No. 15-1293

Title:	Michelle K. Lee, Director, United States Patent and Trademark Office, Petitioner v. Simon Shiao Tam
Docketed:	April 20, 2016
Linked with 15A925	
Lower Ct:	United States Court of Appeals for the Federal Circuit
Case Nos.:	(14-1203)
Decision Date:	December 22, 2015

Questions Presented

~~Date~~~	~~~~~~~Proceedings and Orders~~~~~~~~~~~~~~~~~~~~~
Mar 9 2016	Application (15A925) to extend the time to file a petition for a writ of certiorari from March 21, 2016 to April 20, 2016, submitted to The Chief Justice.
Mar 10 2016	Application (15A925) granted by The Chief Justice extending the time to file until April 20, 2016.
Apr 20 2016	Petition for a writ of certiorari filed. (Response due May 20, 2016)
May 10 2016	Order extending time to file response to petition to and including June 20, 2016.
Jun 20 2016	Brief amicus curiae of Pro-Football, inc.
Jun 20 2016	Brief of respondent Simon Shiao Tam filed.
Jul 6 2016	DISTRIBUTED for Conference of September 26, 2016.
Jul 12 2016	Reply of petitioner Michelle K. Lee, Director, United States Patent and Trademark Office filed. (Distributed)
Sep 29 2016	Petition GRANTED.
Sep 30 2016	Consent to the filing of amicus curiae briefs, in support of either party or of neither party, received from counsel for respondent.
Nov 9 2016	Joint appendix filed.
Nov 9 2016	Brief of petitioner Michelle K. Lee, Director, United States Patent and Trademark Office filed.
Nov 14 2016	Consent to the filing of amicus curiae briefs in support of either party or of neither party received from counsel for the petitioner.
Nov 15 2016	Brief amici curiae of Amanda Blackhorse, et al. filed.
Nov 16 2016	Brief amicus curiae of the American Bar Association, in support of neither party filed.
Nov 16 2016	Brief amici curiae of Native American Organizations filed.
Nov 16 2016	Brief amici curiae of Law Professors filed.
Nov 16 2016	Brief amici curiae of Asian Americans Advancing Justice, et al., in support of neither party filed.
Nov 16 2016	Brief amici curiae of Fred T. Korematsu Center for Law and Equality, et al. filed.
Nov 18 2016	Brief amicus curiae of American Intellectual Property Law Association, in support of neither party filed.
Nov 19 2016	Brief amicus curiae of Public Citizen, Inc., in support of neither party filed.
Nov 21 2016	Brief amici curiae of Certain Members of Congress, in support of neither party filed.
Nov 21 2016	Brief amicus curiae of Public Knowledge, in support of neither party filed.

Nov 21 2016	Brief amicus curiae of New York Intellectual Property Law Association, in support of neither party filed.
Dec 5 2016	SET FOR ARGUMENT on Wednesday, January 18, 2017.
Dec 7 2016	Record requested from the U.S.C.A. Federal Circuit.
Dec 7 2016	Brief amicus curiae of American Center for Law and Justice filed.
Dec 9 2016	Brief of respondent Simon Shiao Tam filed. (Distributed)
Dec 13 2016	CIRCULATED.
Dec 13 2016	Brief amicus curiae of Pacific Legal Foundation filed. (Distributed)
Dec 14 2016	Record received from the U.S. Patent and Trademark Office is electronic along with instructions for access. Part of this record is located on PACER.
Dec 14 2016	Brief amici curiae of Constitutional Law Professors filed. (Distributed)
Dec 15 2016	Brief amici curiae of Professors Edward Lee and Jake Linford filed. (Distributed)
Dec 16 2016	Brief amicus curiae of Alliance Defending Freedom filed. (Distributed)
Dec 16 2016	Brief amicus curiae of Chamber of Commerce of the United States of America filed. (Distributed)
Dec 16 2016	Brief amicus curiae of Pro-Football, Inc. filed. (Distributed)
Dec 16 2016	Brief amicus curiae of Justice and Freedom Fund filed. (Distributed)
Dec 16 2016	Brief amicus curiae of San Francisco Dykes on Bikes Women's Motorcycle Contingent, Inc. filed. (Distributed)
Dec 16 2016	Brief amici curiae of The Thomas Jefferson Center for the Protection of Free Expression, et al. filed. (Distributed)
Dec 16 2016	Brief amicus curiae of The American Jewish Committee filed. (Distributed)
Dec 16 2016	Brief amici curiae of Rutherford Institute and Consumer's Research filed. (Distributed)
Dec 16 2016	Brief amici curiae of American Civil Liberties Union, et al. filed. (Distributed)
Dec 16 2016	Brief amicus curiae of International Trademark Association filed. (Distributed)
Dec 16 2016	Brief amici curiae of Cato Institute, et al. filed. (Distributed)
Dec 16 2016	Brief amicus curiae of Becket Fund for Religious Liberty filed. (Distributed)
Dec 16 2016	Brief amicus curiae of Professor Hugh C. Hansen filed. (Distributed)
Dec 16 2016	Brief amici curiae of Law Professors Gregory Dolin, et al. filed. (Distributed)
Dec 16 2016	Brief amicus curiae of Erik Brunetti filed. (Distributed)
Dec 16 2016	Brief amicus curiae of First Amendment Lawyers Association filed. (Distributed)
Jan 9 2017	Reply of petitioner Michelle K. Lee, Director, United States Patent and Trademark Office filed. (Distributed)
Jan 18 2017 Jun 19 2017	Argued. For petitioner: Malcolm L. Stewart, Deputy Solicitor General, Department of Justice, Washington, D. C. For respondents: John C. Connell, Haddonfield, N. J. Adjudged to be AFFIRMED. Alito, J., announced the judgment of the Court and delivered the opinion of the Court with respect to Parts I, II, and III-A, in which Roberts, C. J., and Kennedy, Ginsburg, Breyer, Sotomayor, and Kagan, JJ., joined, and in which Thomas, J., joined except for Part II, and an opinion with respect to Parts III-B, III-C, and IV, in which Roberts, C. J., and Thomas and Breyer, JJ., joined. Kennedy, J., filed an opinion concurring in part and concurring in the judgment, in which Ginsburg, Sotomayor, and Kagan, JJ., joined. Thomas, J., filed an opinion concurring in part and concurring in the judgment. Gorsuch, J., took no part in the consideration or decision of the case.

~~Name~~~~~~~~~~~~~~~~~~~~~~	~~~~~~~Address~~~~~~~~~~~~~~~~~~~	~~Phone~~~
Attorneys for Petitioner:		
Jeffrey B. Wall Counsel of Record	Acting Solicitor General United States Department of Justice	(202) 514-2217

950 Pennsylvania Avenue, N.W.
Washington, DC 20530-0001
SupremeCtBriefs@USDOJ.gov
Party name: Michelle K. Lee, Director, United States Patent and Trademark Office

Malcolm L. Stewart — Deputy Solicitor General — (202) 514-2201
Department of Justice
Washington, DC 20530
malcolm.l.stewart@usdoj.gov
Party name: Michelle K. Lee, Director, United States Patent and Trademark Office

Attorneys for Respondent:

John C. Connell — Archer & Greiner, P.C. — (856) 354-3074
Counsel of Record
One Centennial Square, P.O. Box 3000
Haddonfield, NJ 08033
jconnell@archerlaw.com
Party name: Simon Shiao Tam

Other:

Floyd Abrams — Cahill Gordon & Reindel LLP — (212) 701-3000
80 Pine Street
New York, NY 10005
fabrams@cahill.com
Party name: Constitutional Law Professors

Lisa S. Blatt — Arnold & Porter LLP — (202) 942-5000
601 Massachusetts Ave., NW
Washington, DC 20001
lisa.blatt@aporter.com
Party name: Pro-Football, Inc.

Megan L. Brown — Wiley Rein LLP — (202) 719-7000
1776 K Street NW
Washington, DC 20006
mbrown@wileyrein.com
Party name: The Rutherford Institute and Consumer's Research

Matthew James Dowd — Dowd, PLLC — (202) 573-3853
1717 Pennsylvania Ave., NW
Washington, DC 20006
mjdowd@dowdpllc.com
Party name: Law Professors Gregory Dolin, et al.

John A. Dragseth — Fish & Richardson, P.C., P.A. — (612) 335-5070
3200 RBC Plaza
60 South 6th Street

	Minneapolis, MN 55402 dragseth@fr.com	

Party name: Certain Members of Congress

Anthony J Dreyer	Skadden, Arps, Slate, Meagher, & Flom LLP Four Times Square New York, NY 10036 anthony.dreyer@skadden.com	(212) 735-3000

Party name: The International Trademark Association

Christine Haight Farley	American University Washington College Law 4300 Nebraska Avenue, NW Washington, DC 20016 cfarley@wcl.american.edu	(202) 274-4171

Party name: Law Professors

Dyan Mary Finguerra-DuCharme	Pryor Cashman LLP 7 Times Square New York, NY 10036 dfinguerra-ducharme@pryorcashman.com	(212) 421-4100

Party name: The New York Intellectual Property Law Association

Hugh C. Hansen	Fordham University School of Law 150 West 62nd Street New York, NY 10023 hansenhugh@gmail.com	(212) 636-6854

Party name: Professor Hugh C. Hansen

James L. Hirsen	505 S. Villa Real Drive Suite 208 Anaheim Hills, CA 92807 hirsen@earthlink.net	(714) 283-8880

Party name: Justice and Freedom Fund

Linda A. Klein	President American Bar Association 321 North Clark Street Chicago, IL 60654 abapresident@americanbar.org	(312) 988-5000

Party name: the American Bar Association

Daniel J. Kornstein	Emery Celli Brinckerhoff & Abady, LLP 600 Fifth Avenue, 10th Floor New York, NY 10020 dkornstein@ecbalaw.com	(212) 763-5000

Party name: Asian Americans Advancing Justice, et al.

Edward S. Lee
Chicago-Kent College of Law
565 W. Adams Street
Chicago, IL 60657
elee@kentlaw.iit.edu
(312) 906-5212
Party name: Professors Edward Lee and Jake Linford

Mark Lemley
Durie Tangri LLP
217 Leidesdorff Street
San Francisco, CA 94111
mlemley@durietangri.com
(415) 362-6666
Party name: San Francisco Dykes on Bikes Women's Motorcycle Contingent, Inc.

Phillip Robert Malone
Stanford Law School
Juelsgaard Intellectual Property and Innovation Clinic
559 Nathan Abbott Way
Stanford, CA 94305
pmalone@law.stanford.edu
(650) 725-6369
Party name: Public Knowledge

Scott L. Nelson
Public Citizen Litigation Group
1600 20th Street, N.W.
Washington, DC 20009
snelson@citizen.org
(202) 588-1000
Party name: Public Citizen, Inc., in support of neither party

Marc J. Randazza
Randazza Legal Group, PLLC
4035 S. El Capitan Way
Las Vegas, NV 89147
ecf@randazza.com
(702) 420-2001
Party name: First Amendment Lawyers Association

William Cheever Rava
Perkins Coie, LLP
1201 Third Avenue, Suite 4900
Seattle, WA 98101
WRava@perkinscoie.com
(206) 359-8000
Party name: Fred T. Korematsu Center for Law and Equality, et al.

Mark L. Rienzi
The Becket Fund for Religious Liberty
1200 New Hampshire Avenue, NW
Suite 700
Washington, DC 20036
mrienzi@becketfund.org
(202) 955-0095
Party name: The Becket Fund for Religious Liberty

Charles A. Rothfeld	Mayer Brown LLP 1999 K Street, N.W. Washington, DC 20006 crothfeld@mayerbrown.com	(202) 263-3000

Party name: Native American Organizations

Lee Berkley Rowland	American Civil Liberties Union Foundation 125 Broad Street, 18th Floor New York, NY 10004 lrowland@aclu.org	(212) 549-2500

Party name: The American Civil Liberties Union, et al.

Eugene Scalia	Gibson, Dunn & Crutcher, LLP 1050 Connecticut Avenue, N.W. Washington, DC 20036 escalia@gibsondunn.com	(202) 955-8500

Party name: The Chamber of Commerce of The United States of America

Jay Alan Sekulow	American Center for Law & Justice 201 Maryland Ave., N.E. Washington, DC 20002 sekulow@aclj.org	(202) 546-8890

Party name: American Center for Law and Justice

Kannon K. Shanmugam	Williams & Connolly LLP 725 Twelfth Street, N.W. Washington, DC 20005 kshanmugam@wc.com	(202) 434-5000

Party name: The American Jewish Committee

Ilya Shapiro	Cato Institute 1000 Massachusetts Ave., NW Washington, DC 20001 ishapiro@cato.org	(202) 842-0200

Party name: The Cato Institute, et al.

Paul M. Smith	Jenner & Block LLP 1099 New York Avenue, N.W. Suite 900 Washington, DC 20001 psmith@jenner.com	(202) 639-6060

Party name: American Intellectual Property Law Association

John R. Sommer	17426 Daimler Street Irvine, CA 92614	(949) 752-5344

	sommerjohn@gmail.com	

Party name: Erik Brunetti

Joshua P. Thompson	Pacific Legal Foundation 930 G Street Sacramento, CA 95814 jpt@pacificlegal.org	(916) 419-7111

Party name: Pacific Legal Foundation

Kristen K. Waggoner	Alliance Defending Freedom 15100 N. 90th Street Scottsdale, AZ 85260 kwaggoner@ADFlegal.org	(480) 444-0020

Party name: Alliance Defending Freedom

J. Joshua Wheeler	Thomas Jefferson Center for the Protection of Free Expression 400 Worrell Drive Charlottesville, VA 22911 jjw@tjcenter.org	(434) 295-4784

Party name: The Thomas Jefferson Center for the Protection of Free Expression, et al.

Jesse Amnon Witten	Drinker Biddle & Reath, LLP 1500 K Street, NW Washington, DC 20815 jesse.witten@dbr.com	(202) 842-8800

Party name: Amanda Blackhorse, et al.

Supreme Court, U.S.
FILED
APR 20 2015
OFFICE OF THE CLERK

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

SIMON SHIAO TAM

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

DONALD B. VERRILLI, JR.
Solicitor General
Counsel of Record
BENJAMIN C. MIZER
Principal Deputy Assistant Attorney General
MALCOLM L. STEWART
Deputy Solicitor General
NICOLE A. SAHARSKY
Assistant to the Solicitor General
DOUGLAS N. LETTER
MARK R. FREEMAN
DANIEL TENNY
JOSHUA M. SALZMAN
MOLLY R. SILFEN
Attorneys

Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217

SARAH HARRIS
General Counsel
THOMAS W. KRAUSE
Acting Solicitor
CHRISTINA J. HIEBER
THOMAS L. CASAGRANDE
MARY BETH WALKER
Associate Solicitors
U.S. Patent and Trademark Office
Alexandria, Va. 22313

QUESTION PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a), provides that no trademark shall be refused registration on account of its nature unless, *inter alia*, it "[c]onsists of * * * matter which may disparage * * * persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." The question presented is as follows:

Whether the disparagement provision in 15 U.S.C. 1052(a) is facially invalid under the Free Speech Clause of the First Amendment.

TABLE OF CONTENTS

Page

Opinions below 1
Jurisdiction 1
Statutory and regulatory provisions involved 2
Statement 2
Reasons for granting the petition 8
I. The court of appeals' invalidation of an Act of Congress warrants this Court's review 9
II. The court of appeals erred in holding that Section 1052(a) is unconstitutional 10
A. Section 1052(a) does not restrict speech 10
B. Section 1052(a) establishes lawful eligibility criteria for federal trademark registration 14
III. The question presented is important 22
Conclusion 25
Appendix A — En banc court of appeals opinion (Dec. 22, 2015) 1a
Appendix B — Court of appeals opinion (Apr. 20, 2015) 123a
Appendix C — Trademark Trial and Appeal Board opinion (Sept. 26, 2015) 162a
Appendix D — Statutory provision 183a

TABLE OF AUTHORITIES

Cases:

Ashcroft v. *ACLU*, 542 U.S. 656 (2004) 10
B & B Hardware, Inc. v. *Hargis Indus., Inc.*, 135 S. Ct. 1293 (2015) 3, 11
Bates v. *State Bar*, 433 U.S. 350 (1977) 19
Blodgett v. *Holden*, 275 U.S. 142 (1927) 9
Boulevard Entm't, Inc., In re, 334 F.3d 1336 (Fed. Cir. 2003) 12
Broadrick v. *Oklahoma*, 413 U.S. 601 (1973) 9

Cases—Continued: Page

Central Hudson Gas & Elec. Corp. v. *Public Serv. Comm'n*, 447 U.S. 557 (1980) 20
Holder v. *Humanitarian Law Project*, 561 U.S. 1 (2010) 9
McGinley, In re, 660 F.2d 481 (C.C.P.A. 1981) 6, 12
National Endowment for the Arts v. *Finley*, 524 U.S. 569 (1998) 15, 18
Park 'N Fly, Inc. v. *Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985) 2
Pleasant Grove City v. *Summum*, 555 U.S. 460 (2009) 18
R.A.V. v. *City of St. Paul*, 505 U.S. 377 (1992) 13
Regan v. *Taxation With Representation of Wash.*, 461 U.S. 540 (1983) 14, 15
Rosenberger v. *Rector & Visitors of Univ. of Va.*, 515 U.S. 819 (1995) 13
Rostker v. *Goldberg*, 453 U.S. 57 (1981) 9
Rust v. *Sullivan*, 500 U.S. 173 (1991) 14, 15, 16, 18, 19
San Francisco Arts & Athletics, Inc. v. *United States Olympic Comm.*, 483 U.S. 522 (1987) 20
Test Masters Educ. Servs., Inc. v. *Singh*, 428 F.3d 559 (5th Cir. 2005), cert. denied, 547 U.S. 1055 (2006) 12
Trade-Mark Cases, In re, 100 U.S. 82 (1879) 3, 11
Two Pesos, Inc. v. *Taco Cabana, Inc.*, 505 U.S. 763 (1992) 3
United States v. *Alvarez*, 132 S. Ct. 2537 (2012) 9
United States v. *Stevens*, 559 U.S. 460 (2010) 9
United States v. *Williams*, 553 U.S. 285 (2008) 9
Walker v. *Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015) 14, 16, 17, 18
Wooley v. *Maynard*, 430 U.S. 705 (1977) 17

Constitution, treaty and statutes: Page

U.S. Const. Amend. I ..... *passim*
Paris Convention for the Protection of Industrial Property art. 6quinquies, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 22
Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 725 22
Act of July 5, 1946, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*) 3
15 U.S.C. 1051(a) 4
15 U.S.C. 1052 ..... 4, 10
15 U.S.C. 1052(a) (§ 2(a), 60 Stat. 428) ..... *passim*
15 U.S.C. 1052(b) 4
15 U.S.C. 1052(c) 4
15 U.S.C. 1052(d) 4
15 U.S.C. 1052(e) 4, 12
15 U.S.C. 1052(e)(5) 4
15 U.S.C. 1057(a) 15
15 U.S.C. 1057(b) 3
15 U.S.C. 1065 3
15 U.S.C. 1071(a) 23
15 U.S.C. 1072 3
15 U.S.C. 1091 16
15 U.S.C. 1115(a) 3
15 U.S.C. 1115(b) 3
15 U.S.C. 1117(a) 12
15 U.S.C. 1125(a) 4, 11
15 U.S.C. 1125(b) 4, 11
15 U.S.C. 1125(d) 4, 11
15 U.S.C. 1127 ..... 2, 11
15 U.S.C. 1141a 22
15 U.S.C. 1141b 22

Statute—Continued: Page

28 U.S.C. 1295(a)(4)(B) 23

Miscellaneous:

1 Anne Gilson LaLonde, *Gilson on Trademarks*, (2015) 3

U.S. Patent and Trademark Office, *Exam Guide 01-16: Examination for Compliance with Section 2(a)'s Scandalousness and Disparagement Provisions While Constitutionality Remains in Question* (Mar. 2016), http://www.uspto.gov/trademark/guides-and-manuals/trademark-examination-guides 23

In the Supreme Court of the United States

No.

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

SIMON SHIAO TAM

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

The Solicitor General, on behalf of the Director of the United States Patent and Trademark Office, respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the en banc court of appeals (App., *infra*, 1a-122a) is reported at 808 F.3d 1321. The opinion of a panel of the court of appeals (App., *infra*, 123a-161a) is reported at 785 F.3d 567. The opinion of the Trademark Trial and Appeal Board (App., *infra*, 162a-182a) is available at 2013 WL 5498164.

JURISDICTION

The judgment of the court of appeals was entered on December 22, 2015. On March 10, 2016, the Chief Justice extended the time within which to file a peti-

tion for a writ of certiorari to and including April 20, 2016. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATUTORY AND REGULATORY PROVISIONS INVOLVED

The First Amendment to the Constitution provides, in relevant part: "Congress shall make no law * * * abridging the freedom of speech." Section 1052 of Title 15 of the United States Code is reproduced in the appendix to this petition. App., *infra*, 183a-186a.

STATEMENT

This case involves a facial First Amendment challenge to Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a). That provision directs the United States Patent and Trademark Office (PTO) to refuse registration of trademarks that "disparage * * * persons, living or dead, institutions, beliefs, or national symbols." *Ibid.* Respondent sought federal registration for the mark THE SLANTS in connection with his dance-rock band. The PTO refused registration on the ground that the mark refers to persons of Asian ancestry and is disparaging to them. App., *infra*, 162a-182a. The en banc court of appeals held the disparagement provision of Section 1052(a) facially invalid under the First Amendment. *Id.* at 1a-122a.

1. A trademark is a "word, name, symbol, or device" used by a person "to identify and distinguish his or her goods" in commerce and "to indicate the source of the goods." 15 U.S.C. 1127. "[T]rademarks desirably promote competition and the maintenance of product quality." *Park 'N Fly, Inc.* v. *Dollar Park & Fly, Inc.*, 469 U.S. 189, 193 (1985). Trademark law also protects the public by preventing competing

merchants from using confusingly similar marks to mislead consumers about the source of the goods and services they purchase. See, *e.g.*, *B & B Hardware, Inc.* v. *Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015); *Two Pesos, Inc.* v. *Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992).

Federal law does not create trademarks or trademark rights. See, *e.g.*, *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879). Trademark rights arise through use of a mark in commerce in connection with particular goods and services. 1 Anne Gilson LaLonde, *Gilson on Trademarks*, § 3.02[2][a] (2015). The holder of a trademark may use and enforce his mark without federal registration. See *B & B Hardware, Inc.*, 135 S. Ct. at 1299.

As a supplement to common-law protection, Congress has created a federal trademark-registration system and has provided federal remedies for mark owners against infringement, dilution, and unfair competition. See Act of July 5, 1946, ch. 540, 60 Stat. 427 (Lanham Act) (15 U.S.C. 1051 *et seq.*). Federal registration confers certain benefits on trademark owners who register their marks. See *B & B Hardware*, 135 S. Ct. at 1300. For example, registration provides prima facie evidence of the owner's exclusive right to use the mark in connection with certain goods or services in commerce. 15 U.S.C. 1057(b), 1115(a). Registration also provides constructive notice of the registrant's claim of ownership of the mark. 15 U.S.C. 1072. After five years of registration, an owner's right to use a trademark can become "incontestable" and may be challenged only on very limited grounds. 15 U.S.C. 1065, 1115(b). But many of the federal remedies created by the Lanham Act are available to own-

ers of all marks, without regard to registration. See 15 U.S.C. 1125(a) (federal cause of action for representations about the origin of goods or services that are likely to confuse consumers), (b) (importation ban), and (d) (remedy for cybersquatting).

To obtain federal registration, the trademark owner submits an application to the PTO. 15 U.S.C. 1051(a). The PTO is not required to register every mark for which an application is filed. Rather, Congress directed the PTO to "refuse[] registration" of certain categories of marks "on account of [their] nature." 15 U.S.C. 1052. This case concerns one of those categories—marks consisting of or comprising "matter which may disparage * * * persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." 15 U.S.C. 1052(a).[1]

2. Respondent is the lead singer of a dance-rock band called "The Slants." App., *infra*, 10a. In 2011, he sought to federally register THE SLANTS as a trademark for use in connection with live performances by his band. *Id.* at 162a & n.1, 166a; see C.A. App. A23-A36 (respondent's trademark application).[2] Respondent had been using the mark in commerce since

---

[1] Other categories include immoral, deceptive, or scandalous marks, 15 U.S.C. 1052(a); marks containing a flag, coat of arms, or insignia of the United States, a State, or a foreign nation, 15 U.S.C. 1052(b); marks including a name, portrait, or signature of a living person without his or her consent, 15 U.S.C. 1052(c); marks that so resemble other marks that they are likely to cause confusion, 15 U.S.C. 1052(d); marks that are merely descriptive, 15 U.S.C. 1052(e); and marks that are functional, 15 U.S.C. 1052(e)(5).

[2] Respondent originally filed a trademark application for THE SLANTS in 2010, but then abandoned that application. App., *infra*, 10a n.2.

2006. App., *infra*, 10a. A PTO examining attorney refused registration on the ground that the mark is disparaging to persons of Asian ancestry. *Id.* at 163a; see C.A. App. A41-A44.

The PTO's Trademark Trial and Appeal Board (Board) affirmed. App., *infra*, 162a-182a. The Board concluded that the mark is used to refer to an identifiable group of people—persons of Asian ancestry—and that the mark is disparaging to a substantial composite of such people. *Id.* at 173a-174a, 180a-181a. The Board explained that dictionary definitions and other sources cited by the parties "unanimously categorize the word 'slant,' when meaning a person of Asian descent, as disparaging." *Id.* at 180a. The Board also cited record evidence that Asian individuals and groups had specifically objected to respondent's use of the term as the name for his band. *Id.* at 167a-168a. And the Board noted that members of the band have said that they use the word "slant" because it is "an ethnic slur for Asians" and the band wishes to "take on stereotypes" about Asians. *Id.* at 166a. The Board further determined that the PTO's refusal to register the mark does not violate the First Amendment because the denial of registration does not suppress speech or proscribe conduct, but simply prevents respondent from calling upon the resources of the federal government to assist him in enforcing his rights in THE SLANTS. *Id.* at 181a-182a.

3. A panel of the court of appeals affirmed. App., *infra*, 123a-161a. The court first rejected respondent's argument that the Board had erred in finding the mark disparaging under Section 1052(a). The court concluded that substantial evidence supports the Board's conclusions that "the mark THE SLANTS

refers to people of Asian descent" and that the mark "is likely offensive to a substantial composite of people of Asian descent." *Id.* at 127a-131a. The court noted that "the definitions in evidence universally characterize the word 'slant' as disparaging, offensive, or an ethnic slur when used to refer to a person of Asian descent." *Id.* at 130a.

The court of appeals rejected respondent's various constitutional challenges, including his facial First Amendment challenge to Section 1052(a). Relying on circuit precedent, the court explained that "the PTO's refusal to register [the] mark does not affect his right to use it"; that "[n]o conduct is proscribed, and no tangible form of expression is suppressed"; and that respondent's First Amendment rights therefore are not "abridged by the refusal to register his mark." App., *infra*, 131a (quoting *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981)); see *id.* at 131a-132a (citing other Federal Circuit decisions reaching the same conclusion).

In a separate opinion, Judge Moore urged the court to "revisit [its prior] holding on the constitutionality of § 2(a) of the Lanham Act." App., *infra*, 135a (Moore, J., providing additional views).

4. The en banc court of appeals held that Section 1052(a)'s disparagement provision is facially unconstitutional under the First Amendment, vacated the Board's decision, and remanded for further proceedings. App., *infra*, 1a-122a.[3] The government had argued that Congress may, consistent with the First Amendment, create an optional program of federal

---

[3] The en banc court of appeals upheld the Board's finding that THE SLANTS is disparaging within the meaning of 15 U.S.C. 1052(a). App., *infra*, 12a n.3.

trademark registration without opening that program to racial slurs or other disparaging marks. See *id.* at 27a-28a. The court rejected that characterization of the program, concluding that the trademark-registration scheme is a law "penaliz[ing] private speech merely because [the government] disapproves of the message it conveys." *Id.* at 2a. Because the court viewed Section 1052(a) as a viewpoint-based restriction on speech, it subjected the provision to strict scrutiny and found it invalid. *Id.* at 17a-19a, 67a. The court also stated that it would find Section 1052(a) unconstitutional even under the more forgiving commercial-speech standard because there is no "substantial government interest justifying the" ban on registration of disparaging marks. *Id.* at 61a-67a.

Judge O'Malley (joined by Judge Wallach) filed a concurring opinion. App., *infra*, 68a-80a. Those judges agreed that Section 1052(a)'s disparagement provision is facially unconstitutional under the First Amendment, and they would also have held that the provision is impermissibly vague. *Id.* at 68a. Judge Dyk concurred in part and dissented in part. *Id.* at 80a-104a. He would have held that Section 1052(a) is facially constitutional because registration is a government benefit for commercial speech that reasonably may be denied to disparaging marks, *id.* at 90a-97a, but that Section 1052(a) is unconstitutional as applied in this case because respondent's use of his mark involves "political" speech, *id.* at 103a-104a.[4]

---

[4] Judge Dyk was joined by Judges Lourie and Reyna with respect to his conclusion that Section 1052(a)'s disparagement provision is facially constitutional, but not with respect to his conclusion that the provision is unconstitutional as applied. See App., *infra*, 80a.

Judge Lourie dissented, concluding that Section 1052(a) is constitutional because it does not prohibit any speech but instead denies the benefits of registration to private disparaging speech. *Id.* at 105a-108a. Judge Reyna also dissented, expressing the view that Section 1052(a)'s disparagement provision is a permissible regulation of commercial speech because it "directly advances the government's substantial interest in the orderly flow of commerce." *Id.* at 108a-109a.

REASONS FOR GRANTING THE PETITION

The en banc court of appeals held that the disparagement provision in Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a), is facially unconstitutional. That holding is incorrect and warrants this Court's review.

Section 1052(a) does not prohibit any speech, proscribe any conduct, or restrict the use of any trademark. Nor does it restrict a mark owner's common-law trademark protections. Rather, Section 1052(a) directs the PTO not to provide the benefits of federal registration to disparaging marks. The Federal Circuit nonetheless treated the registration ban as an affirmative restriction on speech and, applying strict scrutiny, declared it facially unconstitutional. The court of appeals disregarded this Court's teaching that, when Congress does not restrict private speech or conduct, but simply offers federal benefits on terms that encourage private activity consonant with legislative policy, it has significant latitude to consider the content of speech in defining the terms on which the benefits will be provided.

The question presented is important. The statutory provision at issue here has guided the PTO's decisions for 70 years. Absent this Court's review, the Federal Circuit's ruling will effectively resolve the

validity of Section 1052(a)'s disparagement provision nationwide because any applicant for trademark registration may obtain judicial review of an adverse decision of the PTO in that court. The petition for a writ of certiorari should be granted.

I. THE COURT OF APPEALS' INVALIDATION OF AN ACT OF CONGRESS WARRANTS THIS COURT'S REVIEW

The Court should grant review because the court of appeals has held that a longstanding federal statutory provision is facially unconstitutional. See App., *infra*, 20a n.5 ("[W]e conclude that § 2(a) is invalid on its face."); *id.* at 68a ("We hold that the disparagement provision of § 2(a) is unconstitutional because it violates the First Amendment."); see also *id.* at 19a n.5 (noting the parties' agreement that "this appeal is appropriately viewed as involving a facial challenge").

Facial invalidation of a statute under the First Amendment is "strong medicine" that should be employed "sparingly and only as a last resort." *Broadrick* v. *Oklahoma*, 413 U.S. 601, 613 (1973). And any decision invalidating an Act of Congress on constitutional grounds is significant. See *Rostker* v. *Goldberg*, 453 U.S. 57, 64 (1981) (noting that judging the constitutionality of an Act of Congress is "the gravest and most delicate duty that this Court is called upon to perform") (quoting *Blodgett* v. *Holden*, 275 U.S. 142, 148 (1927) (Holmes, J.)). This Court has often reviewed holdings that a federal law is invalid under the First Amendment, even in the absence of a circuit split. See, *e.g.*, *United States* v. *Alvarez*, 132 S. Ct. 2537, 2543 (2012); *Holder* v. *Humanitarian Law Project*, 561 U.S. 1, 14 (2010); *United States* v. *Stevens*, 559 U.S. 460, 467 (2010); *United States* v. *Williams*,

553 U.S. 285, 292 (2008); *Ashcroft* v. *ACLU*, 542 U.S. 656, 664 (2004).

Under the "sweeping holding" of the court below, the PTO may not use Section 1052(a) to refuse registration as a trademark of even the most vile racial epithet. App., *infra*, 80a (Dyk, J., concurring in part and dissenting in part). By treating eligibility criteria for participation in a voluntary federal program as constitutionally equivalent to affirmative restrictions on speech, the court of appeals has cast doubt on Congress's ability to determine when the federal government will lend its assistance to private actors. A decision that so limits Congress's authority deserves this Court's immediate review.

II. THE COURT OF APPEALS ERRED IN HOLDING THAT SECTION 1052(a) IS UNCONSTITUTIONAL

Section 1052(a) does not restrict any speech or restrain any form of expression. Common-law trademark rights exist and may be enforced without regard to federal registration. Section 1052(a) simply reflects Congress's judgment that the federal government should not affirmatively promote the use of racial slurs and other disparaging terms by granting them the benefits of registration. That judgment does not violate the First Amendment.

A. Section 1052(a) Does Not Restrict Speech

1. The "first step" in a First Amendment analysis is "to construe the challenged statute." *Williams*, 553 U.S. at 293. The statute at issue here directs the PTO to "refuse[] registration" of certain categories of trademarks "on account of [their] nature." 15 U.S.C. 1052. One such category is marks that "[c]onsist[] of or comprise[] * * * matter which may dispar-

age * * * persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." 15 U.S.C. 1052(a). The sole effect of this provision is that various benefits of federal registration are not available for disparaging marks. See App., *infra*, 4a-5a (listing those benefits).

Section 1052(a) does not restrict the terms or images that may lawfully be used as trademarks. A trademark is "any word, name, symbol, or device" used by a person "to identify and distinguish his or her goods" in commerce and "to indicate the source of the goods." 15 U.S.C. 1127. Trademark rights are created by use of the mark to identify goods and services in commerce, not by federal law. See *B & B Hardware, Inc.* v. *Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015) (explaining that "federal law does not create trademarks"; rather, a person who "first uses a distinct mark in commerce * * * acquires rights to that mark"); see also *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879).

Even without federal registration, respondent may use a disparaging racial term to identify his band's goods and services in commerce. Respondent began using his mark in commerce in 2006 and has acquired rights to enforce his mark through that use. App., *infra*, 10a. In addition to any common-law protections, respondent has federal remedies under the Lanham Act against those who misuse his mark or misappropriate any goodwill associated with it, even though it is not registered. Those remedies include a cause of action for false association, 15 U.S.C. 1125(a); a prohibition on importing goods bearing confusingly similar marks, 15 U.S.C. 1125(b); protection against cybersquatting, 15 U.S.C. 1125(d); and authorization

of treble-damages awards for certain types of infringement, 15 U.S.C. 1117(a).[5]

2. The court of appeals erred in equating Section 1052(a)'s disparagement provision with an affirmative restriction on speech. As that court previously had recognized, "the refusal to register a mark does not proscribe any conduct or suppress any form of expression because it does not affect the applicant's right to use the mark in question." *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003); see *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (PTO's refusal to register a mark "does not affect [the applicant's] right to use it"; "[n]o conduct is proscribed, and no tangible form of expression is suppressed"). The Fifth Circuit applied the same reasoning in holding that an applicant had no First Amendment right to register a trademark that was merely descriptive. *Test Masters Educ. Servs., Inc.* v. *Singh*, 428 F.3d 559, 567-568, 578 n.9 (2005), cert. denied, 547 U.S. 1055 (2006); see 15 U.S.C. 1052(e); Pet. App. 16a.

Section 1052(a) does not prevent respondent from promoting his band using any racial slur or image he wishes. It does not limit how respondent may advertise, what songs he may sing, or what messages he may convey. Respondent's freedom of expression is no more restricted by federal law now than it was in 2006, when he first used THE SLANTS to identify his band.

The court of appeals viewed Section 1052(a)'s disparagement provision as "penaliz[ing] private speech"

---

[5] Although the court of appeals suggested that federal registration is necessary to obtain some of these remedies, App., *infra*, 4a-5a, that suggestion reflects a misunderstanding of federal trademark law.

because the government "disapproves of the message it conveys." App., *infra*, 2a. As an initial matter, the court was wrong to view Section 1052(a) as a viewpoint-based provision. Section 1052(a) prohibits registration of trademarks containing certain words without regard to the "ideology," "opinion," or "perspective" of the trademark owner. *Rosenberger* v. *Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995). That congressional judgment is permissible. See *R.A.V.* v. *City of St. Paul*, 505 U.S. 377, 391 (1992) (there is no viewpoint discrimination when a statute prohibits use of "odious racial epithets" by "proponents of all views"). In this case, the Board's denial of registration was not based on any finding that respondent intended to disparage Asians. To the contrary, the Board determined that Section 1052(a) prohibits registration of respondent's mark *despite* the fact that respondent's stated purpose for using the mark is to "reclaim" the slur as a sign of ethnic pride. App., *infra*, 10a, 166a.[6]

---

[6] In his separate concurring and dissenting opinion, Judge Dyk concluded that Section 1052(a) is facially constitutional because trademark registration is a benefit for commercial speech that reasonably may be denied for disparaging marks. App., *infra*, 90a-97a. He would have held, however, that Section 1052(a) is unconstitutional as applied to this case because respondent's own "choice of mark reflects a clear desire to editorialize on cultural and political subjects. [Respondent] chose THE SLANTS at least in part to reclaim the negative racial stereotype it embodies." *Id.* at 102a-103a. But if Congress or the PTO had drawn the distinction that the concurring judge suggested—*i.e.*, approving respondent's application based on the "cultural and political" message that respondent sought to convey, even though THE SLANTS could not have been registered by an applicant that intended to disparage Asians—it would have introduced into the statute the very

In any event, Section 1052(a) does not penalize private speech. This Court has repeatedly recognized the critical constitutional distinction between *penalizing* speech and refusing to *support* it. The government may not prohibit or penalize respondent's racial slurs except in the most compelling circumstances. As explained below, however, the government may decline to use its resources to support such speech.

B. Section 1052(a) Establishes Lawful Eligibility Criteria For Federal Trademark Registration

1. While Congress cannot prohibit the use of disparaging terms to express ideas, the government has no obligation to support such speech. The Court has squarely "reject[ed] the notion that First Amendment rights are somehow not fully realized unless they are subsidized by the State." *Regan* v. *Taxation With Representation of Wash.*, 461 U.S. 540, 546 (1983) (internal quotation marks omitted). This Court has also consistently recognized that the government may "selectively fund a program to encourage certain activities it believes to be in the public interest, without at the same time funding an alternative program which seeks to deal with the problem in another way." *Rust* v. *Sullivan*, 500 U.S. 173, 193 (1991). "In so doing, the Government has not discriminated on the basis of viewpoint; it has merely chosen to fund one activity to the exclusion of the other." *Ibid.*

The Court has recognized in a variety of contexts that the government may take into account the content of speech in deciding whether to assist would-be private speakers. See, *e.g.*, *Walker* v. *Texas Div.*,

---

viewpoint discrimination that the First Amendment generally discountenances.

Sons of Confederate Veterans, Inc., 135 S. Ct. 2239, 2245-2250 (2015) (State may refuse to issue license plate with confederate-flag logo); *National Endowment for the Arts* v. *Finley*, 524 U.S. 569, 572, 587-588 (1998) (National Endowment for the Arts may take into account "decency and respect for the diverse beliefs and values of the American public" in distributing federal grants to artists) (citation omitted); *Rust*, 500 U.S. at 192-193 (upholding regulations that limited ability of recipients of Title X funding to engage in abortion-related activities); *Regan*, 461 U.S. at 545-546 (upholding statute granting tax-exempt status to organizations that do not engage in lobbying). Although the doctrinal labels vary, those decisions share a common thread: First Amendment scrutiny is significantly more relaxed when the government establishes eligibility criteria for a voluntary government program than when it restricts wholly private speech. Uncertainty as to which doctrinal "box" this case falls into is much less important than the fact that, although Section 1052(a) disentitles respondent to certain forms of government assistance, it does not restrict respondent's ability to use THE SLANTS, or to engage in any other communication about the band, Asian stereotypes, or anything else.

2. The Constitution does not require Congress to open the federal trademark-registration system to racial epithets. Having decided to create a federal trademark-registration system, Congress may set the criteria for participation in that program. A federal registrant receives a certificate of registration "issued in the name of the United States of America, under the seal of the [PTO]." 15 U.S.C. 1057(a). Registered trademarks are published in the *Official Gazette* of

the PTO and recorded on the agency's Principal Register (or, in certain circumstances, on a Supplemental Register). See *ibid.* (Principal Register); 15 U.S.C. 1091 (Supplemental Register).

Congress legitimately determined that a federal agency should not use government funds to issue certificates "in the name of the United States of America" conferring statutory benefits for use of racial slurs and other disparaging terms. Just as the Constitution does not require a State to issue confederate-flag license plates, it does not require Congress to underwrite the commercial use of racist, misogynist, or bigoted terms and imagery in commerce. See *Walker*, 135 S. Ct. at 2245, 2252-2253. Although respondent has a First Amendment right to use THE SLANTS in marketing his band, he has no comparable right to force the government to register racial epithets, publish those epithets in the PTO's *Official Gazette*, issue registration certificates for those epithets in the name of the United States, and inscribe those epithets on the PTO's Principal Register.

3. The court of appeals erred in deeming this Court's government-subsidy decisions inapplicable.

a. The court of appeals viewed Section 1052(a)'s disparagement provision as imposing an unconstitutional condition on private speech. App., *infra*, 28a-31a. That characterization is mistaken. A limitation on the receipt of public benefits constitutes a potentially unconstitutional condition only when "the Government has placed a condition on the recipient of the subsidy rather than on a particular program or service, thus effectively prohibiting the recipient from engaging in the protected conduct outside the scope of the federally funded program." *Rust*, 500 U.S. at 197

(emphasis omitted). That doctrine would apply, for example, if the Lanham Act denied the benefits of trademark registration to persons who had engaged in specified speech or conduct outside the registration program (*e.g.*, if respondent's use of THE SLANTS as a mark in commerce rendered him ineligible to register *other* marks). Section 1052(a) does not operate in that manner. Rather, under Section 1052(a), the registrability of a particular trademark depends solely on the specific mark sought to be registered, not on the applicant's other activities. The unconstitutional-conditions doctrine therefore is inapplicable. See App., *infra*, 95a-96a (Dyk, J., concurring in part and dissenting in part).

b. The court of appeals' other reasons for treating Section 1052(a) as an affirmative restriction on speech likewise do not withstand scrutiny. The court stated that registration of a trademark is not government speech because the government is not embracing the message conveyed by the mark. App., *infra*, 40a-47a. But when the PTO approves a particular trademark for federal registration, the agency must record the mark on a government platform "for the express purpose that it be observed and read by the public." *Wooley* v. *Maynard*, 430 U.S. 705, 713 (1977). In *Wooley*, the Court recognized "an individual's First Amendment right to avoid becoming the courier for" a message he finds objectionable, *id.* at 717, even in circumstances where the message is unlikely to be attributed to the individual himself, see *id.* at 720-721 (Rehnquist, J., dissenting). The government has an analogous interest in declining to incorporate racially offensive epithets into various official communications. See *Walker*, 135 S. Ct. at 2248-2250. In any event, the

principle that the government has broad authority to decide what speech to assist has frequently been applied to private speech whose message could not reasonably be attributed to the government. See, *e.g.*, *Finley*, 524 U.S. at 587-588 ("Congress has wide latitude to set spending priorities."); *Rust*, 500 U.S. at 200 (citing the "general rule" that "the Government may choose not to subsidize speech").

The court of appeals concluded that Section 1052(a)'s disparagement provision is not a limit on a government subsidy, App., *infra*, 47a-61a, but that conclusion was based on the court's erroneous view that the unconstitutional-conditions doctrine applied. See pp. 16-17, *supra*. The court also suggested that the registration program cannot be viewed as a government subsidy because it is funded by registration fees. App., *infra*, 57a-58a. But the Court has upheld government programs with similar funding mechanisms, explaining that receipt of fees does not change the nature of the government program. See *Walker*, 135 S. Ct. at 2252 ("[I]f the city in [*Pleasant Grove City* v. *Summum*, 555 U.S. 460 (2009),] had established a rule that organizations wishing to donate monuments must also pay fees to assist in park maintenance, we do not believe that the result in that case would have been any different."). And respondent's application to register his mark presumably reflects his determination that the benefits of registration outweigh the costs involved.

The court of appeals opined that Section 1052(a)'s exclusion of disparaging marks could have the "chilling effect" of discouraging the use of those marks in commerce. App., *infra*, at 47a-48a, 52a. But the First Amendment does not bar Congress from

using the resources of the federal government to encourage some forms of expressive conduct rather than others. A marginal shift in incentives "is commonly the effect of the denial of subsidies," but that "does not turn a subsidy provision into a regulatory provision, so long as the subsidy is not designed to limit speech outside of the subsidized program." *Id.* at 95a (Dyk, J., concurring in part and dissenting in part). The commercial nature of trademarks further reduces any concerns about chill. See *Bates* v. *State Bar*, 433 U.S. 350, 381 (1977) (explaining that, because commercial speech is "linked to commercial well-being, it seems unlikely that such speech is particularly susceptible" to incidental chill).

The court of appeals also stated that, "[u]nder the logic of the government's approach, * * * Congress could pass a law prohibiting the copyrighting of works containing 'racial slurs,' 'religious insults,' 'ethnic caricatures,' and 'misogynistic images.'" App., *infra*, 60a. That reasoning reflects a misunderstanding of the government's legal theory. The government's core argument in this case—*i.e.*, that the government has much greater latitude under the First Amendment when it merely refuses to support private speech rather than affirmatively bans it—does logically imply that limits on copyright registrability are subject to less demanding First Amendment scrutiny than actual bans on dissemination of creative works. The argument does not logically suggest, however, that such limits are wholly exempt from First Amendment challenge. Cf. *Rust*, 500 U.S. at 199 (explaining that government funding is not "invariably sufficient to justify Government control over the content of expression"). Nor does it suggest that the

First Amendment analysis must be identical in the trademark and copyright contexts. To the extent that the hypothetical statute described by the Federal Circuit would more greatly burden expression than does the denial of trademark registration (*e.g.*, because of differences between trademarks and copyrights, or because the hypothetical law would deny registration to the entire work based on isolated words within the work), the First Amendment inquiry in the hypothetical copyright-registration scenario could account for that greater burden.

4. The court of appeals made two other important errors. First, the court failed to recognize that the trademark-registration program operates exclusively in the sphere of commercial speech. See *San Francisco Arts & Athletics, Inc.* v. *United States Olympic Comm.*, 483 U.S. 522, 535 (1987). This case involves a dispute not about purely political speech, but about use of a mark to identify goods and services in commerce. If Section 1052(a) actually restricted speech (for example, if it precluded certain terms or symbols from being used as names of businesses, products, or services), the standards set out in *Central Hudson Gas & Electric Corp.* v. *Public Service Commission*, 447 U.S. 557, 566 (1980), would apply. That form of intermediate scrutiny would be appropriate for such a restriction because "[t]he marketplace of ideas differs dramatically from the marketplace of goods and services." App., *infra*, 116a (Reyna, J., dissenting).

As explained above, Section 1052(a) does not prohibit or restrict speech at all, but instead establishes eligibility criteria for a particular form of federal assistance. But just as restrictions on commercial speech are subject to less demanding First Amend-

ment scrutiny than other speech restrictions, the fact that the advantages conferred by federal trademark registration are economic in nature provides a further reason to uphold the viewpoint-neutral eligibility criteria at issue here. The court of appeals therefore seriously erred in subjecting Section 1052(a) to strict scrutiny and deeming it "presumptively invalid." App., *infra*, 27a.

Second, the court of appeals erred in concluding that the government has no substantial interest in prohibiting the registration of disparaging trademarks. The government has a substantial interest in creating a federal trademark-registration program to facilitate the efficient conduct of interstate commerce by offering additional benefits to qualifying marks. Having created such a program, the government also has an interest in declining to use its resources to encourage offensive or disparaging marks. See App., *infra*, 81a (Dyk, J., concurring in part and dissenting in part) (Section 1052(a) "protect[s] underrepresented groups in our society from being bombarded with demeaning messages in commercial advertising."); *id.* at 117a (Reyna, J., dissenting) ("Commerce does not benefit from political volatility, nor from insults, discrimination, or bigotry.").

Although registration of a trademark does not signal government endorsement of any particular product, service, mark, name, or registrant, the government's registration of a disparaging term as a trademark, and publication of that mark on the Principal Register, would convey to the public that the United States regards racial slurs as appropriate source iden-

tifiers in commerce.[7] Congress could also reasonably conclude that commercial actors are more likely to choose marks for which the advantages of federal registration are available, and it could reasonably decline to provide this incentive to use of racial epithets and other disparaging marks. Those government interests are fully sufficient to justify Section 1052(a)'s exclusion of such marks from the federal trademark-registration program.

III. THE QUESTION PRESENTED IS IMPORTANT

The challenged provision is a longstanding and important part of the federal trademark-registration system. Congress has prohibited registration of certain categories of trademarks since the registration system was created in 1905. See Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 725. The prohibition on disparaging marks has been in place since 1946. See Act of July 5, 1946, ch. 540, § 2(a), 60 Stat. 428 (Lanham Act). The PTO has repeatedly applied these provisions to refuse registration of disparaging marks. See App., *infra*, 7a-8a (listing a variety of disparaging marks that the PTO has refused to register). The court below nevertheless invalidated Section 1052(a)'s disparagement provision on its face, so that it cannot be used in any circumstances, even to prohibit registration of the most vile racial epithets.

---

[7] That is especially true because owners of registered marks may ask the PTO to transmit their applications to international bodies for recognition. See 15 U.S.C. 1141a, 1141b (Madrid Protocol); Paris Convention for the Protection of Industrial Property art. 6^{quinquies}, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 (providing for transmittal of certificates of registration to other countries).

The court of appeals' decision effectively precludes the PTO from enforcing Section 1052(a)'s disparagement provision against any trademark-registration applicant nationwide. By statute, any applicant who is refused trademark registration may seek review of the PTO's decision in the Federal Circuit. See 15 U.S.C. 1071(a); 28 U.S.C. 1295(a)(4)(B). Pending the Court's disposition of this petition, the PTO therefore has suspended action on trademark applications that would be refused under the disparagement provision of Section 1052(a). See U.S. Patent and Trademark Office, *Exam Guide 01-16: Examination for Compliance with Section 2(a)'s Scandalousness and Disparagement Provisions While Constitutionality Remains in Question* 1 (Mar. 2016), http://www.uspto.gov/trademark/guides-and-manuals/trademark-examination-guides. Accordingly, this Court should review the question presented now.[8]

The court of appeals' decision also casts doubt on the validity of other provisions of Section 1052(a) not at issue in this case, such as the bar against registration of "immoral * * * or scandalous matter." 15 U.S.C. 1052(a). The court acknowledged that, under

---

[8] The question presented here also is presented in a pending case in the Fourth Circuit, *Pro-Football, Inc.* v. *Blackhorse*, No. 15-1874, which concerns the cancellation of registrations for marks that contain the term "Redskins" used by the Washington football team. That case has been briefed and is awaiting oral argument. Because that case involves other statutory and evidentiary challenges to the agency's decision, the court of appeals may decide the case without reaching the constitutional question. And in the meantime, the Federal Circuit's decision prevents the PTO from refusing registrations based on Section 1052(a)'s disparagement provision. This Court therefore should not await a decision in the Fourth Circuit case.

its First Amendment theory, "other portions of § 2 may constitute government regulation of expression based on message, such as the exclusions of immoral or scandalous marks." App., *infra*, 7a n.1; see *id.* at 82a (Dyk, J., concurring in part and dissenting in part) (expressing concern that the "majority's opinion * * * may also effectively invalidate the bar on scandalous marks"). In addition, by subjecting eligibility criteria established by Congress for participation in a voluntary federal program to the same strict First Amendment scrutiny that would apply to affirmative restrictions on the use of disparaging terms, the court of appeals blurred the line between statutory restrictions on speech and Congress's refusal to support or subsidize private communications. The potential implications of the court's decision for other government support programs provide a further reason for this Court's review.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

DONALD B. VERRILLI, JR.
Solicitor General
BENJAMIN C. MIZER
Principal Deputy Assistant Attorney General
MALCOLM L. STEWART
Deputy Solicitor General
NICOLE A. SAHARSKY
Assistant to the Solicitor General
DOUGLAS N. LETTER
MARK R. FREEMAN
DANIEL TENNY
JOSHUA M. SALZMAN
MOLLY R. SILFEN
Attorneys

SARAH HARRIS
General Counsel
THOMAS W. KRAUSE
Acting Solicitor
CHRISTINA J. HIEBER
THOMAS L. CASAGRANDE
MARY BETH WALKER
Associate Solicitors
U.S. Patent and Trademark Office

APRIL 2016

APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

No. 2014-1203

IN RE SIMON SHIAO TAM

Dec. 22, 2015

As Corrected Feb. 11, 2016

Before: PROST, Chief Judge, NEWMAN, LOURIE, DYK, MOORE, O'MALLEY, REYNA, WALLACH, TARANTO, CHEN, HUGHES, and STOLL, Circuit Judges.

Opinion for the court filed by Circuit Judge MOORE, in which Chief Judge PROST and Circuit Judges NEWMAN, O'MALLEY, WALLACH, TARANTO, CHEN, HUGHES, and STOLL join.

Concurring opinion filed by Circuit Judge O'MALLEY, in which Circuit Judge WALLACH joins.

Opinion concurring in part and dissenting in part filed by Circuit Judge DYK, in which Circuit Judges LOURIE and REYNA join with respect to parts I, II, III, and IV.

Dissenting opinion filed by Circuit Judge LOURIE.

Dissenting opinion filed by Circuit Judge REYNA.

MOORE, Circuit Judge.

Section 2(a) of the Lanham Act bars the Patent and Trademark Office ("PTO") from registering scandalous, immoral, or disparaging marks. 15 U.S.C. § 1052(a). The government enacted this law—and defends it today—because it disapproves of the messages conveyed by disparaging marks. It is a bedrock principle underlying the First Amendment that the government may not penalize private speech merely because it disapproves of the message it conveys. That principle governs even when the government's message-discriminatory penalty is less than a prohibition.

Courts have been slow to appreciate the expressive power of trademarks. Words—even a single word—can be powerful. Mr. Simon Shiao Tam named his band THE SLANTS to make a statement about racial and cultural issues in this country. With his band name, Mr. Tam conveys more about our society than many volumes of undisputedly protected speech. Another rejected mark, STOP THE ISLAMISATION OF AMERICA, proclaims that Islamisation is undesirable and should be stopped. Many of the marks rejected as disparaging convey hurtful speech that harms members of oft-stigmatized communities. But the First Amendment protects even hurtful speech.

The government cannot refuse to register disparaging marks because it disapproves of the expressive messages conveyed by the marks. It cannot refuse to register marks because it concludes that such marks will be disparaging to others. The government regulation at issue amounts to viewpoint discrimination, and under the strict scrutiny review appropriate for

government regulation of message or viewpoint, we conclude that the disparagement proscription of § 2(a) is unconstitutional. Because the government has offered no legitimate interests justifying § 2(a), we conclude that it would also be unconstitutional under the intermediate scrutiny traditionally applied to regulation of the commercial aspects of speech. We therefore vacate the Trademark Trial and Appeal Board's ("Board") holding that Mr. Tam's mark is unregistrable, and remand this case to the Board for further proceedings.

BACKGROUND

I. The Lanham Act

Congress enacted the Lanham Act in 1946 to provide a national system for registering and protecting trademarks used in interstate and foreign commerce. Congress's purpose in enacting the Lanham Act was to advance the two related goals of trademark law. First, the purpose of the Lanham Act is to "protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15, 112 S. Ct. 2753, 120 L. Ed. 2d 615 (1992) (Stevens, J., concurring) (quoting S. Rep. No. 791333, at 3 (1946)). Second, the Lanham Act ensures that a markholder can protect "his investment from . . . misappropriation by pirates and cheats." *Id.; see also Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 854 n.14, 102 S. Ct. 2182, 72 L. Ed. 2d 606 (1982) ("By applying a trademark to goods produced by one other than the trademark's owner, the infringer deprives the owner of the goodwill

which he spent energy, time, and money to obtain. At the same time, the infringer deprives consumers of their ability to distinguish among the goods of competing manufacturers." (citations omitted)).

"Registration is significant. The Lanham Act confers important legal rights and benefits on trademark owners who register their marks." *B & B Hardware, Inc. v. Hargis Ind., Inc.*, — U.S. —, 135 S. Ct. 1293, 1300, 191 L. Ed. 2d 222 (2015) (quotation marks omitted). These benefits—unavailable in the absence of federal registration—are numerous, and include both substantive and procedural rights. The holder of a federal trademark has a right to exclusive nationwide use of that mark where there was no prior use by others. *See* 15 U.S.C. §§ 1072, 1115. Because the common law grants a markholder the right to exclusive use only in the geographic areas where he has actually used his mark, *see* 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 26:32 (4th ed.) (hereinafter "McCarthy"), holders of a federally registered trademark have an important substantive right they could not otherwise obtain. Also, a registered mark is presumed to be valid, 15 U.S.C. § 1057(b), and the mark becomes incontestable (with certain exceptions) after five years of consecutive post- registration use, *id.* § 1065; *see also B & B Hardware*, 135 S. Ct. at 1310 ("Incontestability is a powerful protection."). A markholder may sue in federal court to enforce his trademark, 15 U.S.C. § 1121, and he may recover treble damages if he can show infringement was willful, *id.* § 1117. He may also obtain the assistance of U.S. Customs and Border Protection in restricting importation of infringing or counterfeit goods, *id.* § 1124, 19 U.S.C. § 1526, and

qualify for a simplified process for obtaining recognition and protection of his mark in countries that have signed the Paris Convention, *see id.* § 1141b (Madrid Protocol); Paris Convention for the Protection of Industrial Property art. 6 *quinquies*, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305. Lastly, registration operates as a complete defense to state or common law claims of trademark dilution. 15 U.S.C. § 1125(c)(6).

Under the Lanham Act, the PTO must register source-identifying trademarks unless the mark falls into one of several categories of marks precluded from registration. *Id.* § 1052 ("*No trademark* by which the goods of the applicant may be distinguished from the goods of others *shall be refused registration on the principal register on account of its nature* unless . . . . " (emphasis added)). Many of these categories bar the registration of deceptive or misleading speech, because such speech actually undermines the interests served by trademark protection and, thus, the Lanham Act's purposes in providing for registration. For example, a mark may not be registered if it resembles a registered mark such that its use is likely to "cause confusion, or to cause mistake, or to deceive," § 2(d), or if it is "deceptively misdescriptive," § 2(e). These restrictions on registration of deceptive speech do not run afoul of the First Amendment. *See Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 563, 100 S. Ct. 2343, 65 L. Ed. 2d 341 (1980) ("The government may ban forms of communication more likely to deceive the public than to inform it."); *see also Friedman v. Rogers*, 440 U.S. 1, 13, 15-16, 99 S. Ct. 887, 59 L. Ed. 2d 100 (1979); *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 462-63, 98 S. Ct. 1912, 56 L. Ed. 2d 444 (1978).

Section 2(a), however, is a hodgepodge of restrictions. Among them is the bar on registration of a mark that "[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute." Section 2(a) contains proscriptions against deceptive speech, for example, the prohibition on deceptive matter or the prohibition on falsely suggesting a connection with a person or institution. But other restrictions in § 2(a) differ in that they are based on the expressive nature of the content, such as the ban on marks that may disparage persons or are scandalous or immoral. These latter restrictions cannot be justified on the basis that they further the Lanham Act's purpose in preventing consumers from being deceived. These exclusions from registration do not rest on any judgment that the mark is deceptive or likely to cause consumer confusion, nor do they protect the markholder's investment in his mark. They deny the protections of registration for reasons quite separate from any ability of the mark to serve the consumer and investment interests underlying trademark protection. In fact, § 2(a)'s exclusions can undermine those interests because they can even be employed in cancellation proceedings challenging a mark many years after its issuance and after the markholder has invested millions of dollars protecting its brand identity and consumers have come to rely on the mark as a brand identifier.

This case involves the disparagement provision of § 2(a).[1] Section 2(a)'s ban on the federal registration of "immoral" or "scandalous" marks originated in the trademark legislation of 1905. *See* Act of Feb. 20, 1905, ch. 592, § 5(a), 33 Stat. 724, 725. The provision barring registration based on disparagement first appeared in the Lanham Act in 1946. Pub. L. 79-489, § 2(a), 60 Stat. 427, 428 (codified at 15 U.S.C. § 1052(a)). It had no roots in the earlier trademark statute or the common law. There were few marks rejected under the disparagement provision following enactment of the Lanham Act. Only in the last several decades has the disparagement provision become a more frequent ground of rejection or cancellation of trademarks. Marks that the PTO has found to be disparaging include: REDSKINS, *Pro-Football, Inc. v. Blackhorse*, No. 1-14-CV-01043-GBL, — F. Supp. 3d —, 2015 WL 4096277 (E.D. Va. July 8, 2015) (2014 PTO cancellation determination currently on appeal in Fourth Circuit); STOP THE ISLAMISATION OF AMERICA, *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014); THE CHRISTIAN PROSTITUTE (2013); AMISHHOMO (2013); MORMON WHISKEY (2012); KHORAN for wine, *In re Lebanese Arak Corp.*, 94

---

[1] We limit our holding in this case to the constitutionality of the § 2(a) disparagement provision. Recognizing, however, that other portions of § 2 may likewise constitute government regulation of expression based on message, such as the exclusions of immoral or scandalous marks, we leave to future panels the consideration of the § 2 provisions other than the disparagement provision at issue here. To be clear, we overrule *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981), and other precedent insofar as they could be argued to prevent a future panel from considering the constitutionality of other portions of § 2 in light of the present decision.

U.S.P.Q. 2d 1215 (T.T.A.B. Mar. 4, 2010); HAVE YOU HEARD THAT SATAN IS A REPUBLICAN? (2010); RIDE HARD RETARD (2009); ABORT THE REPUBLICANS (2009); HEEB, *In re Heeb Media, LLC*, 89 U.S.P.Q. 2d 1071 (T.T.A.B. Nov. 26, 2008); SEX ROD, *Bos. Red Sox Baseball Club L.P. v. Sherman*, 88 U.S.P.Q. 2d 1581 (T.T.A.B. Sept. 9, 2008) (sustaining an opposition on multiple grounds, including disparagement); MARRIAGE IS FOR FAGS (2008); DEMOCRATS SHOULDN'T BREED (2007); REPUBLICANS SHOULDN'T BREED (2007); 2 DYKE MINIMUM (2007); WET BAC/WET B.A.C. (2007); URBAN INJUN (2007); SQUAW VALLEY, *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q. 2d 1264 (T.T.A.B. June 2, 2006); DON'T BE A WET BACK (2006); FAGDOG (2003); N.I.G.G.A. NATURALLY INTELLIGENT GOD GIFTED AFRICANS (1996); a mark depicting a defecating dog, *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q. 2d 1635 (T.T.A.B. Mar. 30, 1988) (found to disparage Greyhound's trademarked running dog logo); an image consisting of the national symbol of the Soviet Union with an "X" over it, *In re Anti-Communist World Freedom Cong., Inc.*, 161 U.S.P.Q. 304 (T.T.A.B. Feb. 24, 1969); DOUGH-BOY for "a prophylactic preparation for the prevention of venereal diseases," *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. 227 (T.T.A.B. Jan. 25, 1951).

A disparaging mark is a mark which "dishonors by comparison with what is inferior, slights, deprecates, degrades, or affects or injures by unjust comparison." *Geller*, 751 F.3d at 1358 (alterations omitted). To determine if a mark is disparaging under § 2(a), a trademark examiner of the PTO considers:

> (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
>
> (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

Trademark Manual of Exam. Proc. ("TMEP") § 1203.03(b)(i) (Jan. 2015 ed.) (citing *Geller*, 751 F.3d at 1358). If the examiner "make[s] a prima facie showing that a substantial composite, although not necessarily a majority, of the referenced group would find the proposed mark, as used on or in connection with the relevant goods or services, to be disparaging in the context of contemporary attitudes," the burden shifts to the applicant for rebuttal. *Id.* If the applicant fails to rebut the prima facie case of disparagement, the examiner refuses to register the mark. The Trademark Manual of Examining Procedure does not require an examiner who finds a mark disparaging to consult her supervisor or take any further steps to ensure the provision is applied fairly and consistently across the agency. *Compare* TMEP § 1203.03 (no discussion of action to take if examiner finds mark disparaging), *with* TMEP § 1203.01 (requiring examiner who finds a mark scandalous or immoral to consult his supervisor). A single examiner, with no input from her supervisor, can reject a mark as disparaging by

determining that it would be disparaging to a substantial composite of the referenced group.

II. Facts of This Case

Mr. Tam is the "front man" for the Asian-American dance-rock band The Slants. Mr. Tam named his band The Slants to "reclaim" and "take ownership" of Asian stereotypes. J.A. 129-30. The band draws inspiration for its lyrics from childhood slurs and mocking nursery rhymes, J.A. 130, and its albums include "The Yellow Album" and "Slanted Eyes, Slanted Hearts." The band "feel[s] strongly that Asians should be proud of their cultural heri[ta]ge, and not be offended by stereotypical descriptions." J.A. 52. With their lyrics, performances, and band name, Mr. Tam and his band weigh in on cultural and political discussions about race and society that are within the heartland of speech protected by the First Amendment.

On November 14, 2011, Mr. Tam filed the instant application (App. No. 85/472,044) seeking to register the mark THE SLANTS for "Entertainment in the nature of live performances by a musical band," based on his use of the mark since 2006.[2] The examiner refused to register Mr. Tam's mark, finding it likely disparaging to "persons of Asian descent" under § 2(a). The examiner found that the mark likely referred to

---

[2] This is Mr. Tam's second application for the mark THE SLANTS. In 2010, Mr. Tam filed App. No. 77/952,263 seeking to register the mark for "Entertainment, namely, live performances by a musical band." The examiner found the mark disparaging to people of Asian descent under § 2(a) and therefore refused to register it. Mr. Tam appealed that refusal to the Board, but the case was dismissed for failure to file a brief.

people of Asian descent in a disparaging way, explaining that the term "slants" had "a long history of being used to deride and mock a physical feature" of people of Asian descent. J.A. 42. And even though Mr. Tam may have chosen the mark to "reappropriate the disparaging term," the examiner found that a substantial composite of persons of Asian descent would find the term offensive. J.A. 43.

The Board affirmed the examiner's refusal to register the mark. The Board wrote that "it is abundantly clear from the record not only that THE SLANTS . . . would have the 'likely meaning' of people of Asian descent but also that such meaning has been so perceived and has prompted significant responses by prospective attendees or hosts of the band's performances." *In re Tam*, No. 85472044, 2013 WL 5498164, at *5 (T.T.A.B. Sept. 26, 2013) ("*Board Opinion*"). To support its finding that the mark likely referred to people of Asian descent, the Board pointed to dictionary definitions, the band's website, which displayed the mark next to "a depiction of an Asian woman, utilizing rising sun imagery and using a stylized dragon image," and a statement by Mr. Tam that he selected the mark in order to "own" the stereotype it represents. *Id.* The Board also found that the mark is disparaging to a substantial component of people of Asian descent because "[t]he dictionary definitions, reference works and all other evidence unanimously categorize the word 'slant,' when meaning a person of Asian descent, as disparaging," and because there was record evidence of individuals and groups in the Asian community objecting to Mr. Tam's use of the word. *Id.* at *7. The Board

therefore disqualified the mark for registration under § 2(a).

Mr. Tam appealed, arguing that the Board erred in finding the mark disparaging and that § 2(a) is unconstitutional. On appeal, a panel of this Court affirmed the Board determination that the mark is disparaging.[3] *In re Tam*, 785 F.3d 567, 570-71 (Fed. Cir. 2015) ("*Panel Opinion*"), *reh'g en banc granted, opinion vacated*, 600 Fed. Appx. 775 (Fed. Cir. 2015) ("*En Banc Order*"). Although the term "slants" has several meanings, the panel found that substantial evidence supported the Board's finding that the mark likely refers to people of Asian descent. *Panel Op.* at 570-71. This included an article in which Mr. Tam described the genesis of the band's name by explaining: "I was trying to think of things that people associate with Asians. Obviously, one of the first things people say is that we have slanted eyes. . . . " *Id.* at 570 (quoting J.A. 130). Moreover, the band's Wikipedia page stated that the band's name is "derived from an ethnic slur for Asians." *Id.* (quoting J.A. 57). The Wikipedia entry quoted Mr. Tam: "We want to take on these stereotypes that people have about us, like the slanted eyes, and own them. We're very proud of being Asian—we're not going to hide that fact. The reaction from the Asian community has been positive." J.A. 57. The record included an image from the band's website in which the mark THE SLANTS is set against Asian imagery. *Id.* (citing J.A. 59). Finally, the record included unrebutted evidence that both individuals and Asian groups have

---

[3] We reinstate the panel's holding that Mr. Tam's mark is disparaging.

perceived the term as referring to people of Asian descent. *Id.* at 570-71 (citing, e.g., J.A. 95 ("[Mr. Tam] was initially slated to give the keynote address at the 2009 Asian American Youth Leadership Conference in Portland. But some conference supporters and attendees felt the name of the band was offensive and racist, and out of respect for these opinions the conference organizers decided to choose someone less controversial.")).

The panel also found that substantial evidence supported the Board's finding that the mark is disparaging to a substantial composite of people of Asian descent. *Panel Op.* at 571. It noted that the definitions in evidence universally characterize the word "slant" as disparaging, offensive, or an ethnic slur when used to refer to a person of Asian descent, including the dictionary definitions provided by Mr. Tam. *Id.* The record also included a brochure published by the Japanese American Citizens League describing the term "slant," when used to refer to people of Asian descent, as a "derogatory term" that is "demeaning" and "cripple[s] the spirit." *Id.* (quoting J.A. 48-49). Finally, the record included news articles and blog posts discussing the offensive nature of the band's name. *Id.* (citing *Board Op.* at *2-3; J.A. 45, 51, 94-98, 100).

Having found the mark disparaging under § 2(a), the panel held that binding precedent foreclosed Mr. Tam's arguments that § 2(a) is unconstitutional, including Mr. Tam's argument that § 2(a) violates the First Amendment on its face. *Panel Op.* at 572-73. As the panel explained, in *McGinley*, our predecessor court held that the refusal to register a mark under

§ 2(a) does not bar the applicant from using the mark, and therefore does not implicate the First Amendment. *Id.* at 572 (citing *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981)). The entirety of the *McGinley* analysis was:

> With respect to appellant's First Amendment rights, it is clear that the PTO's refusal to register appellant's mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark.

660 F.2d at 484 (citations omitted). In subsequent cases, panels of this Court relied on the holding in *McGinley*. *See In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012); *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003); *In re Mavety Media Grp.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994). Additional views by the panel's authoring judge questioned whether the en banc court should reconsider the constitutionality of § 2(a) en banc. *Panel Op.* at 573-85 (Moore, J., additional views).

More than thirty years have passed since the decision in *McGinley*, and in that time both the *McGinley* decision and our reliance on it have been widely criticized.[4] *Id.* at 573-74. Furthermore, the *McGinley*

---

[4] *See, e.g.*, *Ritchie v. Simpson*, 170 F.3d 1092, 1103 & n.1 (Fed. Cir. 1999) (Newman, J., dissenting); *Pro-Football Inc. v. Harjo*, No. 99-1385(CKK), 2000 WL 1923326, at *4 (D.D.C. Dec. 11, 2000); Stephen Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REPORTER 661, 685-86 (1993); Justin G. Blankenship, *The Cancellation of Redskins as a Disparaging*

analysis was cursory, without citation to legal authority, and decided at a time when the First Amendment had only recently been applied to commercial speech. *Id.* at 574, 581 (citing *Cent. Hudson*, 447 U.S. at 566, 100 S. Ct. 2343). First Amendment jurisprudence on the unconstitutional conditions doctrine and the protection accorded to commercial speech has evolved significantly since the *McGinley* decision. *Id.* at 574; *see also id.* at 574-580 (describing evolution of commercial speech doctrine and unconstitutional conditions doctrine).

Trademark: Is Federal Trademark Law an Appropriate Solution for Words That Offend?, 72 U. COLO. L. REV. 415, 443-44 (2001); Terence Dougherty, *Group Rights to Cultural Survival: Intellectual Property Rights in Native American Cultural Symbols*, 29 COLUM. HUM. RTS. L. REV. 355, 383 (1998); Bruce C. Kelber, *"Scalping the Redskins:" Can Trademark Law Start Athletic Teams Bearing Native American Nicknames and Images on the Road to Racial Reform?*, 17 HAMLINE L. REV. 533, 556 (1994); Paul Kuruk, *Goading a Reluctant Dinosaur: Mutual Recognition Agreements as a Policy Response to the Misappropriation of Foreign Traditional Knowledge in the United States*, 34 PEPP. L. REV. 629, 662 n.209 (2007); Michelle B. Lee, *Section 2(a) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?*, 4 SPORTS L.J. 65, 66-67 (1997); Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of Redskins?*, 52 STAN. L. REV. 665, 676-77 (2000); Nell Jessup Newton, *Memory and Misrepresentation: Representing Crazy Horse*, 27 CONN. L. REV. 1003, 1030 n.109 (1995); Ron Phillips, *A Case for Scandal and Immorality: Proposing Thin Protection of Controversial Trademarks*, 17 U. BALT. INTELL. PROP. L.J. 55, 67-68 (2008); Jendi Reiter, *Redskins and Scarlet Letters: Why "Immoral" and "Scandalous" Trademarks Should Be Federally Registrable*, 6 FED. CIR. BAR. J. 191, 197 (1996); Lilit Voskanyan, *The Trademark Principal Register as a Nonpublic Forum*, 75 U. CHI. L. REV. 1295, 1302 (2008).

Other courts' reliance on the reasoning in *McGinley* further reinforces the importance of taking this case en banc. Without analysis, the Fifth Circuit wrote that "[w]e join our sister circuit in rejecting [the applicant's] argument that prohibiting him from registering a mark with the PTO violates his [F]irst [A]mendment rights." *Test Masters Educ. Servs., Inc. v. Singh*, 428 F.3d 559, 578 n.9 (5th Cir. 2005). And a district court in the Eastern District of Virginia relied upon *McGinley* when it concluded that the cancellation of trademark registrations under § 2(a) did not implicate the First Amendment. *Pro-Football, Inc.*, — F. Supp. 3d at —, 2015 WL 4096277, at *8-10 ("[T]he Court agrees with the Federal Circuit and Fifth Circuit and holds that Section 2(a) of the Lanham Act does not implicate the First Amendment.").

For these reasons, we sua sponte ordered rehearing en banc. We asked the parties to file briefs on the following issue:

> Does the bar on registration of disparaging marks in 15 U.S.C. § 1052(a) violate the First Amendment?

En Banc Order at 775. In addition to the parties' briefs, we received ten amicus briefs. We heard oral argument on October 2, 2015.

DISCUSSION

I. Section 2(a)'s Denial of Important Legal Rights to Private Speech Based on Disapproval of the Message Conveyed Is Subject to, and Cannot Survive, Strict Scrutiny

Strict scrutiny is used to review any governmental regulation that burdens private speech based on disapproval of the message conveyed. Section 2(a),

which denies important legal rights to private speech on that basis, is such a regulation. It is therefore subject to strict scrutiny. It is undisputed that it cannot survive strict scrutiny.

A. The Disparagement Provision, Which Discriminates Based on Disapproval of the Message, Is Not Content or Viewpoint Neutral

"Content-based regulations are presumptively invalid." *R.A.V. v. City of St. Paul*, 505 U.S. 377, 382, 112 S. Ct. 2538, 120 L. Ed. 2d 305 (1992); *see also Ashcroft v. ACLU*, 542 U.S. 656, 660, 124 S. Ct. 2783, 159 L. Ed. 2d 690 (2004). "Content-based laws—those that target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests." *Reed v. Town of Gilbert*, — U.S. —, 135 S. Ct. 2218, 2226, 192 L. Ed. 2d 236 (2015); *see also Police Dep't of Chi. v. Mosley*, 408 U.S. 92, 95, 92 S. Ct. 2286, 33 L. Ed. 2d 212 (1972) ("[A]bove all else, the First Amendment means that the government has no power to restrict expression because of its message, its ideas, its subject matter, or its content."). A regulation is content based even when its reach is defined simply by the topic (subject matter) of the covered speech. *See Reed*, 135 S. Ct. at 2230.

Viewpoint-based regulations, targeting the substance of the viewpoint expressed, are even more suspect. They are recognized as a particularly "egregious form of content discrimination," *id.*, though they have sometimes been discussed without being cleanly separated from topic discrimination, *see, e.g., Mosley*, 408 U.S. at 95, 92 S. Ct. 2286. Such measures

"raise[] the specter that the government may effectively drive certain ideas or viewpoints from the marketplace." *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 116, 112 S. Ct. 501, 116 L. Ed. 2d 476 (1991); *see also Sorrell v. IMS Health Inc.*, — U.S. —, 131 S. Ct. 2653, 2667, 180 L. Ed. 2d 544 (2011); *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 828, 115 S. Ct. 2510, 132 L. Ed. 2d 700 (1995). "The First Amendment requires heightened scrutiny whenever the government creates 'a regulation of speech because of disagreement with the message it conveys.'" *Sorrell*, 131 S. Ct. at 2664 (quoting *Ward v. Rock Against Racism*, 491 U.S. 781, 791, 109 S. Ct. 2746, 105 L. Ed. 2d 661 (1989)). This is true whether the regulation bans or merely burdens speech. "[H]eightened judicial scrutiny is warranted" when an act "is designed to impose a specific, content-based burden on protected expression." *Id.*; *see also Rosenberger*, 515 U.S. at 828, 115 S. Ct. 2510 ("[T]he government offends the First Amendment when it imposes financial burdens on certain speakers based on the content of their expression."). "The distinction between laws burdening and laws banning speech is but a matter of degree. The Government's content-based burdens must satisfy the same rigorous scrutiny as its content-based bans." *United States v. Playboy Entm't Grp., Inc.*, 529 U.S. 803, 812, 120 S. Ct. 1878, 146 L. Ed. 2d 865 (2000). "Lawmakers may no more silence unwanted speech by burdening its utterance than by censoring its content." *Sorrell*, 131 S. Ct. at 2664; *see also infra* at 1340.

It is beyond dispute that § 2(a) discriminates on the basis of content in the sense that it "applies to particular speech because of the topic discussed." *Reed*,

135 S. Ct. at 2227. Section 2(a) prevents the registration of disparaging marks—it cannot reasonably be argued that this is not a content-based restriction or that it is a content-neutral regulation of speech. And the test for disparagement—whether a substantial composite of the referenced group would find the mark disparaging—makes clear that it is the nature of the message conveyed by the speech which is being regulated. If the mark is found disparaging by the referenced group, it is denied registration. "Listeners' reaction to speech is not a content-neutral basis for regulation." *Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123, 134, 112 S. Ct. 2395, 120 L. Ed. 2d 101 (1992).

And § 2(a) does more than discriminate on the basis of topic. It also discriminates on the basis of message conveyed, "the idea or message expressed," *Reed*, 135 S. Ct. at 2227; it targets "viewpoints [in] the marketplace," *Simon & Schuster*, 502 U.S. at 116, 112 S. Ct. 501. It does so as a matter of avowed and undeniable purpose, and it does so on its face.[5]

---

[5] Both parties agree that this appeal is appropriately viewed as involving a facial challenge. A law is facially invalid if "a substantial number of its applications are unconstitutional, judged in relation to the statute's plainly legitimate sweep." *Wash. State Grange v. Wash. State Republican Party*, 552 U.S. 442, 449 n.6, 128 S. Ct. 1184, 170 L. Ed. 2d 151 (2008) (internal quotation marks omitted). In other words, to succeed in his facial challenge, Mr. Tam must "demonstrate a substantial risk that application of the provision will lead to the suppression of speech." *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 580, 118 S. Ct. 2168, 141 L. Ed. 2d 500 (1998). The marks refused registration under the disparagement provision are protected speech. And the government refused to register all of these marks because it found they

First, the government enacted and continues to defend § 2(a) "because of disagreement with the message [disparaging marks] convey[]." *Sorrell*, 131 S. Ct. at 2664. When the government refuses to register a mark under § 2(a), it does so because it disapproves of "the message a speaker conveys" by the mark. *Reed*, 135 S. Ct. at 2227. Underscoring its hostility to these messages, the government repeatedly asserts in its briefing before this court that it ought to be able to prevent the registration of "the most vile racial epithets and images," Appellee's En Banc Br. 1, and "to dissociate itself from speech it finds odious," *id.* 41. The legislative history of § 2(a) reinforces this conclusion. *See* Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong., 1st Sess. 18-21 (1939) (statement of Rep. Thomas E. Robertson) (Rep. Maroney) ("[W]e would not want to have Abraham Lincoln gin."); *id.* (Rep. Rogers) (stating that a mark like "Abraham Lincoln gin ought not to be used," and that § 2(a) "would take care of [such] abuses"). From its enactment in 1946 through its defense of the statute today, the government has argued that the prohibited marks

---

convey a disparaging message. More than a "substantial number" of § 2(a)'s applications of the disparagement provision rest on disapproval of the expressive message conveyed—every rejection under the disparagement provision is a message-based denial of otherwise-available legal rights. Thus, we conclude that § 2(a) is invalid on its face. That conclusion follows from the standards for First Amendment facial invalidation and also fits the rationale for those standards: it avoids maintaining on the books a rule that called for case-by-case litigation over particular marks, based on speakers' intent and government interests or other factors, which would threaten to produce the very chilling effect that First Amendment facial-invalidity standards condemn.

ought not to be registered because of the messages the marks convey. When the government discriminates against speech because it disapproves of the message conveyed by the speech, it discriminates on the basis of viewpoint. *Sorrell*, 131 S. Ct. at 2664.

The legal significance of viewpoint discrimination is the same whether the government disapproves of the message or claims that some part of the populace will disapprove of the message. This point is recognized in the Supreme Court's long-standing condemnation of government impositions on speech based on adverse reactions among the public. *See, e.g., Snyder v. Phelps*, 562 U.S. 443, 460-61, 131 S. Ct. 1207, 179 L. Ed. 2d 172 (2011); *R.A.V.*, 505 U.S. 377, 112 S. Ct. 2538, 120 L. Ed. 2d 305; *Texas v. Johnson*, 491 U.S. 397, 414, 109 S. Ct. 2533, 105 L. Ed. 2d 342 (1989).

Second, the disparagement provision at issue is viewpoint discriminatory on its face. The PTO rejects marks under § 2(a) when it finds the marks refer to a group in a negative way, but it permits the registration of marks that refer to a group in a positive, non-disparaging manner. In this case the PTO refused to register Mr. Tam's mark because it found the mark "disparaging" and "objectionable" to people of Asian descent. *Tam*, 2013 WL 5498164, at *6. But the PTO has registered marks that refer positively to people of Asian descent. *See, e.g.*, CELEBRASIANS, ASIAN EFFICIENCY. Similarly, the PTO has prohibited the registration of marks that it found disparaged other groups. *See, e.g., Pro-Football*, — F. Supp. 3d —, 2015 WL 4096277 (affirming cancellation of REDSKINS); *Geller*, 751 F.3d 1355 (affirming rejection of STOP THE ISLAMISATION OF

AMERICA); *Lebanese Arak Corp.*, 94 U.S.P.Q. 2d 1215 (refusing to register KHORAN for wine); *Heeb Media*, 89 U.S.P.Q. 2d 1071 (refusing to register HEEB); *Squaw Valley Dev. Co.*, 80 U.S.P.Q. 2d 1264 (refusing to register SQUAW VALLEY for one class of goods, but registering it for another). Yet the government registers marks that refer to particular ethnic groups or religions in positive or neutral ways—for example, NAACP, THINK ISLAM, NEW MUSLIM COOL, MORMON SAVINGS, JEWISHSTAR, and PROUD 2 B CATHOLIC.

The government argues that § 2(a) is viewpoint neutral because it does not eliminate any particular view-point—only particular words. Appellee's En Banc Br. 39-40. It argues that under § 2(a), two marks with diametrically opposed viewpoints will both be refused, so long as those marks use the same disparaging term. *Id.* 39-40. It points to Mr. Tam—who does not seek to express an anti-Asian viewpoint—as proof. It cites a statement in *R.A.V.* that a hypothetical statute that prohibited "odious racial epithets . . . to proponents of all views" would not be viewpoint discriminatory. *Id.* 40 (quoting 505 U.S. at 391, 112 S. Ct. 2538); *see also Ridley v. Mass. Bay Transp. Auth.*, 390 F.3d 65, 90-91 (1st Cir. 2004) (holding that "guidelines prohibiting demeaning or disparaging ads are themselves viewpoint neutral").

The *R.A.V.* statement does not apply here. The government's starting point—that it rejects marks conveying diametrically opposed viewpoints, if they contain the same offensive word—is incorrect. The PTO looks at what message the referenced group takes from the applicant's mark in the context of the

applicant's use, and it denies registration only if the message received is a negative one. Thus, an applicant can register a mark if he shows it is perceived by the referenced group in a positive way, even if the mark contains language that would be offensive in another context. For example, the PTO registered the mark DYKES ON BIKES, U.S. Reg. No. 3,323,803, after the applicant showed the term was often enough used with pride among the relevant population. In *Squaw Valley*, the Board allowed the registration of the mark SQUAW VALLEY in connection with one of the applied-for classes of goods (namely, skiing-related products), but not in connection with a different class of goods. 80 U.S.P.Q. 2d at *22. Section 2(a) does not treat identical marks the same. A mark that is viewed by a substantial composite of the referenced group as disparaging is rejected. It is thus the viewpoint of the message conveyed which causes the government to burden the speech. This form of regulation cannot reasonably be argued to be content neutral or viewpoint neutral.

The government's argument also fails because denial of registration under § 2(a) turns on the referenced group's perception of a mark. Speech that is offensive or hostile to a particular group conveys a distinct viewpoint from speech that carries a positive message about the group. STOP THE ISLAMISATION OF AMERICA and THINK ISLAM express two different viewpoints. Under § 2(a), one of these viewpoints garners the benefits of registration, and one does not. The government enacted § 2(a), and defends it today, because it is hostile to the messages conveyed by the refused marks. Section 2(a) is a viewpoint-discriminatory regulation of speech, created

and applied in order to stifle the use of certain disfavored messages. Strict scrutiny therefore governs its First Amendment assessment—and no argument has been made that the measure survives such scrutiny.

B. The Disparagement Provision Regulates the Expressive Aspects of the Mark, Not Its Function As Commercial Speech

The government cannot escape strict scrutiny by arguing that § 2(a) regulates commercial speech. True, trademarks identify the source of a product or service, and therefore play a role in the "dissemination of information as to who is producing and selling what product, for what reason, and at what price." *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 765, 96 S. Ct. 1817, 48 L. Ed. 2d 346 (1976). But they very commonly do much more than that. And, critically, it is always a mark's expressive character, not its ability to serve as a source identifier, that is the basis for the disparagement exclusion from registration. The disparagement provision must be assessed under First Amendment standards applicable to what it targets, which is not the commercial-speech function of the mark.

This case exemplifies how marks often have an expressive aspect over and above their commercial-speech aspect. Mr. Tam explicitly selected his mark to create a dialogue on controversial political and social issues. With his band name, Mr. Tam makes a statement about racial and ethnic identity. He seeks to shift the meaning of, and thereby reclaim, an emotionally charged word. He advocates for social change and challenges perceptions of people of Asian descent. His band name pushes people. It offends.

Despite this—indeed, because of it—Mr. Tam's band name is expressive speech.

Importantly, *every time* the PTO refuses to register a mark under § 2(a), it does so because it believes the mark conveys an expressive message—a message that is disparaging to certain groups. STOP THE ISLAMISATION OF AMERICA is expressive. In refusing to register the mark, the Board explained that the "mark's admonition to 'STOP' Islamisation in America 'sets a negative tone and signals that Islamization is undesirable and is something that must be brought to an end in America.'" *Geller*, 751 F.3d at 1361. And by finding HEEB and SQUAW VALLEY disparaging, the PTO necessarily did so based on its finding that the marks convey an expressive message over and above their function as source identifiers —namely, an expressive message disparaging Jewish and Native American people. It was these expressive messages that the government found objectionable, and that led the government to refuse to register or to cancel the marks. In doing so, the government made moral judgments based solely and indisputably on the marks' expressive content. Every single time registration is refused or cancelled pursuant to the disparagement provision, it is based upon a determination by the government that the expressive content of the message is unsuitable because it would be viewed by the referenced group as disparaging them.

"Commercial speech is no exception" to the need for heightened scrutiny of content-based impositions seeking to curtail the communication of particular information or messages. *Sorrell*, 131 S. Ct. at 2664. Indeed, "[a] consumer's concern for the free flow of com-

mercial speech often may be far keener than his concern for urgent political dialogue." *Id.* (internal quotation marks omitted). Strict scrutiny must apply to a government regulation that is directed at the expressive component of speech. That the speech is used in commerce or has a commercial component should not change the inquiry when the government regulation is entirely directed to the expressive component of the speech. This is not a government regulation aimed at the commercial component of speech. *See Va. State Bd. of Pharmacy*, 425 U.S. at 765, 96 S. Ct. 1817 (commercial speech involves the "dissemination of information as to who is producing and selling what product, for what reason, and at what price"); *see id.* at 762, 96 S. Ct. 1817 (defining "commercial speech" as speech that does "no more than propose a commercial transaction"); *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 473-74, 109 S. Ct. 3028, 106 L. Ed. 2d 388 (1989); *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 423, 113 S. Ct. 1505, 123 L. Ed. 2d 99 (1993).

In *R.A.V.*, the Supreme Court explained the key point: under First Amendment law, government measures often affect speech that has a dual character, and when they do, which First Amendment standard is applicable depends on which aspect of the speech is targeted by the measure being reviewed. *See* 505 U.S. at 385, 112 S. Ct. 2538 ("The proposition that a particular instance of speech can be proscribable on the basis of one feature (*e.g.*, obscenity) but not on the basis of another (*e.g.*, opposition to the city government) is commonplace and has found application in many contexts."). In particular, commercial speech that is "inextricably intertwined" with expressive

speech is treated as expressive speech under the First Amendment when the expressive aspect is being regulated. *Riley v. Nat'l Fed'n of the Blind*, 487 U.S. 781, 796, 108 S. Ct. 2667, 101 L. Ed. 2d 669 (1988). Here, § 2(a) targets speech that is of "public concern," because it "can be fairly considered as relating to any matter of political, social, or other concern to the community." *Snyder v. Phelps*, 562 U.S. 443, 453, 131 S. Ct. 1207, 179 L. Ed. 2d 172 (2011) (internal quotation marks omitted). It therefore "occupies the highest rung of the hierarchy of First Amendment values, and is entitled to special protection." *Id.* at 452, 131 S. Ct. 1207 (internal quotation marks omitted).

Because § 2(a) discriminates on the basis of the content of the message conveyed by the speech, it follows that it is presumptively invalid, and must satisfy strict scrutiny to be found constitutional. "In the ordinary case it is all but dispositive to conclude that a law is content-based and, in practice, viewpoint-discriminatory." *Sorrell*, 131 S. Ct. at 2667. The government here does not even argue that § 2(a) satisfies strict scrutiny.

II. Section 2(a) Is Not Saved From Strict Scrutiny Because It Bans No Speech or By Government-Speech or Government-Subsidy Doctrines

Faced with the daunting prospect of defending a content- and viewpoint-discriminatory regulation of speech, the government argues that § 2(a) does not implicate the First Amendment at all. First, the government suggests that § 2(a) is immune from First Amendment scrutiny because it prohibits no speech, but leaves Mr. Tam free to name his band as he wishes and use this name in commerce. Second, the govern-

ment suggests that trademark registration is government speech, and thus the government can grant and reject trademark registrations without implicating the First Amendment. Finally, the government argues that § 2(a) merely withholds a government subsidy for Mr. Tam's speech and is valid as a permissible definition of a government subsidy program. We reject each of the government's arguments.

A. Strict Scrutiny Applies to § 2(a), Which Significantly Chills Private Speech on Discriminatory Grounds, Though It Does Not Ban Speech

The government argues that § 2(a) does not implicate the First Amendment because it does not prohibit any speech. Appellee's En Banc Br. 17. The government's argument is essentially the same as that of our predecessor court in *McGinley*: "it is clear that the PTO's refusal to register appellant's mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed." 660 F.2d at 484 (citations omitted). But the First Amendment's standards, including those broadly invalidating message discrimination, are not limited to such prohibitions. *See Pitt News v. Pappert*, 379 F.3d 96, 111-12 (3d Cir. 2004) (Alito, J.) ("The threat to the First Amendment arises from the imposition of financial burdens that may have the effect of influencing or suppressing speech, and whether those burdens take the form of taxes or some other form is unimportant.").

The point has been recognized in various doctrinal settings. "For if the government could deny a benefit to a person because of his constitutionally protected speech or associations, his exercise of those freedoms

would in effect be penalized and inhibited. This would allow the government to produce a result which it could not command directly." *Perry v. Sindermann*, 408 U.S. 593, 597, 92 S. Ct. 2694, 33 L. Ed. 2d 570 (1972) (internal quotation marks and alterations omitted). This premise—that denial of a benefit would chill exercise of the constitutional right—undergirds every unconstitutional conditions doctrine case, discussed *infra*. *See, e.g.*, *Speiser v. Randall*, 357 U.S. 513, 518, 78 S. Ct. 1332, 2 L. Ed. 2d 1460 (1958) ("It is settled that speech can be effectively limited by the exercise of the taxing power. To deny an exemption to claimants who engage in certain forms of speech is in effect to penalize them for such speech." (citation omitted)); *Bd. of Cty. Comm'rs v. Umbehr*, 518 U.S. 668, 674, 116 S. Ct. 2342, 135 L. Ed. 2d 843 (1996) (loss of a valuable benefit "in retaliation for speech may chill speech on matters of public concern"); *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 545, 121 S. Ct. 1043, 149 L. Ed. 2d 63 (2001); *Rosenberger*, 515 U.S. at 835, 115 S. Ct. 2510 (explaining that "[v]ital First Amendment speech principles are at stake here," including danger arising "from the chilling of individual thought and expression").

The general principle is clear: "Lawmakers may no more silence unwanted speech by burdening its utterance than by censoring its content." *Sorrell*, 131 S. Ct. at 2664. "[T]he government's ability to impose content-based burdens on speech raises the specter that the government may effectively drive certain ideas or viewpoints from the marketplace." *Simon & Schuster*, 502 U.S. at 116, 112 S. Ct. 501. A law may burden speech even when it does so indirectly. In *Sorrell*, the challenged statute did not directly ban

speech, but rather forbade certain pharmaceutical marketing executives from obtaining and using information that could help them market their products more effectively. 131 S. Ct. at 2659-60. The Court found that the state "ha[d] burdened a form of protected expression," while leaving "unburdened those speakers whose messages are in accord with its own views." *Id.* at 2672.

Here, too, § 2(a) burdens some speakers and benefits others. And while it is true that a trademark owner may use its mark in commerce even without federal registration, it has been widely recognized that federal trademark registration bestows *truly* significant and financially valuable benefits upon markholders. *B & B Hardware*, 135 S. Ct. at 1300; *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 199-200, 105 S. Ct. 658, 83 L. Ed. 2d 582 (1985) (valuable new rights were created by the Lanham Act); McCarthy at § 19:9, :11 ("Registration of a mark on the federal Principal Register confers a number of procedural and substantive legal advantages over reliance on common law rights. . . . Registration on the Principal Register should be attempted if it is at all possible."); McCarthy at § 2:14 ("Businesspeople regard trademarks as valuable assets and are willing to pay large sums to buy or license a well-known mark."); Lee Ann W. Lockridge, *Abolishing State Trademark Registrations*, 29 Cardozo Arts & Ent. L.J. 597, 605 (2011) ("[T]he incentives to pursue federal registration . . . are now so significant as to make federal registration indispensable for any owner making an informed decision about its trademark rights. A federal registration is the only rational choice."); Susan M. Richey, *The Second Kind of Sin: Making the*

Case for a Duty to Disclose Facts Related to Genericism and Functionality in the Trademark Office, 67 Wash. & Lee L. Rev. 137, 174 (2010) ("Federal registration has evolved into a powerful tool for trademark holders. . . . "); Patricia Kimball Fletcher, *Joint Registration of Trademarks and the Economic Value of a Trademark System*, 36 U. Miami L. Rev. 297, 298-99 (1982) ("Federal registration under the Lanham Act is advantageous, however, because it increases the owner's legal rights in the mark, making the mark itself more valuable. Thus, trademark owners have significant legal and economic interests in obtaining federal registration of trademarks.").

Denial of these benefits creates a serious disincentive to adopt a mark which the government may deem offensive or disparaging. Br. of Amici Curiae ACLU 12 ("If a group fears that its chosen name will be denied federal trademark protection by the government's invocation of Section 2(a), it will be less likely to adopt the name, at least in part because the associative value of the trademark itself is lessened when it is unlikely that a group will be the exclusive holder of that mark."); Br. of Amicus Curiae Pro-Football, Inc. 15 ("Section 2(a) certainly works to chill speech. . . . Through it, the Government uses threatened denial of registration to encourage potential registrants not to use 'disparaging' names. Faced with the possibility of being denied a registration—or worse, cancellation after years of investment-backed brand development —new brand owners are more likely to avoid brand names that may be arguably controversial for fear of later being deemed 'disparaging.'"); Br. of Amicus Curiae First Amendment Lawyers Ass'n 7 ("Individuals and businesses refrain from using certain terms as

trademarks for fear the PTO might see the terms as immoral, scandalous, or derogatory, in violation of section 2(a). Such self-censorship narrows the spectrum of speech in the public marketplace."); Br. of Amici Curiae Rutherford Inst. 12 ("Denial of registration indisputably has the effect of placing applicants at a legal and financial disadvantage."); Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of Redskins?*, 52 Stan. L. Rev. 665, 678 (2000) ("[I]t is clear that section 2(a) of the Lanham Act, by denying the valuable registration right to scandalous or disparaging trademarks, imposes a financial disincentive to the use of such marks in commercial communication."); Michelle B. Lee, *Section 2(a) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?*, 4 Sports L.J. 65, 69 (1997) ("Use [of disparaging marks] is discouraged by cancellation of registration by a loss of the benefits that go along with it. These benefits go well beyond those granted by the common law, and a loss of them will remove advantages which make the property more valuable.").

For those reasons, the § 2(a) bar on registration creates a strong disincentive to choose a "disparaging" mark. And that disincentive is not cabined to a clearly understandable range of expressions. The statute extends the uncertainty to marks that "may disparage." 15 U.S.C. § 1052(a). The uncertainty as to what *might be deemed* disparaging is not only evident on its face, given the subjective-reaction element and shifting usages in different parts of society.[6] It is

---

[6] In 1939, the Assistant Commissioner of Patents testified during congressional hearings on the Lanham Act that "it is always going

confirmed by the record of PTO grants and denials over the years, from which the public would have a hard time drawing much reliable guidance.[7]

---

to be just a matter of the personal opinion of the individual parties as to whether they think it is disparaging." *See* Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong., 1st Sess. 18-21 (1939) (statement of Leslie Frazer, Assistant Comm'r of Patents) (Mr. Frazer). And further interpretation has helped little. The definition of a disparaging mark—a mark that "dishonors by comparison with what is inferior, slights, deprecates, degrades, or affects or injures by unjust comparison"—provides little clarity. *Geller*, 751 F.3d at 1358 (alterations omitted). In *In re In Over Our Heads*, the PTO admitted that "[t]he guidelines for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one." No. 755,278, 1990 WL 354546, at *1 (T.T.A.B. 1990) (alterations and quotation marks omitted).

[7] The PTO's record of trademark registrations and denials often appears arbitrary and is rife with inconsistency. The PTO denied the mark HAVE YOU HEARD SATAN IS A REPUBLICAN because it disparaged the Republican Party, App. Ser. No. 85/077647, but did not find the mark THE DEVIL IS A DEMOCRAT disparaging, App. Ser. No. 85/525,066 (abandoned after publication for other reasons). The PTO registered the mark FAGDOG three times and refused it twice, at least once as disparaging. *Compare* Reg. Nos. 2,926,775; 2,828,396; *and* 3,174,475, *with* App. Ser. Nos. 76/454,927 *and* 75/950,535. The PTO refused to register the marks FAG FOREVER A GENIUS!, App. Ser. No. 86/089,512, and MARRIAGE IS FOR FAGS, App. Ser. No. 77/477,549, but allowed the mark F*A*G FABULOUS AND GAY, Reg. No. 2,997,761 (abandoned after publication for other reasons). And PTO examiners have registered DANGEROUS NEGRO, CELEBRETARDS, STINKY GRINGO, MIDGET-MAN, and OFF-WHITE TRASH—all marks that could be offensive to a substantial composite of the referenced group. We see no rationale for the PTO's seemingly arbitrary registration decisions, let alone one that would give applicants much guidance.

Such uncertainty of speech-affecting standards has long been recognized as a First Amendment problem, *e.g.*, in the overbreadth doctrine. *See Broadrick v. Oklahoma*, 413 U.S. 601, 613, 615, 93 S. Ct. 2908, 37 L. Ed. 2d 830 (1973). It has also been recognized as a problem under Fifth Amendment vagueness standards as they have been specially applied in the First Amendment setting.[8] All we need say about the uncertainty here, however, is that it contributes significantly to the chilling effect on speech.

The disincentive to choose a particular mark extends to any mark that could require the expenditure of substantial resources in litigating to obtain regis-

---

[8] A vague law that regulates speech on the basis of message "raises special First Amendment concerns because of its obvious chilling effect on free speech." *Reno v. ACLU*, 521 U.S. 844, 871-72, 117 S. Ct. 2329, 138 L. Ed. 2d 874 (1997). Thus, if a "law interferes with the right of free speech or of association, a more stringent vagueness test should apply." *Vill. of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 499, 102 S. Ct. 1186, 71 L. Ed. 2d 362 (1982). The Supreme Court reiterated these principles just three years ago:

> Even when speech is not at issue, the void for vagueness doctrine addresses at least two connected but discrete due process concerns: first, that regulated parties should know what is required of them so they may act accordingly; second, precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory way. *See Grayned v. City of Rockford*, 408 U.S. 104, 108-109, 92 S. Ct. 2294, 33 L. Ed. 2d 222 (1972). When speech is involved, rigorous adherence to those requirements is necessary to ensure that ambiguity does not chill protected speech.

F.C.C. v. Fox Television Stations, Inc., — U.S. —, 132 S. Ct. 2307, 2317-18, 183 L. Ed. 2d 234 (2012).

tration in the first place. And the disincentive does not stop there, because the disparagement determination is not a onetime matter. Even if an applicant obtains a registration initially, the mark may be challenged in a cancellation proceeding years later. Thus, after years of investment in promoting a registered mark and coming to be known by it, a mark's owner may have to (re)litigate its character under § 2(a) and might lose the registration. This effectively forces the mark's owner to find a new mark and make substantial new investments in educating the public that the products known by the old mark are now known by the new mark and, more generally, in establishing recognition of the new mark. The "disparagement" standard steers applicants away from choosing a mark that might result in these problems any time in the future.

Not surprisingly, "those who are denied registration under Section 2(a) often abandon the denied application and file a new one, indicating that they have changed their name rather than bear the costs of using a 'disparaging' mark or challenge the PTO's determination." Br. of Amicus Curiae Pro-Football, Inc. 15. In many cases, as soon as a trademark examiner issues a rejection based upon disparagement, the applicant immediately abandons the trademark application. *See, e.g.*, AMISHHOMO (abandoned 2013); MORMON WHISKEY (abandoned 2012); HAVE YOU HEARD THAT SATAN IS A REPUBLICAN? (abandoned 2010); DEMOCRATS SHOULDN'T BREED (abandoned 2008); REPUBLICANS SHOULDN'T BREED (abandoned 2008); 2 DYKE MINIMUM (abandoned 2007); WET BAC/WET B.A.C. (abandoned 2007);

DON'T BE A WET BACK (abandoned 2006); FAGDOG (abandoned 2003).

The importance of the benefits of federal trademark registration explains the strength of the incentive to avoid marks that are vulnerable under § 2(a). For example, the holder of a federally registered trademark has a right to exclusive nationwide use of that mark anywhere there is not already a prior use that proceeds registration. *See* 15 U.S.C. §§ 1072, 1115. In the absence of federal registration, if a trademark owner has any common law rights, they are "limited to the territory in which the mark is known and recognized by those in the defined group of potential customers." McCarthy at § 26:2. Without the recognition of nationwide constructive use conferred by federal registration, a competitor can swoop in and adopt the same mark for the same goods in a different location. Without federal registration, the applicant does not have prima facie evidence of the mark's validity or its ownership or exclusive use of the mark. 15 U.S.C. § 1057(b). And a common law trademark can never become incontestable. *Id.* § 1065. Without federal registration, a trademark user cannot stop importation of goods bearing the mark, or recover treble damages for willful infringement. *Id.* §§ 1117, 1124. The common law provides no rights like these.

Contrary to the suggestion by the government, Mr. Tam is likely also barred from registering his mark in nearly every state. Three years after the enactment of the Lanham Act, the United States Trademark Association prepared the Model State Trademark Act—a bill patterned on the Lanham Act in many respects. McCarthy at § 22:5. The Model Act con-

tains language barring a mark from registration if it "consists of or comprises matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." 1964 Model State Trademark Act, § 2. Following the lead of the federal government, virtually all states have adopted the Model Act and its disparagement provision. McCarthy at § 22:5. Thus, not only are the benefits of federal registration unavailable to Mr. Tam, so too are the benefits of trademark registration in nearly all states.[9]

The government argues that the denial of Mr. Tam's registration "does not eliminate any common-law rights that might exist in [his] mark." Appellee's En Banc Br. 20. But as the government's use of "might" indicates, it is unclear whether Mr. Tam could actually enforce any common law rights to a disparaging mark.[10] The 1964 Model State Trademark Act, which most states have adopted, provides that "[n]othing herein shall adversely affect the rights or the enforcement of rights in marks acquired in good faith at any time at common law." § 14. However, the term "mark" is defined as "any trademark or service mark *entitled* to registration under this Act whether registered or not." § 1.C (emphasis added). Common law

---

[9] And even if Mr. Tam could register his mark in a state, the benefits of state registration are limited by the boundaries of the individual state or the geographic scope of the actual use of the mark within the state. They are by no means the nationwide benefits afforded to federally registered trademarks.

[10] Not surprisingly, holders of disparaging marks like Mr. Tam have not argued that they lack these common law rights on account of their marks not being registrable. They have little incentive to give this argument away.

rights to a mark may thus be limited to marks "entitled to registration." Whether a user of an unregistrable, disparaging mark has any enforceable common law rights is at best unclear. *See* Justin G. Blankenship, *The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words That Offend?*, 72 U. Colo. L. Rev. 415, 451 (2001) ("[A]ny mark that is canceled under section 2(a) of the Lanham Act for being scandalous or disparaging is unlikely to find much protection under common law principles either, although this will ultimately be determined by state courts applying their own common law principles."); Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(A) Trademark Law After Lawrence v. Texas*, 9 Marq. Intell. Prop. L. Rev. 187, 232 (2005) ("[A]s immoral, scandalous, and/or disparaging marks may not be registered under either state or federal law, nor do they enjoy common law protection, there appears to be no way of establishing a legally recognized property right in these marks."); Stephen Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REPORTER 661, 795 (1993) (disparaging marks are presumably "unprotect[a]ble pursuant to state common law"). The Restatement (Third) of Unfair Competition notes that the Lanham Act and the Model State Trademark Bill both prohibit registration of disparaging marks and that adoption and use of such marks may preclude enforcement under the common law doctrine of unclean hands. Restatement (Third) of Unfair Competition § 32 cmt. c (1995). The government has not pointed to a single case where the common-law holder

of a disparaging mark was able to enforce that mark, nor could we find one. The government's suggestion that Mr. Tam has common-law rights to his mark appears illusionary.[11]

Whether Mr. Tam has enforceable common-law rights to his mark or could bring suit under § 43(a) does not change our conclusion. Federal trademark registration brings with it valuable substantive and procedural rights unavailable in the absence of registration. These benefits are denied to anyone whose trademark expresses a message that the government finds disparages any group, Mr. Tam included. The

---

[11] The government also argues that Mr. Tam "may" have rights under 15 U.S.C. § 1125(a) ("Section 43(a)"). First, those rights would not include the benefits afforded to federally registered marks. Furthermore, it is not at all clear that Mr. Tam could bring a § 43(a) unfair competition claim. Section 43(a) allows for a federal suit to protect an unregistered trademark, much like state common law. But there is no authority extending § 43(a) to marks denied under § 2(a)'s disparagement provision. To the contrary, courts have suggested that § 43(a) is only available for marks that are registrable under § 2. *See Two Pesos*, 505 U.S. at 768, 112 S. Ct. 2753 (section 43(a) "protects qualifying unregistered trademarks and . . . the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)"); *Yarmuth-Dion, Inc. v. D'ion Furs, Inc.*, 835 F.2d 990, 992 (2d Cir. 1987) (requiring a plaintiff to "demonstrate that his [unregistered] mark merits protection under the Lanham Act"); *see also Renna v. Cty. of Union*, 88 F. Supp. 3d 310, 320 (D.N.J. 2014) ("Section 2 declares certain marks to be unregistrable because they are inappropriate subjects for trademark protection. It follows that such unregistrable marks, not actionable as registered marks under Section 32, are not actionable under Section 43, either."). And we have found no case allowing a § 43(a) action on a mark rejected or cancelled under § 2(a).

loss of these rights, standing alone, is enough for us to conclude that § 2(a) has a chilling effect on speech. Denial of federal trademark registration on the basis of the government's disapproval of the message conveyed by certain trademarks violates the guarantees of the First Amendment.

B. Trademark Registration Is Not Government Speech

The government suggests, and several amici argue, that trademark registration is government speech, and as such outside the coverage of the First Amendment. *See* Appellee's En Banc Br. 41-42; Br. of Amici Curiae Nat'l Asian Pacific Am. Bar Ass'n 19-22; Br. of Amici Curiae Blackhorse 13-23. "The Free Speech Clause restricts government regulation of private speech; it does not regulate government speech." *Pleasant Grove City v. Summum*, 555 U.S. 460, 467, 129 S. Ct. 1125, 172 L. Ed. 2d 853 (2009). Although we find it difficult to understand the government's precise position as to how trademark registration constitutes government speech, we conclude that there is no government speech at issue in the rejection of disparaging trademark registrations that would insulate § 2(a) from First Amendment review.

Wisely, the government does not argue that a mark-holder's use or enforcement of its federally registered trademark is government speech. Use of a mark by its owner is clearly private speech. Trademarks identify the source of a product, and are often closely associated with the actual product. A mark's purpose—to identify the source of goods—is antithetical to the notion that a trademark is tied to the government. The fact that COCA COLA and PEPSI may be

registered trademarks does not mean the government has endorsed these brands of cola, or prefers them over other brands. We see no reason that a markholder's use of its mark constitutes government speech.

Instead, the government appears to argue that trademark registration and the accoutrements of registration—such as the registrant's right to attach the ® symbol to the registered mark, the mark's placement on the Principal Register, and the issuance of a certificate of registration—amount to government speech. *See* Oral Argument at 52:40-53:07; 54:20-54:32. This argument is meritless. Trademark registration is a regulatory activity. These manifestations of government registration do not convert the underlying speech to government speech. And if they do, then copyright registration would likewise amount to government speech. Copyright registration has identical accoutrements—the registrant can attach the © symbol to its work, registered copyrights are listed in a government database, and the copyright owner receives a certificate of registration. The logical extension of the government's argument is that these indicia of registration convert the underlying speech into government speech unprotected by the First Amendment. Thus, the government would be free, under this logic, to prohibit the copyright registration of any work deemed immoral, scandalous, or disparaging to others. This sort of censorship is not consistent with the First Amendment or government speech jurisprudence.

In *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*, the Supreme Court detailed the indicia of government speech. — U.S. —, 135 S. Ct. 2239,

192 L. Ed. 2d 274 (2015). The Court concluded that specialty license plates were government speech, even though a state law allowed individuals, organizations, and nonprofit groups to request certain designs. The Court found several considerations weighing in favor of this holding. It emphasized that "the history of license plates shows that, insofar as license plates have conveyed more than state names and vehicle identification numbers, they long have communicated messages from the States." *Id.* at 2248. It stressed that "[t]he State places the name 'TEXAS' in large letters at the top of every plate," that "the State requires Texas vehicle owners to display license plates, and every Texas license plate is issued by the State," that "Texas also owns the designs on its license plates," and that "Texas dictates the manner in which drivers may dispose of unused plates." *Id.* As a consequence, the Court reasoned, "Texas license plate designs 'are often closely identified in the public mind with the State.'" *Id.* (quoting *Summum*, 555 U.S. at 472, 129 S. Ct. 1125 (alteration omitted)). Amidst all of its other aspects of control, moreover, "Texas maintains direct control over the messages conveyed on its specialty plates." *Id.* at 2249. "Indeed, a person who displays a message on a Texas license plate likely intends to convey to the public that the State has endorsed that message." *Id.*

The government's argument in this case that trademark registration amounts to government speech is at odds with the Supreme Court's analysis in *Walker* and unmoored from the very concept of government speech. When the government registers a trademark, the only message it conveys is that a mark is registered. The vast array of private trademarks are

not created by the government, owned or monopolized by the government, sized and formatted by the government, immediately understood as performing any government function (like unique, visible vehicle identification), aligned with the government, or (putting aside any specific government-secured trademarks) used as a platform for government speech. There is simply no meaningful basis for finding that consumers associate registered private trademarks with the government.

Indeed, the PTO routinely registers marks that no one can say the government endorses. *See, e.g.*, RADICALLY FOLLOWING CHRIST IN MISSION TOGETHER, U.S. Reg. No. 4,759,522; THINK ISLAM, U.S. Reg. No. 4,719,002 (religious marks); GANJA UNIVERSITY, U.S. Reg. No. 4,070,160 (drug-related); CAPITALISM SUCKS DONKEY BALLS, U.S. Reg. No. 4,744,351; TAKE YO PANTIES OFF, U.S. Reg. No. 4,824,028; and MURDER 4 HIRE, U.S. Reg. No. 3,605,862. As the government itself explains, "the USPTO does not endorse any particular product, service, mark, or registrant" when it registers a mark. Appellee's En Banc Br. 44. For decades, the government has maintained that:

> [J]ust as the issuance of a trademark registration by this Office does not amount to government endorsement of the quality of the goods to which the mark is applied, the act of registration is not a government imprimatur or pronouncement that the mark is a "good" one in an aesthetic, or any analogous, sense.

In re Old Glory Condom Corp., 26 U.S.P.Q. 2d 1216, 1219-20 n.3 (T.T.A.B. Mar. 3, 1993); *see also* McCarthy

at § 19:3.50 ("[G]overnment registration of a mark is neither a government endorsement of the quality of the goods to which the mark is applied nor a government pronouncement that the mark is a good or reliable one in any moral or commercial sense."); Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of Redskins?*, 52 Stan. L. Rev. 665, 684 (2000) ("The overwhelming majority of the public encounters trademarks in their roles as product identifiers, not as the beneficiaries of a federal registration scheme. The public is unlikely to believe that a registered trademark designation accompanying a word or logo on a product reflects government endorsement."). Trademarks are understood in society to identify the source of the goods sold, and to the extent that they convey an expressive message, that message is associated with the private party that supplies the goods or services. Trademarks are not understood to convey a government message or carry a government endorsement.

The government argues that use of the ® symbol, being listed in a database of registered marks, and having been issued a registration certificate makes trademark registration government speech. These incidents of registration do not convert private speech into government speech. The government does not own the trademark designs or the underlying goods to which the trademark is affixed as the state owned the license plates in *Walker*. Markholders are not even required to use the ® symbol on their goods. 15 U.S.C. § 1111. And if simply affixing the ® symbol converted private speech into government speech then the government would be free to regulate the content, viewpoint, and messages of registered copyrights. A

copyright registration likewise allows the copyright owner to affix a © symbol, 17 U.S.C. § 401, but this symbol does not convert the copyrighted work into government speech or permit the government to grant some copyrights and deny others on account of the work's message. Just as the public does not associate the copyrighted works *Nigger: The Strange Career of a Troublesome Word* or *Fifty Shades of Grey* with the government, neither does the public associate individual trademarks such as THE SLANTS with the government.

Similarly, a registered mark's placement on the Principal Register or publication in the PTO's Official Gazette does not morph the private expression being registered into government expression. As a preliminary matter, it is not entirely clear what the Principal Register is. There is apparently no government-published book of all trademark registrations; instead, the Principal Register is at most an internet database hosted on the PTO's website. *See* U.S. Patent and Trademark Office, Search Trademark Database, *available at* http://www.uspto.gov/trademarks-application-process/search-trademark-database. If being listed in a government database or published in a list of registrations were enough to convert private speech to government speech, nearly every action the government takes—every parade permit granted, every property title recorded, every hunting or fishing license issued—would amount to government speech. The government could record recipients of parade permits in an official database or publish them weekly, thus insulating content-based grants of these permits from judicial review. Governmental agencies could assign TV and radio licenses

and states could refuse to license medical doctors with no First Amendment oversight by "registering" these licenses in an online database, or by allowing licensees to display a mark by their name. The fact that the government records a trademark in a database of all registered trademarks cannot possibly be the basis for concluding that government speech is involved.

Finally, the issuance of a registration certificate signed by the Director with the seal of the United States Patent and Trademark Office does not convert private expression or registration into government speech. This is a certificate, a piece of paper, which the trademark owner is free to do with as it wishes. The government maintains no control over the certificates. The government does not require companies to display their trademark registration certificate, or dictate the manner in which markholders may dispose of unused registration certificates. It is not public like license plates or monuments. When copyrights are granted, the copyright owner receives a similar registration certificate with the seal and signed by the Registrar of Copyrights. 17 U.S.C. § 410(a). And patents issue "in the name of the United States of America, under the seal of the Patent and Trademark Office," with a gold seal and red ribbon attached. 35 U.S.C. § 153; *see also* U.S. Patent and Trademark Office, Patent Process Overview, *available at* http://www.uspto.gov/patents-getting-started/patent process-overview#step7 (explaining that patent grants are issued with "a gold seal and red ribbon on the cover"). These certificates do not convert the registered subject matter into government speech such that the government is free to regulate its content. The public simply does not view these registra-

tion certificates as the government's expression of its ideas or as the government's endorsement of the ideas, inventions, or trademarks of the private speakers to whom they are issued.

In short, the act of registration, which includes the right (but not the obligation) to put an ® symbol on one's goods, receiving a registration certificate, and being listed in a government database, simply cannot amount to government speech. The PTO's processing of trademark registrations no more transforms private speech into government speech than when the government issues permits for street parades, copyright registration certificates, or, for that matter, grants medical, hunting, fishing, or drivers licenses, or records property titles, birth certificates, or articles of incorporation. To conclude otherwise would transform every act of government registration into one of government speech and thus allow rampant viewpoint discrimination. When the government registers a trademark, it regulates private speech. It does not speak for itself.

C. Section 2(a) Is Not a Government Subsidy Exempt from Strict Scrutiny

We reject the government's argument that § 2(a)'s message-based discrimination is merely the government's shaping of a subsidy program. The government's defense is contrary to the long-established unconstitutional conditions doctrine. The Supreme Court has repeatedly invalidated denials of "benefits" based on message-based disapproval of private speech that is not part of a government-speech program. In such circumstances, denial of an otherwise-available benefit is unconstitutional at least where, as here, it

has a significant chilling effect on private speech. *Bd. of Cty. Comm'rs*, 518 U.S. at 674, 116 S. Ct. 2342 (1996) (explaining that "the threat of the loss of [a valuable financial benefit] in retaliation for speech may chill speech on matters of public concern"); *id.* ("[r]ecognizing that constitutional violations may arise from the deterrent, or 'chilling,' effect of governmental efforts that fall short of a direct prohibition against the exercise of First Amendment rights") (citations and alterations omitted).

Under the unconstitutional conditions doctrine:

> [E]ven though a person has no 'right' to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech.

Perry, 408 U.S. at 597, 92 S. Ct. 2694. The Supreme Court, applying this doctrine, held that a state college could not refuse to retain a professor because of his public criticism of that college's policy, even though the professor had no right to reemployment, and even though the government had not directly prohibited the professor from speaking. *Id.* at 597-98, 92 S. Ct. 2694. This is because "[t]o deny [a benefit] to claimants who engage in certain forms of speech is in effect to penalize them for such speech." *Speiser v. Randall*, 357 U.S. 513, 518, 78 S. Ct. 1332, 2 L. Ed. 2d 1460 (1958); *Perry*, 408 U.S. at 597, 92 S. Ct. 2694 ("For if the government could deny a benefit to a person because of his constitutionally protected speech or asso-

ciations, his exercise of those freedoms would in effect be penalized and inhibited.").

Since *Perry*, the Supreme Court has wrestled with how to apply the unconstitutional conditions doctrine while protecting Congress's ability to direct government spending. The Spending Clause of the U.S. Constitution, which grants Congress the power "[t]o lay and collect Taxes, Duties, Imposts and Excises, to pay the Debts and provide for the common Defence and general Welfare of the United States," U.S. Const. Art. I, § 8, cl. 1, "provides Congress broad discretion to tax and spend for the 'general Welfare,' including by funding particular state or private programs or activities." *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, — U.S. —, 133 S. Ct. 2321, 2327-28, 186 L. Ed. 2d 398 (2013). This includes "the authority to impose limits on the use of such funds to ensure they are used in the manner Congress intends," even when these limits exclude protected speech or other constitutionally protected conduct. *Id.* at 2328 (citing *Rust v. Sullivan*, 500 U.S. 173, 195 n.4, 111 S. Ct. 1759, 114 L. Ed. 2d 233 (1991)). The Court reasoned that "if a party objects to a condition on the receipt of federal funding," it can always decline the funds. *Id.*

"[W]hen the Government appropriates public funds to establish a program it is entitled to define the limits of that program." *United States v. Am. Library Ass'n*, 539 U.S. 194, 211, 123 S. Ct. 2297, 156 L. Ed. 2d 221 (2003) (quoting *Rust*, 500 U.S. at 194, 111 S. Ct. 1759). For purposes of a message-discriminatory condition on the grant of government funds, the Supreme Court has said that the government can "disburse[] public funds to private entities to convey a

governmental message." *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 541, 121 S. Ct. 1043, 149 L. Ed. 2d 63 (2001) (citation omitted). When it does so, "it may take legitimate and appropriate steps to ensure that its message is neither garbled nor distorted by the grantee." *Id.* Therefore, "viewpoint-based funding decisions can be sustained in instances . . . in which the government used private speakers to transmit specific information pertaining to its own program." *Id.* (citations omitted).

Thus, in *Rust*, the government could prohibit the expenditure of public federal family planning funds on abortion-related counseling because the government distributed those funds to promote the conveying of a particular message. *Rosenberger*, 515 U.S. at 833, 115 S. Ct. 2510 (citing *Rust*, 500 U.S. at 194, 111 S. Ct. 1759); *Velazquez*, 531 U.S. at 541, 121 S. Ct. 1043 (noting that *Rust* must be understood as resting on the conclusion that it involved "government speech"). Relatedly, although there was no majority opinion in *American Library Ass'n*, the Court upheld a specific congressional determination not to give money for technology to be used for supporting particular speech (pornography) in particular circumstances (in public libraries where non-user patrons likely would inadvertently see it), even then only upon confirming the minor nature of the burden on the user patrons involved. 539 U.S. at 211-12, 123 S. Ct. 2297 (upholding conditioning public libraries' receipt of federal subsidies on their use of Internet filtering software, because Congress was entitled to insist that "public funds be spent for the purposes for which they were authorized" (quotation marks omitted)). Earlier, the Court had recognized that tax exemptions or deductions were a

form of subsidy for First Amendment analysis. *Regan v. Taxation with Representation of Wash.*, 461 U.S. 540, 544, 103 S. Ct. 1997, 76 L. Ed. 2d 129 (1983) ("Both tax exemptions and tax-deductibility are a form of subsidy that is administered through the tax system."); *id.* (explaining that tax-exempt status "has much the same effect as a cash grant to an organization").

The government's discretion to direct its spending, while broad, is not unbounded, and the limits take account of the real-world effect on the speech of those subject to the conditions. If a program arises under the Spending Clause, Congress is free to attach "conditions that define the limits of the government spending program—those that specify the activities Congress wants to subsidize." *Agency for Int'l Dev.*, 133 S. Ct. at 2328. However, Congress does not have the authority to attach "conditions that seek to leverage funding to regulate speech outside the contours of the program itself." *Id.* "Congress cannot recast a condition on funding as a mere definition of its program in every case, lest the First Amendment be reduced to a simple semantic exercise." *Velazquez*, 531 U.S. at 547, 121 S. Ct. 1043. The Court held that Congress could not restrict appropriations aimed at combating the spread of HIV/AIDS to only organizations having policies affirmatively opposing prostitution and sex trafficking, which would make such organizations unable to convey a contrary message. *Agency for Int'l Dev.*, 133 S. Ct. at 2330-31. The Court struck down Congress's conditioning of funding to public broadcasters on their refraining from editorializing, even with their non-federal money. *FCC v. League of Women Voters*, 468 U.S. 364, 104 S. Ct. 3106, 82 L. Ed.

2d 278 (1984). And in *Regan*, the Court, in upholding the subsidy of certain organizations for lobbying, took pains to note the relatively easy work-around for other unsubsidized organizations to achieve a comparable position for lobbying and the absence of any attempt to suppress ideas. 461 U.S. at 548, 103 S. Ct. 1997; *see Leathers v. Medlock*, 499 U.S. 439, 452, 111 S. Ct. 1438, 113 L. Ed. 2d 494 (1991) (discussing *Regan*).

The government argues that trademark registration is a form of government subsidy that the government may refuse where it disapproves of the message a mark conveys. It contends: "Congress has at least as much discretion to determine which terms and symbols should be registered and published by a federal agency as it would to determine which private entities should receive federal funds." Appellee's En Banc Br. 29. But as already described, trademark registration is not a program through which the government is seeking to get its message out through recipients of funding (direct or indirect). And for the reasons described above, the denial of registration has a major chilling effect on private speech, because the benefits of registration are so substantial. Nor is there a ready work-around to maintain private speech without significant disadvantage. Markholders cannot, for example, realistically have two brand names, one inoffensive, non-disparaging one (which would be able to secure registration) and a second, expressive, disparaging one (which would be unregistrable and unprotectable).

In any event, the scope of the subsidy cases has never been extended to a "benefit" like recognition of legal rights in speakers against private interference.

The cases cannot be extended to any "program" conferring legal rights on the theory that the government is free to distribute the legal rights it creates without respecting First Amendment limits on content and viewpoint discrimination. Not surprisingly, the subsidy cases have all involved government funding or government property.

The government cites *Ysursa v. Pocatello Education Ass'n*, 555 U.S. 353, 129 S. Ct. 1093, 172 L. Ed. 2d 770 (2009), and *Davenport v. Washington Education Ass'n*, 551 U.S. 177, 127 S. Ct. 2372, 168 L. Ed. 2d 71 (2007), in support of its subsidy defense of § 2(a). Appellee's En Banc Br. 28-29. But they are inapposite. Both *Davenport* and *Ysursa* center on challenges to the constitutionality of state laws limiting the ability of public-sector unions to spend on political speech non-members' money the unions obtain through the government's affirmative use of its own payroll systems. *Davenport*, 551 U.S. at 180, 127 S. Ct. 2372 (considering constitutionality of law prohibiting payroll deductions for political spending unless the union had the affirmative consent of the non-member); *Ysursa*, 555 U.S. at 355, 129 S. Ct. 1093 (considering constitutionality of law completely prohibiting payroll deductions for political spending). Even in the context of use of government property, the Court focused on the absence of viewpoint discrimination, holding that the programs placed a "reasonable, viewpoint-neutral limitation" on the unions' abilities to enlist the government's aid in acquiring the money of government employees for spending on political speech to which particular employees might object. *Davenport*, 551 U.S. at 189, 127 S. Ct. 2372; *see also Ysursa*, 555 U.S. at 361 n.3, 129 S. Ct. 1093. The

prohibitions were not "aimed at the suppression of dangerous ideas." *Ysursa*, 555 U.S. at 359, 129 S. Ct. 1093 (alterations omitted); *see also Davenport*, 551 U.S. at 190, 127 S. Ct. 2372 ("Quite obviously, no suppression of ideas is afoot.").

These cases do not speak to Congress's power to enact viewpoint-discriminatory regulations like § 2(a). The government does not shy away from the fact that the purpose of § 2(a) is to discourage, and thereby eliminate, disparaging marks, particularly marks that include "the most vile racial epithets," "religious insults," "ethnic caricatures," and "misogynistic images." Appellee's En Banc Br. 1-3. On its face, § 2(a) is aimed at the suppression of dangerous ideas, unlike the provisions in *Ysursa* and *Davenport*. Moreover *Ysursa* and *Davenport* both took place in "the unique context of public-sector agency-shop arrangements," where the government was "act[ing] in a capacity other than as regulator." *Davenport*, 551 U.S. at 188, 190, 127 S. Ct. 2372. Thus, the risk that the government "may effectively drive certain ideas or viewpoints from the marketplace [was] attenuated." *Id.* at 188, 127 S. Ct. 2372. Section 2(a) is regulation of speech that targets expressive content and thereby threatens to drive ideas or viewpoints from the marketplace.

In determining if a condition on a favorable government action is unconstitutional, courts—both before and after *Davenport* and *Ysursa*—have distinguished between government actions that implicate the government's power to spend and government actions that do not. For example, the Ninth Circuit considered the constitutionality of a treaty under which certain "educational, scientific and cultural

audio-visual materials" were granted various benefits, including exemption from import duties. *Bullfrog Films, Inc. v. Wick*, 847 F.2d 502, 503 (9th Cir. 1988). The government argued, as it does here, that the regulations stemming from the treaty did not "punish or directly obstruct [filmmakers'] ability to produce or disseminate their films," but amount to "the government simply declining to pay a subsidy." *Id.* at 509. The Ninth Circuit rejected the government's "benign characterization" of the regulations and held that the trade benefits were not a subsidy because "no Treasury Department funds [were] involved." *Id.* at 509. Because the trade benefits were not a subsidy, the Ninth Circuit held that the unconstitutional conditions doctrine applied, and found the treaty and implementing regulations unconstitutional. *Id.* at 511.

The Fifth Circuit, sitting en banc, recently considered the constitutionality of a Texas law allowing charitable organizations to hold bingo games so long as the resulting funds were not used for lobbying. *Dep't of Tex., Veterans of Foreign Wars v. Tex. Lottery Comm'n*, 760 F.3d 427, 430 (5th Cir. 2014) (en banc). The Texas Lottery Commission argued that the restrictions were constitutional because they fell within the state government's spending power, which is analogous to the federal government's spending power. *Id.* at 434. The Fifth Circuit agreed that "the government may attach certain speech restrictions to funds linked to the public treasury—when either granting cash subsidies directly from the public coffers . . . or approving the withholding of funds that otherwise would go to the public treasury." *Id.* at 435. But it found the Texas bingo program "wholly distinguishable . . . because no public monies or 'spending'

by the state are involved." *Id.* at 436. Reasoning that the bingo program's primary function is regulatory, further "underscor[ing] the incongruity of [applying] the 'subsidy' paradigm to the bingo program," the Fifth Circuit applied the unconstitutional conditions doctrine and found the lobbying provision unconstitutional. *Id.* at 437-41.

Similarly, the D.C. Circuit recently held that a presidential directive barring lobbyists from serving on international trade advisory committees implicated the First Amendment. *Autor v. Pritzker*, 740 F.3d 176, 177 (D.C. Cir. 2014). The government argued that "when [it] appropriates public funds to establish a program, its decision not to use program funds to subsidize the exercise of a fundamental right does not infringe" the First Amendment. *Id.* at 182 (quotations and alterations omitted). The D.C. Circuit rejected this argument because membership in the advisory committees was a non-financial—albeit valuable—benefit. *Id.* at 182-83. Explaining that "[t]he Supreme Court has never extended the [spending exception] to situations not involving financial benefits," the D.C. Circuit found the directive could be an unconstitutional condition, and remanded for further consideration. *Id.* at 183-84.

Trademark registration does not implicate Congress's power to spend or to control use of government property.[12] Trademark registration is not a subsidy. The benefits of trademark registration, while valuable,

---

[12] Counsel for the United States at oral argument disclaimed the notion that a government forum approach was appropriate in the context of trademark registration. *See* Oral Argument at 1:14:25-1:14:58; 1:16:20-1:17:15.

are not monetary. Unlike a subsidy consisting of, for example, HIV/AIDS funding, or tax exemptions, a trademark registration does not directly affect the public fisc. Instead, a registered trademark redefines the nature of the markholder's rights as against the rights of other citizens, depriving others of their ability to use the mark. Like the programs in *Bullfrog* and *Texas Lottery Commission*, the system of trademark registration is a regulatory regime, not a government subsidy program.

The government also argues that because the PTO is funded by appropriations, any government spending requirement is met here. Appellee's En Banc Br. 29-30 (citing 35 U.S.C. § 42(c)(1)-(2)). Trademark registration fees are collected and, "[t]o the extent and in the amounts provided in advance in appropriations Acts," made available "to carry out the activities of the [PTO]." 35 U.S.C. § 42(c)(1). However, since 1991 these appropriations have been funded entirely by registration fees, not the taxpayer. *Figueroa v. United States*, 466 F.3d 1023, 1028 (Fed. Cir. 2006); *see also* 56 Fed. Reg. 65147 (1991); Omnibus Budget Reconciliation Act of 1990, Pub. L. No. 101-508, S. 10101, 1990 U.S.C.C.A.N. (104 Stat.) 1388. The fact that registration fees cover all of the operating expenses associated with registering marks is further evidence that, despite conveying valuable benefits, trademark registration is not a government subsidy.

While PTO operations are fully underwritten by registration fees, some federal funds are nonetheless spent on the registration and enforcement of trademarks. For example, PTO employee benefits, including pensions, health insurance, and life insurance,

are administered by the Office of Personnel Management and funded from the general treasury. *Figueroa*, 466 F.3d at 1028. And registering a trademark may lead to additional government spending, such as when the trademark owner seeks to enforce the trademark through the federal courts and U.S. Customs and Border Patrol. This spending, however, is attenuated from the benefits bestowed by registration. Trademark registration does not implicate the Spending Clause merely because of this attenuated spending, else every benefit or regulatory program provided by the government would implicate the Spending Clause. The Copyright Office is only partially funded by user fees, but copyright registration is nonetheless not a subsidy. *Copyright Office Fees: Registration, Recordation and Related Services; Special Services; Licensing Division Services; FOIA Services*, 79 Fed. Reg. 15910-01 (Mar. 24, 2014) (setting fees to recover "a significant part of the costs to the Office of registering copyright claims"). It would be unreasonable to argue that the government subsidizes an author when it grants him a copyright. Similarly, the programs in Bullfrog and Texas Lottery Commission were likely funded in some part by the government—perhaps also by government benefits paid to employees administering the programs—but the Ninth Circuit and the Fifth Circuit considered only whether the conditioned benefits were paid for by government spending, and not whether the programs were subsidized in more indirect ways. And while the government argued in *Autor* that the government had appropriated public funds to establish the international trade advisory committees, 740 F.3d at 182, the D.C. Circuit nonetheless found that membership on these

advisory committees was not a financial benefit, *id.* at 183.

The fact that the Lanham Act derives from the Commerce Clause, not the Spending Clause, is further evidence that trademark registration is not a subsidy. The purpose of the Lanham Act is to regulate marks used in interstate commerce, prevent customer confusion, and protect the goodwill of markholders, 15 U.S.C. § 1127, not to subsidize markholders. Moreover, the government funding cases have thus far been limited to situations where the government has chosen to limit funding to individuals that are advancing the goals underlying the program the government seeks to fund. *See generally Agency for Int'l Dev.*, 133 S. Ct. at 2324-25; *Rust*, 500 U.S. at 191, 111 S. Ct. 1759; *cf. American Library Ass'n*, 539 U.S. at 211, 123 S. Ct. 2297 (it is not unconstitutional for the government to insist that "public funds be spent for the purposes for which they were authorized"). The restriction on the registration of disparaging marks bears no relation to the objectives, goals, or purpose of the federal trademark registration program. Preventing disparaging marks does not protect trademark owners' investments; in fact, because § 2(a) can be brought in cancellation proceedings decades after a mark is granted, this provision actually undermines this important purpose of the Lanham Act. And the disparagement proscription has never been alleged to prevent consumer confusion or deception. The government's viewpoint —and content-based discrimination in this case is completely untethered to the purposes of the federal trademark registration program. It would be a radical extension of existing precedent to permit the government to rely upon its power to subsidize to justify

its viewpoint discrimination, when that discrimination has nothing to do with the goals of the program in which it is occurring.

Were we to accept the government's argument that trademark registration is a government subsidy and that therefore the government is free to restrict speech within the confines of the trademark program, it would expand the "subsidy" exception to swallow nearly all government regulation. In many ways, trademark registration resembles copyright registration. Under the logic of the government's approach, it follows that the government could refuse to register copyrights without the oversight of the First Amendment. Congress could pass a law prohibiting the copyrighting of works containing "racial slurs," "religious insults," "ethnic caricatures," and "misogynistic images." Appellee's En Banc Br. 2-3. It is difficult to imagine how trademark registration with its attendant benefits could be deemed a government subsidy but copyright registration with its attendant benefits would not amount to a government subsidy. And if both must be treated as government subsidies by virtue of their conference of benefits or advantages, though not public money, then the government has the right to make content—or viewpoint-based determinations over which works to grant registration. This idea—that the government can control speech by denying the benefits of copyright registration to disfavored speech—is anathema to the First Amendment. With this, the government agrees, arguing that copyright registration, unlike trademark registration, is protected by the First Amendment. Oral Arg. at 36:45-38:50. But the government has advanced no principled reason to treat trademark registration dif-

ferently than copyright registration for present purposes. The government admits that any message-based regulation of copyrights would be subject to the First Amendment. We agree, and extend the government's reasoning to § 2(a)'s message-based regulation of trademarks. These registration programs are prototypical examples of regulatory regimes. The government may not place unconstitutional conditions on trademark registration. We reject the government's argument that it is free to restrict constitutional rights within the confines of its trademark registration program.

III. Section 2(a) Is Unconstitutional Even Under the *Central Hudson* Test for Commercial Speech

As discussed above, § 2(a) regulates expressive speech, not commercial speech, and therefore strict scrutiny is appropriate. Trademarks have at times been referred to as commercial speech. *See, e.g., Friedman v. Rogers*, 440 U.S. 1, 11, 99 S. Ct. 887, 59 L. Ed. 2d 100 (1979) (holding that the trade name of an optometrist was commercial speech). They are, after all, commercial identifiers, the symbols and words by which companies distinguish and identify their brands. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 765, 96 S. Ct. 1817, 48 L. Ed. 2d 346 (1976) (defining commercial speech as the "dissemination of information as to who is producing and selling what product, for what reason, and at what price"). It does not follow, however, that all government regulation of trademarks is properly reviewed under the *Central Hudson* intermediate scrutiny standard. Section 2(a) bars registration of disparaging marks. This regulation is squarely based on

the expressive aspect of the speech, not its commercial-speech aspects. It should therefore be evaluated under the First Amendment standards applicable to the regulation of expressive speech. Discrimination against a mark by virtue of its offensive, disparaging nature discriminates against the mark's political or social message. Section 2(a) should be subject to strict scrutiny, and be invalidated for its undisputed inability to survive such scrutiny.

Even if we were to treat § 2(a) as a regulation of commercial speech, it would fail to survive. In *Central Hudson*, the Supreme Court laid out the intermediate-scrutiny framework for determining the constitutionality of restrictions on commercial speech. 447 U.S. at 566, 100 S. Ct. 2343. First, commercial speech "must concern lawful activity and not be misleading." *Id.* If this is the case, we ask whether "the asserted governmental interest is substantial," *id.*, and whether the regulation "directly and materially advanc[es]" the government's asserted interest and is narrowly tailored to achieve that objective. *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 555-56, 121 S. Ct. 2404, 150 L. Ed. 2d 532 (2001). "Under a commercial speech inquiry, it is the State's burden to justify its content-based law as consistent with the First Amendment." *Sorrell*, 131 S. Ct. at 2667.

First, we ask whether the regulated activity is lawful and not misleading. *Cent. Hudson*, 447 U.S. at 563-64, 100 S. Ct. 2343. Unlike many other provisions of § 2, the disparagement provision does not address misleading, deceptive, or unlawful marks. There is nothing illegal or misleading about a disparaging trademark like Mr. Tam's mark.

Next, for speech that is lawful and not misleading, a substantial government interest must justify the regulation. *Id.* at 566, 100 S. Ct. 2343. But § 2(a) immediately fails at this step. The entire interest of the government in § 2(a) depends on disapproval of the message. That is an insufficient interest to pass the test of intermediate scrutiny, as the Supreme Court made clear in *Sorrell*. 131 S. Ct. at 2668 (law must not "seek to suppress a disfavored message"); *id.* at 2670 (rejecting message-based interest as "contrary to basic First Amendment principles"); *see id.* at 2667-68 (finding it unnecessary to rely on strict scrutiny; rejecting justification under *Central Hudson*); *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 69-72, 103 S. Ct. 2875, 77 L. Ed. 2d 469 (1983); *Carey v. Population Servs., Int'l*, 431 U.S. 678, 701 & n.28, 97 S. Ct. 2010, 52 L. Ed. 2d 675 (1977).

The government proffers several interests to justify its bar on disparaging trademarks. It argues principally that the United States is "entitled to dissociate itself from speech it finds odious." Appellee's En Banc Br. 41. This core argument rests on intense disapproval of the disparaging marks. *See, e.g.*, Appellee's En Banc Br. 1 ("the most vile racial epithets and images"); *id.* at 2-3 ("racial slurs . . . or religious insults, ethnic caricatures, misogynistic images, or any other disparaging terms or logos"); *id.* at 14 ("racial epithets"); *id.* at 21 ("racial slurs and similar disparagements"); *id.* at 22 ("including the most vile racial epithets"); *id.* at 41 ("speech [the government] finds odious"); *id.* at 44 ("racial slurs"). And that disapproval is not a legitimate government interest where, as here, for the reasons we have already discussed, there is no plausible basis for treating the speech as

government speech or as reasonably attributed to the government by the public.

The government also argues that it has a legitimate interest in "declining to expend its resources to facilitate the use of racial slurs as source identifiers in interstate commerce." Appellee's En Banc Br. 43. The government's interest in directing its resources does not warrant regulation of these marks. As discussed, trademark registration is user-funded, not taxpayer-funded. The government expends few resources registering these marks. *See supra* at 1353-54. Its costs are the same costs that would be incidental to any governmental registration: articles of incorporation, copyrights, patents, property deeds, etc. In fact, the government spends far more significant funds defending its refusal decisions under the statute. *See McGinley*, 660 F.2d at 487 (Rich, J., dissenting) ("More 'public funds' are being expended in the prosecution of this appeal than would ever result from the registration of the mark."). Finally, labeling this sort of interest as substantial creates an end-run around the unconstitutional conditions doctrine, as virtually all government benefits involve the resources of the federal government in a similar sense. Nearly every government act could be justified under this ground, no matter how minimal. For example, the government could also claim an interest in declining to spend resources to issue permits to racist, sexist, or homophobic protests. The government cannot target speech on this basis, even if it must expend resources to grant parade permits or close down streets to facilitate such speech.

This holds true even though the government claims to have a "compelling interest in fostering racial tolerance." Appellee's En Banc Br. 43 (citing *Bob Jones Univ. v. United States*, 461 U.S. 574, 604, 103 S. Ct. 2017, 76 L. Ed. 2d 157 (1983)). *Bob Jones University* does not stand for the broad proposition the government claims. *Bob Jones University* is a case about racially discriminatory conduct, not speech. The Court held that the government has an interest in combating "racial discrimination in education," not a more general interest in fostering racial tolerance that would justify preventing disparaging speech. *Id.* at 595, 103 S. Ct. 2017.

The invocation of the general racial-tolerance interest to support *speech* regulation is a sharply different matter, as the Supreme Court explained in *R.A.V.*:

> One must wholeheartedly agree with the Minnesota Supreme Court that "[i]t is the responsibility, even the obligation, of diverse communities to confront [virulent notions of racial supremacy] in whatever form they appear," but the manner of that confrontation cannot consist of selective limitations upon speech. St. Paul's brief asserts that a general "fighting words" law would not meet the city's needs because only a content-specific measure can communicate to minority groups that the "group hatred" aspect of such speech "is not condoned by the majority." The point of the First Amendment is that majority preferences must be expressed in some fashion other than silencing speech on the basis of its content.

505 U.S. at 392, 112 S. Ct. 2538 (first alteration in original; citations omitted). What is true of direct

"silencing" is also true of the denial of important legal rights. "[I]n public debate we must tolerate insulting, and even outrageous, speech in order to provide adequate breathing space to the freedoms protected by the First Amendment." *Snyder*, 562 U.S. at 458, 131 S. Ct. 1207 (quoting *Boos v. Barry*, 485 U.S. 312, 322, 108 S. Ct. 1157, 99 L. Ed. 2d 333 (1988)) (alterations omitted). The case law does not recognize a substantial interest in discriminatorily regulating private speech to try to reduce racial intolerance.

Moreover, at the level of generality at which the government invokes "racial tolerance," it is hard to see how one could find that § 2(a) "directly and materially advanc[es]" this interest and is narrowly tailored to achieve that objective. *Lorillard Tobacco Co.*, 533 U.S. at 555-56, 121 S. Ct. 2404. Disparaging speech abounds on the Internet and in books and songs bearing government registered copyrights. And the PTO has granted trademark registrations of many marks with a racially charged character. Further, the connection to a broad goal of racial tolerance would be even weaker to the extent that the government suggests, contrary to our conclusion in II.A *supra*, that denial of registration has no meaningful effect on the actual adoption and use of particular marks in the marketplace.

Finally, the government argues that it has a legitimate interest in "allowing States to make their own determinations about whether trademarks should be unenforceable on grounds of public policy." Appellee's En Banc Br. 44. However, this interest cannot stand alone. If § 2(a) is otherwise unconstitutional, the government cannot render it constitutional by ar-

guing that it is necessary so that states can partake in the same unconstitutional message-based regulation of trademarks. The government, in essence, argues that it has a legitimate interest in leaving the door open for states to violate the Constitution. This interest is certainly not legitimate, let alone substantial.

We conclude that the government has not presented us with a substantial government interest justifying the § 2(a) bar on disparaging marks. All of the government's proffered interests boil down to permitting the government to burden speech it finds offensive. This is not a legitimate interest. With no substantial government interests, the disparagement provision of § 2(a) cannot satisfy the *Central Hudson* test. We hold the disparagement provision of § 2(a) unconstitutional under the First Amendment.

CONCLUSION

Although we find the disparagement provision of § 2(a) unconstitutional, nothing we say should be viewed as an endorsement of the mark at issue. We recognize that invalidating this provision may lead to the wider registration of marks that offend vulnerable communities. Even Mr. Tam, who seeks to reappropriate the term "slants," may offend members of his community with his use of the mark. *See* Br. of Amici Curiae Nat'l Asian Pacific Am. Bar Ass'n 3, 5. But much the same can be (and has been) said of many decisions upholding First Amendment protection of speech that is hurtful or worse. Whatever our personal feelings about the mark at issue here, or other disparaging marks, the First Amendment forbids government regulators to deny registration because they find the speech likely to offend others. Even when

speech "inflict[s] great pain," our Constitution protects it "to ensure that we do not stifle public debate." *Snyder*, 562 U.S. at 461, 131 S. Ct. 1207. The First Amendment protects Mr. Tam's speech, and the speech of other trademark applicants.

We hold that the disparagement provision of § 2(a) is unconstitutional because it violates the First Amendment. We vacate the Board's holding that Mr. Tam's mark is unregistrable, and remand this case to the Board for further proceedings.

O'MALLEY, Circuit Judge, with whom WALLACH, Circuit Judge, joins, concurring.

I agree that the disparagement provision of 15 U.S.C. § 1052(a) ("§ 2(a)") is unconstitutional on its face. I agree, moreover, that § 2(a) cannot survive the searching constitutional scrutiny to which the majority subjects it under the First Amendment to the United States Constitution. On this point, the majority rightly dispenses with this court's precedent in *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981) and its progeny. I write separately, however, because, I believe § 2(a) is also unconstitutionally vague, rendering it unconstitutional under the Fifth Amendment to the United States Constitution.

While the majority acknowledges the vague and uncertain application of § 2(a), Maj. Op. 1341-43, it finds that "[a]ll we need say about the uncertainty here, however, is that it contributes significantly to the chilling effect on speech," *id.* at 1342-43. I agree with the majority's concern about the uncertain nature of § 2(a), but believe those concerns should lead us to do more than note 2(a)'s undoubted chilling effect on

speech. I find § 2(a)'s disparagement provision to be so vague that I would find it to be unconstitutional, whether or not it could survive Appellant's First Amendment challenge.

DISCUSSION

Section 2(a) provides that the Trademark Trial and Appeal Board ("Board") may refuse an application when the trademark "[c]onsists of or comprises . . . matter which *may disparage* . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." (emphasis added). As the majority correctly notes, the language of the statute creates "uncertainty as to what *might be deemed* disparaging." Maj. Op. 1341-42. Both would- be applicants and the Board are left to guess at what may have the potential to disparage a broad range of persons, institutions, symbols, and even undefined "beliefs." And, they are left to guess at whether "may disparage" is the equivalent of bringing into contempt or disrepute, or is a distinct category of impropriety from these latter evils.

Where, as here, the language of a statute evades clarity, "[t]he area of proscribed conduct will be adequately defined and the deterrent effect of the statute contained within constitutional limits only by authoritative constructions sufficiently illuminating the contours of an otherwise vague prohibition." *Dombrowski v. Pfister*, 380 U.S. 479, 490-91, 85 S. Ct. 1116, 14 L. Ed. 2d 22 (1965). The Board has developed a two-step test to determine whether a mark is disparaging:

(1) What is the likely meaning of the matter in question, taking into account not only dictionary

> definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
>
> (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

Trademark Manual of Exam. Proc. ("TMEP") § 1203.03(b)(i) (Oct. 2015 ed.) (citing, *inter alia*, *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014); *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q. 2d 1705, 1740-41 (T.T.A.B. 1999)). Thus, the Board has concluded that a mark may disparage within the meaning of § 2(a) when a majority of the Board believes it "dishonor[s] by comparison with what is inferior, slight[s], deprecate[s], degrade[s], or affect[s] or injure[s] by unjust comparison." *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 124 (D.D.C. 2003) (internal quotation marks omitted) (quoting *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q. 2d 1705, 1737 n.98 (T.T.A.B. 1999)).

The two-step test does little to alleviate § 2(a)'s uncertainty. Indeed, by adding the caveat that a mark can be rejected whenever a mark's meaning may be disparaging to "a substantial composite" of an "identifiable" group, (TMEP § 1203.03(b)(i)), the TMEP compounds the confusion the statute engenders. Thus a mark need only *potentially* disparage a *subset* of *any group* as long as that group can be "identifi[ed]."

One need only examine the disparate ways in which § 2(a) has been applied to see the confusion. While it

is true that a "fertile legal 'imagination can conjure up hypothetical cases in which the meaning of [disputed] terms will be in nice question,'" *Grayned v. City of Rockford*, 408 U.S. 104, 112 n.15, 92 S. Ct. 2294, 33 L. Ed. 2d 222 (1972) (alteration in original) (quoting *Am. Commc'ns Ass'n v. Douds*, 339 U.S. 382, 412, 70 S. Ct. 674, 94 L. Ed. 925 (1950)), the arbitrary application of § 2(a) is easily demonstrated. The majority discusses numerous examples of inconsistent registration decisions. Maj. Op. 1342 n.7. These include examples where there is no conceivable difference between the applied-for marks, yet one is approved and the other rejected. *Compare* HAVE YOU HEARD SATAN IS A REPUBLICAN (Trademark Application Serial No. 85,077,647) (rejected because it disparaged the Republican Party), *with* THE DEVIL IS A DEMOCRAT, Registration No. 85,525,066 (accepted and later abandoned for other reasons). I agree with the majority that there appears to be "no rationale for the PTO's seemingly arbitrary registration decisions, let alone one that would give applicants much guidance." Maj. Op. 1342 n.7.[1]

---

[1] Amici also were easily able to uncover examples of inconsistencies in the application of the § 2(a). *See* Br. for American Civil Liberties Union, the American Civil Liberties Union of Oregon, and the American Civil Liberties Union of the Nation's Capital as Amici Curiae 22-24 (discussing "a long line of arbitrary and contradictory decisions" as evidenced by the "countless examples of such irregularities," including, but not limited to, examples where the same mark is rejected in one instance and accepted in another, even for the same use—for example *compare* MADONNA, *In re Riverbank Canning Co.*, 25 CCPA 1028, 95 F.2d 327 (CCPA 1938) (affirming rejection of mark for use on wines as scandalous), *with* MADONNA, Registration No. 3,545,635 (accepted for use on wine)

For § 2(a) to survive a vagueness challenge, the Supreme Court requires it "give the person of ordinary intelligence a reasonable opportunity to know what is prohibited, so that he may act accordingly." *Grayned*, 408 U.S. at 108, 92 S. Ct. 2294. Further, "if arbitrary and discriminatory enforcement is to be prevented, laws must provide explicit standards for those who apply them." *Id.* Given the subjective and hypothetical language of the statute and its well-documented, inconsistent application by the Board, § 2(a) is void for vagueness under even a lax test for vagueness. But the standard we should apply to § 2(a) is not lax.

"The degree of vagueness that the Constitution tolerates . . . depends in part on the nature of the enactment." *Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 498, 102 S. Ct. 1186, 71 L. Ed. 2d 362 (1982). "[P]erhaps the most important factor affecting the clarity that the Constitution demands of a law is whether it threatens to inhibit the exercise of constitutionally protected rights. If, for example, the law interferes with the right of free speech . . . , a more stringent vagueness test should apply." *Id.* at 499, 102 S. Ct. 1186. The First Amendment concerns articulated by the majority support application of a "more stringent vagueness test"—one that § 2(a) simply cannot pass.

(Dec. 16, 2008); and MESSIAS, *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. 275 (T.T.A.B. 1968) (rejected for use on wine and brandy), with IL MESSIA, Registration No. 4,093,035 (accepted for use on wine) (Jan. 31, 2012)). These examples further highlight the subjective nature of the registration standard under § 2(a): it is an unstable standard that apparently depends on shifting sensibilities over time.

a. First Amendment Concerns Require a Stringent Vagueness Test

As the majority points out, "[i]t is beyond dispute that § 2(a) discriminates on the basis of content." Maj. Op. 1335. "[T]he test for disparagement—whether a substantial composite of the referenced group would find the mark disparaging—makes clear that it is the nature of the message conveyed by the speech which is being regulated. If the mark is found disparaging by the referenced group, it is denied registration." *Id.* at 1335. Indeed, the problems with § 2(a) are more substantial than the majority even acknowledges—not only is a trademark's registrability adjudged by the message it conveys, but the message conveyed is adjudged by the potential sensibilities of a broad range of potential listeners.

Under First Amendment principles, "content-based regulation of speech . . . raises special First Amendment concerns because of its obvious chilling effect on free speech." *Reno v. ACLU*, 521 U.S. 844, 872, 117 S. Ct. 2329, 138 L. Ed. 2d 874 (1997). Indeed, "[b]road prophylactic rules in the area of free expression are suspect. Precision of regulation must be the touchstone in an area so closely touching our most precious freedoms." *Edenfield v. Fane*, 507 U.S. 761, 777, 113 S. Ct. 1792, 123 L. Ed. 2d 543 (1993) (internal quotation marks omitted) (quoting *NAACP v. Button*, 371 U.S. 415, 438, 83 S. Ct. 328, 9 L. Ed. 2d 405 (1963)). The Supreme Court's emphasis on precision for content-based regulations is premised on its understanding of

> at least two connected but discrete due process concerns: first, that regulated parties should

> know what is required of them so they may act accordingly; second, precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory way. When speech is involved, rigorous adherence to those requirements is necessary to ensure that ambiguity does not chill protected speech.

FCC v. Fox Television Stations, Inc., — U.S. —, 132 S. Ct. 2307, 2317, 183 L. Ed. 2d 234 (2012) (citing *Grayned*, 408 U.S. at 108-109, 92 S. Ct. 2294).

b. Section 2(a) is Void for Vagueness

Section 2(a)'s undeniable chilling effect on speech requires it to pass a "more stringent test" for vagueness in order to pass constitutional muster. *Hoffman*, 455 U.S. at 498, 102 S. Ct. 1186. Recognizing that due process vagueness challenges are more difficult to sustain where civil regulation—as distinct from criminal penalty provisions—are at issue, I believe § 2(a)'s inherent ambiguity makes it difficult for would-be applicants to discern its boundaries and leads to inconsistent and unreliable actions on the part of the government as it seeks to regulate on the basis of content.

First, the imprecise, content-based regulation of trademark registration affects the types of marks sought by would-be registrants. "Vague laws force potential speakers to "'steer far wider of the unlawful zone" . . . than if the boundaries of the forbidden areas were clearly marked.'" *Brown v. Entm't Merchants Ass'n*, — U.S. —, 131 S. Ct. 2729, 2743, 180 L. Ed. 2d 708 (2011) (quoting *Baggett v. Bullitt*, 377 U.S. 360, 372, 84 S. Ct. 1316, 12 L. Ed. 2d 377 (1964)).

The majority opinion rightly concludes that, given the Board's inconsistency, "the public would have a hard time drawing much reliable guidance." Maj. Op. 1342. The "uncertainty of speech-affecting standards has long been recognized as a First Amendment problem," and the uncertainty inherent in § 2(a) "contributes significantly to the chilling effect on speech." Maj. Op. 1342.[2]

Next, the absence of clear standards for the application of § 2(a) provides the government with virtually unlimited ability to pick and choose which marks to allow and which to deny. And neither § 2(a) itself nor the TMEP's two-step test provides the PTO, the courts, or the public with any certainty as to what *may* disparage a given subset of any given population or group of believers. That is simply inadequate under the Fifth Amendment. *See Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 588, 118 S. Ct. 2168, 141 L. Ed. 2d 500 (1998) ("Under the First and Fifth Amendments, speakers are protected from arbitrary and discriminatory enforcement of vague standards."); *Grayned*, 408 U.S. at 108-09, 92 S. Ct. 2294 (1972) ("[I]f

---

[2] Numerous amici have come to the same conclusion. *See, e.g.*, Br. for First Amendment Lawyers Ass'n as Amicus Curiae 14 ("The multitude of Section 2(a) cases show that Section 2(a) does not convey 'sufficiently definite warning as to the proscribed conduct when measured by common understanding and practices,' as required by the Constitution." (quoting *Roth v. United States*, 354 U.S. 476, 491, 77 S. Ct. 1304, 1 L. Ed. 2d 1498 (1957))); Br. for Pro-Football, Inc. as Amicus Curiae 33 n.13 ("Even if Section 2(a) sought to advance a legitimate state interest, its language is impermissibly vague to advance that interest. The statute provides no guidance as to which trademarks will be deemed disparaging, scandalous, or immoral.").

arbitrary and discriminatory enforcement is to be prevented, laws must provide explicit standards for those who apply them. A vague law impermissibly delegates basic policy matters to policemen, judges, and juries for resolution on an ad hoc and subjective basis, with the attendant dangers of arbitrary and discriminatory application.") (footnotes omitted). *Cf. Kolender v. Lawson*, 461 U.S. 352, 357-58, 103 S. Ct. 1855, 75 L. Ed. 2d 903 (1983) (noting in the context of a criminal penalty scheme that, although the vagueness doctrine "focuses both on actual notice to citizens and arbitrary enforcement, we have recognized recently that the more important aspect of vagueness doctrine 'is not actual notice, but the other principal element of the doctrine—the requirement that a legislature establish minimal guidelines to govern law enforcement.' Where the legislature fails to provide such minimal guidelines, a criminal statute may permit 'a standardless sweep [that] allows policemen, prosecutors, and juries to pursue their personal predilections.'" (quoting *Smith v. Goguen*, 415 U.S. 566, 574, 575, 94 S. Ct. 1242, 39 L. Ed. 2d 605 (1974))).

Other circuits to have considered the use of the subjective terms connoting insult—like disparagement—have expressed similar concerns about the absence of objective standards governing their application.

In *Dambrot v. Central Michigan University*, 55 F.3d 1177 (6th Cir. 1995), for example, the Sixth Circuit considered the discriminatory harassment policy of Central Michigan University ("CMU"). That policy defined racial and ethnic harassment as:

> any intentional, unintentional, physical, verbal, or nonverbal behavior that subjects an individual to an

> intimidating, hostile or offensive educational, employment or living environment by . . . (c) *demeaning* or *slurring* individuals through . . . written literature because of their racial or ethnic affiliation; or (d) using symbols, [epithets] or slogans that infer negative connotations about the individual's racial or ethnic affiliation.

Id. at 1182 (emphases added). The court found the policy impermissibly vague because it required "one [to] make a subjective reference" and because "different people find different things offensive." *Id.* at 1184. As such, the policy's enforcement was too tied to subjective reference and, thus, both failed to "provide fair notice" and gave rise to an "unrestricted delegation of power" to university officials. *Id.* *See also Wynn Oil Co. v. Purolator Chem. Corp.*, 536 F.2d 84, 86 (5th Cir. 1976) (finding the subsection of an "injunction which restrains defendants from 'slandering and disparaging the Wynn Oil Co. and its products' [to be] impermissively vague").

In *Ridley v. Massachusetts Bay Transportation Authority*, 390 F.3d 65 (1st Cir. 2004), the First Circuit upheld the validity of the Massachusetts Bay Transportation Authority's ("MBTA") "guideline prohibiting demeaning or disparaging material," *id.* at 93, because, in that case, "there [was] no serious concern about either notice or chilling effects[] where there [were] no consequences for submitting a non-conforming advertisement and having it rejected" *id.* at 94. But that court specifically distinguished the guidelines at issue—"given the nature of the MBTA's advertising program and its chief purpose of raising revenue without losing ridership," *id.* at 94—from "the concern over

subjective decision making[, which has the] most effect in government licensing schemes" *id.* at 95. While the trademark registration scheme is not a traditional public forum making use of a licensing scheme to "maintain basic order," it implicates the "[e]xcessive discretion and vagueness inquiries under the First Amendment" in much the same way. *Id.* at 94. As the majority notes, trademark registrants receive substantial benefits from the fact of registration, Maj. Op. 1328-29; denial of those benefits based on the subjective views of governmental employees about the potential subjective views of those who might be exposed to the proposed mark is an essentially standardless measure.

In *McGinley*, we found § 2(a)'s ban on scandalous subject matter, "sufficiently precise to enable the PTO and the courts to apply the law fairly and to notify a would-be registrant that the mark he adopts will not be granted a federal registration." 660 F.2d at 484. While I agree that the PTO is capable of "notify[ing] a would-be registrant" of its decision to deny registration under § 2(a), the law is by no means precise enough to "enable the PTO and the courts to apply [it] fairly." *Id.* As the majority points out, the Board has allowed use of a term by one trademark holder while disallowing use of precisely the same term by another based apparently on its view of how use of that term might be received by the audience the Board has chosen to "identify." Maj. Op. 1336-38. This fact alone evidences the absence of explicit standards for the application of § 2(a).

As it turns out, the PTO's Assistant Commissioner was correct in 1939 in expressing concern that "the

word 'disparage' . . . is going to cause a great deal of difficulty in the Patent Office, because . . . it is always going to be just a matter of the personal opinion of the individual parties as to whether they think it is disparaging." *Hearing on H.R. 4744 Before the Subcomm. on Trademarks of the H. Comm. on Patents*, 76th Cong. 21 (1939) (statement of Leslie Frazer). The Board has likewise commented on the vague and subjective nature of § 2(a). *See, e.g., In re In Over Our Heads*, 1990 WL 354546, at *1 (T.T.A.B. 1990) ("[T]he guidelines for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one.") (bracketing and quotation marks omitted); *Harjo v. Pro-Football, Inc.*, 1999 WL 375907, at *35 (T.T.A.B. 1999) (noting that whether a mark is disparaging "is highly subjective and, thus, general rules are difficult to postulate").

"It is a basic principle of due process that an enactment is void for vagueness if its prohibitions are not clearly defined." *Grayned*, 408 U.S. at 108, 92 S. Ct. 2294. The need for clarity is especially relevant when a law implicates First Amendment rights, as § 2(a) indisputably does. Section 2(a) does not provide a "person of ordinary intelligence a reasonable opportunity to know what is prohibited, so that he may act accordingly." *Id.* And inconsistent, indeed seemingly rudderless, application of § 2(a) demonstrates the "arbitrary and discriminatory enforcement" that occurs when regulations do not "provide explicit standards for those who apply them." *Id.*

While I agree with the majority's thoughtful First Amendment analysis, I do not believe it is the only predicate to the conclusion that § 2(a) is unconstitutional.

CONCLUSION

For the above reasons, I concur in the majority's conclusions and separately concur in the result.

DYK, Circuit Judge, concurring in part and dissenting in part, with whom Circuit Judges LOURIE and REYNA join with respect to parts I, II, III, and IV.

The majority is correct that the bar on registration of disparaging marks is unconstitutional as applied to Mr. Tam. But in my view the majority errs in going beyond the facts of this case and holding the statute facially unconstitutional as applied to purely commercial speech.

It is noteworthy that the majority seeks to justify its sweeping holding by describing § 2(a) as being something it is not. The provision bars the registration of marks that "disparage . . . or bring into contempt, or disrepute." 15 U.S.C. § 1052(a) (otherwise identified as § 2(a)). The majority repeatedly asserts that "[t]he government enacted § 2(a), and defends it today, because it is hostile to the messages conveyed by the refused marks."[1] Maj. Op. at 1337.

---

[1] The majority frequently characterizes the statute as "discriminat[ing] on the basis of message conveyed" and hence "viewpoint." Maj. Op. at 1335. "It does so as a matter of avowed and undeniable purpose, and it does so on its face." *Id.* "Denial of these benefits creates a serious disincentive to adopt a mark which the government may deem offensive or disparaging." *Id.* at 1341. "The entire interest of the government in § 2(a) depends on disapproval

In my view, there is nothing in the statute itself or the legislative history that supports this interpretation. On its face, and as interpreted by the Trademark Trial and Appeal Board ("the Board"), the statute is designed to preclude the use of government resources not when the *government* disagrees with a trademark's message, but rather when its meaning "may be disparaging to *a substantial composite of the referenced group*." *In re Lebanese Arak Corp.*, 94 U.S.P.Q. 2d 1215, 1217 (T.T.A.B. 2010) (emphasis added). The PTO uses an objective test in making this determination, looking to dictionaries, the relationship of the matter to the other elements of the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services. *See id.*[2]

Thus the purpose of the statute is to protect underrepresented groups in our society from being bombarded with demeaning messages in commercial advertising. The question is whether the statute so designed can survive First Amendment scrutiny. My answer is that the statute is constitutional as applied

---

of the message." *Id.* at 1355. "All of the government's proffered interests boil down to permitting the government to burden speech it finds offensive." *Id.* at 1357.

[2] To be sure, the Board may have rendered inconsistent results in some cases, but this has no bearing on the facial validity of § 2(a). *See, e.g., Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 587, 118 S. Ct. 2168, 141 L. Ed. 2d 500 (1998); *Red Lion Broad. Co. v. F.C.C.*, 395 U.S. 367, 396, 89 S. Ct. 1794, 23 L. Ed. 2d 371 (1969). In any event, when the government is not acting in its sovereign, regulatory capacity, "the consequences of imprecision are not constitutionally severe." *Finley*, 524 U.S. at 589, 118 S. Ct. 2168.

to purely commercial trademarks, but not as to core political speech, of which Mr. Tam's mark is one example. Ultimately, unlike the majority, I do not think that the government must support, or society tolerate, disparaging trademarks in the name of commercial speech. The majority's opinion not only invalidates the bar on disparaging marks in § 2(a) but may also effectively invalidate the bar on scandalous marks and the analogous provisions of the Model State Trademark Act. *See* 1964 Model State Trademark Act, § 2(b). The government need not support the inevitable consequence of this decision—"the wider registration of marks that offend vulnerable communities." Maj. Op. at 1357-58.

I

As the majority notes, the Supreme Court has long recognized the protection of offensive speech that constitutes core political expression. "The right to free speech . . . may not be curtailed simply because the speaker's message may be offensive to his audience." *Hill v. Colorado*, 530 U.S. 703, 716, 120 S. Ct. 2480, 147 L. Ed. 2d 597 (2000). Underpinning the First Amendment's protection of core speech that is disparaging is the fundamental constitutional value of preserving an "uninhibited marketplace of ideas in which truth will ultimately prevail," a marketplace that provides "suitable access to social, political, esthetic, moral, and other ideas and experiences." *Red Lion*, 395 U.S. at 390, 89 S. Ct. 1794. Integral to an "uninhibited marketplace of ideas" is the ability to incite debate. "[A] principal function of free speech under our system of government is to invite dispute. It may

indeed best serve its high purpose when it induces a condition of unrest, creates dissatisfaction with conditions as they are, or even stirs people to anger." *Texas v. Johnson*, 491 U.S. 397, 408-09, 109 S. Ct. 2533, 105 L. Ed. 2d 342 (1989). Thus to maintain a "meaningful dialogue of ideas," "we must tolerate insulting, and even outrageous, speech in order to provide adequate breathing space to the freedoms protected by the First Amendment." *Snyder v. Phelps*, 562 U.S. 443, 452, 458, 131 S. Ct. 1207, 179 L. Ed. 2d 172 (2011) (internal quotation marks, citations, and alterations omitted).[3] At bottom, as Justice Holmes described, in the core speech area the First Amendment enshrines the "principle of free thought—not free thought for those who agree with us but freedom for the thought that we hate." *U.S. v. Schwimmer*, 279 U.S. 644, 654-55, 49 S. Ct. 448, 73 L. Ed. 889 (1929) (Holmes, J., dissenting).

But this principle simply does not apply in the commercial context. For example, it is well established that racially or sexually disparaging speech in the workplace, when severe, may constitute a violation of Title VII, either as harassment or the creation of a hostile work environment. *See, e.g., Faragher v. City of Boca Raton*, 524 U.S. 775, 787-88, 118 S. Ct. 2275, 141 L. Ed. 2d 662 (1998); *Rodgers v. Western-Southern Life Ins. Co.*, 12 F.3d 668, 675 (7th Cir. 1993).

---

[3] *See also, e.g., Cohen v. California*, 403 U.S. 15, 25, 91 S. Ct. 1780, 29 L. Ed. 2d 284 (1971); *Hess v. Indiana*, 414 U.S. 105, 107, 94 S. Ct. 326, 38 L. Ed. 2d 303 (1973); *Denver Area Educ. Telecomm. Consortium, Inc. v. F.C.C.*, 518 U.S. 727, 753-54, 116 S. Ct. 2374, 135 L. Ed. 2d 888 (1996).

The same is necessarily true in the context of federal public accommodations law governing commercial establishments. No case of which I am aware suggests that imposing liability for disparaging speech in those commercial contexts, even when separated from conduct, violates the First Amendment.

So too in the area of commercial speech race or sex disparagement can claim no First Amendment protection. Unlike core political expression, the "extension of First Amendment protection to commercial speech is justified principally by the value to consumers of the information such speech provides." *Zauderer v. Office of Disciplinary Counsel of Supreme Court of Ohio*, 471 U.S. 626, 651, 105 S. Ct. 2265, 85 L. Ed. 2d 652 (1985). Its constitutional protection derives not from any dialogic function in the marketplace of ideas, but rather from its "informational function" in the marketplace of goods and services, *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 563, 100 S. Ct. 2343, 65 L. Ed. 2d 341 (1980), in other words, "who is producing and selling what product, for what reason, and at what price." *Va. State Bd. Of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 765, 96 S. Ct. 1817, 48 L. Ed. 2d 346 (1976); *see also Sorrell v. IMS Health Inc.*, — U.S. —, 131 S. Ct. 2653, 2673-74, 180 L. Ed. 2d 544 (2011) (Breyer, J., dissenting). We protect the dissemination of this information to ensure that "private economic decisions" are "intelligent and well informed." *Va. State Bd. Of Pharmacy*, 425 U.S. at 765, 96 S. Ct. 1817.

Speech proposing a commercial transaction is "an area traditionally subject to government regulation." *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 499, 116 S. Ct. 1495, 134 L. Ed. 2d 711 (1996) (citing and quoting *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 456, 98 S. Ct. 1912, 56 L. Ed. 2d 444 (1978)). The Court has "been careful to distinguish commercial speech from speech at the First Amendment's core," *Florida Bar v. Went For It, Inc.*, 515 U.S. 618, 623, 115 S. Ct. 2371, 132 L. Ed. 2d 541 (1995), recognizing the "commonsense distinctions that exist between commercial and noncommercial speech." *44 Liquormart*, 517 U.S. at 502, 116 S. Ct. 1495 (quoting *Virginia Bd. of Pharmacy*, 425 U.S. at 771 n.24, 96 S. Ct. 1817). The "greater objectivity" and "greater hardiness" of commercial speech and the different constitutional values underlying its protection "likely diminish[] the chilling effect that may attend its regulation." *44 Liquormart*, 517 U.S. at 499, 116 S. Ct. 1495 (internal quotation marks and citations omitted). Accordingly, the Court has explained that "the State may regulate some types of commercial advertising more freely than other forms of protected speech," *id.* at 498, 116 S. Ct. 1495 (internal quotations marks and citations omitted), and "the State may at times prescribe what shall be orthodox in commercial advertising," *Hurley v. Irish-American Gay, Lesbian & Bisexual Group of Boston*, 515 U.S. 557, 573, 115 S. Ct. 2338, 132 L. Ed. 2d 487 (1995) (internal quotation marks and citations omitted) —something it could never do with core political speech.

Recognizing the more limited protection of commercial speech, the Court has repeatedly upheld reg-

ulations "protect[ing] consumers from misleading, deceptive, or aggressive sales practices," because such regulations are "consistent with the reasons for according constitutional protection to commercial speech" in the first place. *44 Liquormart*, 517 U.S. at 501, 116 S. Ct. 1495; *see also, e.g., Florida Bar*, 515 U.S. 618, 115 S. Ct. 2371, 132 L. Ed. 2d 541 (1995); *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490, 101 S. Ct. 2882, 69 L. Ed. 2d 800 (1981); *Bates v. State Bar of Ariz.*, 433 U.S. 350, 97 S. Ct. 2691, 53 L. Ed. 2d 810 (1977). "There can be no constitutional objection to the suppression of commercial messages that do not accurately inform the public about lawful activity." *Central Hudson*, 447 U.S. at 563, 100 S. Ct. 2343.

This stands in stark contrast to core political speech, for which "constitutional protection does not turn upon 'the truth . . . of the ideas and beliefs which are offered.'" *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 271, 84 S. Ct. 710, 11 L. Ed. 2d 686 (1964) (quoting *NAACP v. Button*, 371 U.S. 415, 445, 83 S. Ct. 328, 9 L. Ed. 2d 405 (1963)). "The erroneous statement is inevitable in free debate, and [] it must be protected [absent a showing of actual malice] if the freedoms of expression are to have the breathing space that they need to survive." *Id.* at 271-72, 84 S. Ct. 710 (internal quotation marks, citations, and alterations omitted). "Authoritative interpretations of the First Amendment guarantees have consistently refused to recognize an exception for any test of truth." *N.Y. Times*, 376 U.S. at 271, 84 S. Ct. 710. *See also Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 52, 108 S. Ct. 876, 99 L. Ed. 2d 41 (1988).

To be sure, the Court has held that commercial advertising cannot be restricted just because the product or service may be offensive to some members of the audience. *See Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71, 103 S. Ct. 2875, 77 L. Ed. 2d 469 (1983); *Carey v. Population Servs. Int'l*, 431 U.S. 678, 701, 97 S. Ct. 2010, 52 L. Ed. 2d 675 (1977). But, at the same time, the Court has explained that the manner of advertising itself may be restricted to protect the audience's privacy interests. *See Florida Bar v. Went For It, Inc.*, 515 U.S. 618, 630, 115 S. Ct. 2371, 132 L. Ed. 2d 541 (1995). "[T]he existence of [First Amendment] protection does not deprive the State of all power to regulate such advertising in order to minimize its offensiveness." *Bolger*, 463 U.S. at 84, 103 S. Ct. 2875 (1983) (Stevens, J., concurring) (citing and quoting from *Carey*, 431 U.S. at 716, 97 S. Ct. 2010 (Stevens, J., concurring)).

For example, in *Florida Bar* the Court upheld a ban on lawyer advertising targeted to recent accident victims and their families. 515 U.S. at 634-35, 115 S. Ct. 2371. There the Court distinguished *Bolger*, which rejected a total ban on advertising related to contraceptives, because the government's interest in *Bolger* had been only to shield citizens from generally "offensive" and "intrusive" products. *See id.* at 630-31, 115 S. Ct. 2371. That interest, the Court explained, was entirely different from the interest in "protecting the personal privacy and tranquility of [Florida's] citizens from crass commercial intrusion by attorneys upon their personal grief in times of trauma." *Id.* at 630, 115 S. Ct. 2371 (alterations omitted). The Court thus had "little trouble crediting the Bar's" "privacy-based"

interest as "substantial," and held that it was sufficient to justify the advertising ban. *Id.* at 625, 629, 635, 115 S. Ct. 2371.

Disparagement as defined by the Board "is essentially a violation of one's right of privacy—the right to be let alone from contempt or ridicule." TMEP § 1203.03(b). While in the trademark context the dissemination of the disparaging material is not limited to the disparaged group, the disparaged group is nonetheless targeted in the sense that it is singled out for ridicule. Furthermore, the fact that the dissemination of the disparaging advertising is not limited to the disparaged group makes the government's interest here all the greater—the effect on the disparaged group is amplified, not lessened, by disseminating the disparaging material to the public at large.

This well-recognized disparity in the types of restrictions that are permissible as applied to commercial as opposed to political speech derives from the very different constitutional values underlying their protection in the first place. The Court has recognized that the government has greater authority to "distinguish between the relative value of different categories of commercial speech" than of noncommercial speech. *Metromedia*, 453 U.S. at 514, 101 S. Ct. 2882. Specifically, the government has a distinct and substantial interest in "proscribing intrusive and unpleasant formats" for commercial expression. *Members of City Council of L.A. v. Taxpayers for Vincent*, 466 U.S. 789, 806, 104 S. Ct. 2118, 80 L. Ed. 2d 772 (1984); *see also Lehman v. City of Shaker Heights*, 418 U.S. 298, 304, 94 S. Ct. 2714, 41 L. Ed. 2d 770 (1974);

Metromedia, 453 U.S. at 514, 101 S. Ct. 2882. Indeed, "it may not be the content of the speech, as much as the deliberate 'verbal or visual assault,' that justifies proscription." *Hill*, 530 U.S. at 716, 120 S. Ct. 2480 (quoting *Erznoznik v. Jacksonville*, 422 U.S. 205, 210-11, n.6, 95 S. Ct. 2268, 45 L. Ed. 2d 125 (1975)).

Unlike core political speech, where offensiveness or disparagement has recognized value in its tendency to provoke debate, disparagement in commercial advertising furthers no First Amendment value. Indeed, neither counsel at oral argument nor the majority in its opinion has identified any First Amendment value served by disparaging speech in the commercial context. Thus even blanket bans on commercial speech may be the kind of consumer protective regulations that are consistent with the "informational function" of commercial advertising. *See Central Hudson*, 447 U.S. at 563, 100 S. Ct. 2343.

The majority, apparently recognizing that purely commercial speech is entitled to lesser protection, urges that all disparaging trademarks deserve heightened First Amendment protection because they have an expressive component. *See* Maj. Op. at 1337-38. While I agree that some marks, including Mr. Tam's, have an expressive component, it would seem beyond debate that many do not, as is the case with respect to routine product identifiers. Indeed, the Supreme Court confirmed the lack of an expressive component in most trade names in *Friedman v. Rogers*, where it explicitly distinguished between advertisements that "editorialize on any subject, cultural, philosophical, or political," which might be entitled to greater First

Amendment protection, and the "mere solicitation of patronage implicit in a trade name," which "is a form of commercial speech and nothing more." 440 U.S. 1, 11, n.10, 99 S. Ct. 887, 59 L. Ed. 2d 100 (1979). The Court again recognized this distinction in *S.F. Arts & Athletics Inc. v. U.S. Olympic Comm'n*, 483 U.S. 522, 535, 107 S. Ct. 2971, 97 L. Ed. 2d 427 (1987). "To the extent that [the statute] applies to uses for the purpose of trade [or] to induce the sale of any goods or services, its application is to commercial speech." *Id.* (alterations omitted).

In short, many trademarks lack the kind of "expressive character" that would merit First Amendment protection for offensive content, and a regulation of the use of those marks could satisfy the *Central Hudson* test for commercial speech—a substantial government interest reflected in a narrowly tailored regulation. The majority's contrary conclusion seems to me to be unsupported.

II

Even if disparaging commercial speech were protected from government ban or regulation, this case does not turn on the legitimacy of a regulation or a "blanket ban" on disparaging commercial speech. The refusal to register disparaging marks is not a regulation or "blanket ban" on anything. Rather, it involves the denial of a subsidy, and because it is a subsidy, it may be content based. It is "well established that the government can make content-based distinctions when it subsidizes speech." *Davenport v. Wash. Educ. Ass'n*, 551 U.S. 177, 188-89, 127 S. Ct. 2372, 168 L. Ed. 2d 71 (2007). The First Amendment "does not

confer an affirmative right to use government || mechanisms for the purpose of" expression, nor is the government "required to assist others in funding the expression of particular ideas, including political ones." *Ysursa v. Pocatello Educ. Ass'n*, 555 U.S. 353, 355, 358, 129 S. Ct. 1093, 172 L. Ed. 2d 770 (2009) (internal quotations and citations omitted). Significantly, every single Supreme Court decision upholding the protection of commercial speech has involved a prohibition or restriction of speech—not a subsidy.[4]

That trademark registration is a subsidy is not open to doubt. Contrary to the majority's characterization, federal trademark registration is not a "regulatory regime." Maj. Op. at 1353. Section 2(a) does not regulate any speech, much less impose a blanket ban. It merely deprives a benefit. The majority claims that federal trademark registration is not a subsidy because "the subsidy cases have all involved government funding or government property." Maj. Op. at 1351. But this assertion is belied by the Court's recent decisions in *Davenport* and *Ysursa*—neither in-

---

[4] *See, e.g., Linmark Assocs., Inc. v. Twp. of Willingboro*, 431 U.S. 85, 97, 97 S. Ct. 1614, 52 L. Ed. 2d 155 (1977) (striking down a ban on placing "For Sale" and "Sold" signs on residential property); *Carey*, 431 U.S. at 701-02, 97 S. Ct. 2010 (invalidating a ban on all advertising and display of contraceptives); *Bolger*, 463 U.S. at 71, 103 S. Ct. 2875 (invalidating a ban on unsolicited mailing of contraceptive advertisements); *Va. State Bd. of Pharmacy*, 425 U.S. at 773, 96 S. Ct. 1817 (invalidating a ban on advertising prescription drug prices); *Sorrell v. IMS Health Inc.*, — U.S. —, 131 S. Ct. 2653, 2659, 180 L. Ed. 2d 544 (2011) (invalidating a state law that prohibited the sale, disclosure, and use of pharmacy records without the prescriber's consent and subject to limited exceptions).

volving government funding or property. Each made clear that the government can make content-based distinctions when it provides a benefit.

In *Davenport*, the Court considered a government benefit that gave unions "the power, in essence, to tax government employees," by having the state collect fees from its employees on behalf of the unions. *Davenport*, 551 U.S. at 184, 127 S. Ct. 2372. The state limited this collection mechanism by refusing to collect nonmember fees for election-related purposes unless the nonmember affirmatively consented. *Id.* at 180, 127 S. Ct. 2372. The unions argued that this restriction was an unconstitutional content-based discrimination. *Id.* at 188, 127 S. Ct. 2372. The Court disagreed. The First Amendment's usual aversion to content-based speech regulation is inapposite when "the government is acting in a capacity other than as regulator," such as "when it subsidizes speech." *Id.* at 188, 127 S. Ct. 2372. Because the collection of nonmember fees was a "state-bestowed entitlement," "a matter of grace [that] [it] can, of course, disallow . . . as it chooses," *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540, 549, 103 S. Ct. 1997, 76 L. Ed. 2d 129 (1983) (internal quotations and citations omitted), the content-based condition on that benefit did not raise a "realistic possibility that official suppression of ideas is afoot." *Davenport*, 551 U.S. at 189-90, 127 S. Ct. 2372 (citations and quotation marks omitted). The unions remained "as free as any other entity to participate in the electoral process with all available funds other than the state-coerced agency fees." *Id.* at 190, 127 S. Ct. 2372. Thus the Court declined to apply heightened scrutiny and upheld the

restriction in light of the state's "narrow" and legitimate interest in "protect[ing] the integrity of the election process." *See id.* at 189-90, 127 S. Ct. 2372.

In *Ysursa*, the Court considered a similar benefit where the state collected dues on behalf of unions by providing payroll deductions. *Ysursa*, 555 U.S. at 355, 129 S. Ct. 1093. The state restricted that collection mechanism by preventing unions from using payroll deductions for any political purposes. *Id.* Again the unions argued that this restriction was an impermissible content-based speech restriction, and again the Court disagreed. The First Amendment "protects the right to be free from government abridgement of speech," not the right to be "assist[ed] [] in funding the expression of particular ideas." *Id.* at 358, 129 S. Ct. 1093. "While publicly administered payroll deductions for political purposes can enhance the unions' exercise of First Amendment rights, Idaho is under no obligation to aid the unions in their political activities." *Id.* at 359, 129 S. Ct. 1093. Because collecting payroll deductions was a government benefit, the State's decision not to extend that benefit was "not an abridgement of the unions' speech." *Id.* As in *Davenport*, the unions remained "free to engage in such speech as they see fit. They simply are barred from enlisting the State in support of that endeavor." *Id.* Thus the Court again declined to apply heightened scrutiny and upheld the regulation in light of the "government's interest" in "avoiding the reality or appearance of government favoritism." *Id.*

The same is true here. Federal trademark registration, like the state-bestowed collection mechanisms

for unions in *Davenport* and *Ysursa*, is a government-bestowed collection mechanism for enforcing trademarks. It opens the federal courts to enforce trademark rights by providing, *inter alia*, original jurisdiction in federal courts for infringement claims, eligibility for treble damages for willful infringement, the ability to petition Customs to prevent the importation of infringing articles, and various enhanced protections for marks. *See* 15 U.S.C. §§ 1057(c), 1141, 1117, 1124. These benefits all "enlist" the government in support of the mark holder's commercial identification, much like the collection of nonmember fees in *Davenport* and the payroll deductions in *Ysursa* enlisted the states in support of the unions' political speech. *See Ysursa*, 555 U.S. at 359, 129 S. Ct. 1093. Just as the states were not obligated to enable labor unions to collect nonmember fees or take payroll deductions in the first place, the federal government is not obligated to provide these benefits of a trademark enforcement mechanism. And just as the unions remained free to speak for election-related purposes using all other funds, trademark holders remain free to use their marks—however disparaging—as far as the federal government is concerned.[5] That states may deny state-law protection to these marks cannot make the denial of the federal subsidy any less constitutional.

Finally, the majority argues that § 2(a) should be treated as a regulatory provision because the denial of registration benefits will have a chilling effect on the

---

[5] That alternative federal enforcement under 15 U.S.C. § 1125(a) is potentially available to denied applicants only bolsters this point. *See* Maj. Op. at 1344-45 n.11.

use of disparaging marks and cause mark holders to abandon such marks. *See* Maj. Op. at 1342-43. But that is commonly the effect of the denial of subsidies, as the Supreme Court has recognized. *See Regan*, 461 U.S. at 550, 103 S. Ct. 1997 ("Although TWR does not have as much money as it wants, and thus cannot exercise its freedom of speech as much as it would like," the decision not to subsidize its speech does not violate the First Amendment). A chilling effect does not turn a subsidy provision into a regulatory provision, so long as the subsidy is not designed to limit speech outside of the subsidized program. That is not the case here.

"[T]he relevant distinction that has emerged from our cases is between conditions that define the limits of the government spending program—those that specify the activities Congress wants to subsidize—and conditions that seek to leverage funding to regulate speech outside the contours of the program itself." *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, — U.S. —, 133 S. Ct. 2321, 2328, 186 L. Ed. 2d 398 (2013) ("*AID*"). An example of such impermissible leverage was found in *FCC v. League of Women Voters*, where federal funds were denied to public broadcasters if they engaged in editorializing. 468 U.S. 364, 399-401, 104 S. Ct. 3106, 82 L. Ed. 2d 278 (1984). The restriction was invalidated because it affected editorializing engaged in without federal funds. *Id.* Section 2(a) is not designed to limit speech outside of the federal trademark program. Accordingly,

it does not run afoul of the unconstitutional conditions doctrine.[6] *See id.*

The majority's contrary arguments are the very arguments rejected in the Supreme Court's recent decision in *AID*. *See* 133 S. Ct. at 2328. *AID* explicitly disclaimed the majority's assertion that the condition must be limited to "advancing the goals underlying the program the government seeks to fund." Maj. Op. at 1354. The question is not whether "the condition is [] relevant to the objectives of the program," but rather whether the condition "seek[s] to leverage funding to regulate speech outside the contours of the program itself," which the restriction here does not. *AID*, 133 S. Ct. at 2328. Similarly, in *Regan* the Court upheld a requirement that nonprofit organizations seeking tax-exempt status under 26 U.S.C. § 501(c)(3) not engage in lobbying. 461 U.S. at 544, 103 S. Ct. 1997. The Court upheld that condition not because it was related in some way to the "goals" of 501(c)(3) tax exemption, but rather because "the condition did not prohibit that organization from lobbying Congress" with separate funds, *i.e.*, it did not leverage funds outside of the nonprofit structure. *Id.* at 2329.

---

[6] *Bullfrog Films, Inc. v. Wick*, 847 F.2d 502, 503 (9th Cir. 1988), *Dep't of Tex., Veterans of Foreign Wars v. Tex. Lottery Comm'n*, 760 F.3d 427, 430 (5th Cir. 2014) (en banc), and *Autor v. Pritzker*, 740 F.3d 176, 177 (D.C. Cir. 2014), relied on by the majority, Maj. Op. at 1351-53, are all inapposite. In all three cases, the government was attempting to leverage speech outside of the "contours" of its defined program, thus running afoul of the unconstitutional conditions doctrine. Here, on the other hand, no expression beyond the trademark is suppressed, and therefore no unconstitutional condition obtains.

The majority's arguments fail to show a colorable violation of the unconstitutional conditions doctrine here.

III

The majority urges, however, that subsidies require viewpoint neutrality, and argues that the subsidy provided by § 2(a) discriminates based on viewpoint because favorable racial and other marks are allowed while disparaging ones are not. *See* Maj. Op. at 1336-38. Contrary to the majority, the Supreme Court has never held that this kind of subsidy must be viewpoint neutral. The question was raised, but not answered, in *Davenport* and *Ysursa*. *See Davenport*, 551 U.S. at 189, 127 S. Ct. 2372 ("Even if it be thought necessary that the content limitation be reasonable and viewpoint neutral . . . "); *Ysursa*, 555 U.S. at 361, n.3, 129 S. Ct. 1093. And the Court has upheld subsidies that were facially viewpoint discriminatory. *See, e.g., Rust v. Sullivan*, 500 U.S. 173, 111 S. Ct. 1759, 114 L. Ed. 2d 233 (1991) (upholding a condition limiting Title X funding to clinics that do not advocate abortion as a method of family planning). The Court made an exception in a subsidy case involving the unique context of legal services, where "the traditional role of the [subsidized] attorneys" is to "speak[] on the behalf of his or her private, indigent client" and viewpoint discrimination undermined the very purpose of the subsidy. *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 542, 544, 121 S. Ct. 1043, 149 L. Ed. 2d 63 (2001). There is no tradition of unfettered advocacy in commercial advertising. Thus even if the regulation here could be deemed viewpoint discriminatory, it

would not fail under the First Amendment. *See Davenport*, 551 U.S. at 189, 127 S. Ct. 2372.

But § 2(a) is in any event viewpoint neutral. In *Boos v. Barry*, 485 U.S. 312, 108 S. Ct. 1157, 99 L. Ed. 2d 333 (1988), the Court addressed a nearly identical standard as applied to core political speech. The law there prohibited the display of any sign within 500 feet of a foreign embassy if the sign would tend to bring that foreign government into "public odium" or "disrepute." *Id.* at 315, 108 S. Ct. 1157. Justice O'Connor's plurality opinion confirmed that the restriction is "content-based," but it specifically found that "the provision is *not* viewpoint based." *Id.* at 319, 108 S. Ct. 1157 (emphasis added). "The display clause determines which viewpoint is acceptable in a *neutral fashion* by looking to the policies of foreign governments." *Id.* (emphasis added). This "prevents the display clause from being directly viewpoint based, a label with potential First Amendment ramifications of its own." *Id.* This aspect of the plurality opinion has since been cited with approval by a majority of the Court in *Turner Broadcasting System, Inc. v. FCC*, 512 U.S. 622, 645, 114 S. Ct. 2445, 129 L. Ed. 2d 497 (1994). The same reasoning applies here. Just as the restriction in *Boos* operated in a "neutral fashion" by looking only to foreign governments, the bar on registration of disparaging marks operates in a "neutral fashion" by looking only to the views of the referenced group. Accordingly, just as the restriction in *Boos* was viewpoint neutral, so too is § 2(a). In *Ridley v. Massachusetts Bay Transportation Authority*, 390 F.3d 65 (1st Cir. 2004), the First Circuit arrived at the same conclusion, holding that a regulation "pro-

hibit[ing] demeaning or disparaging ads" was viewpoint neutral because "the state is not attempting to give one group an advantage over another in the marketplace of ideas." *Id.* at 90-91.

Finding § 2(a) to be viewpoint neutral is consistent with the Court's treatment of viewpoint discrimination in other areas. The Court has defined viewpoint discrimination as the *government's* disagreement with the underlying "ideology," "opinion" or "perspective of the speaker." *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829, 115 S. Ct. 2510, 132 L. Ed. 2d 700 (1995). Here, as in *Boos*, the standard is not based on the *government's* disagreement with anything. Rather, it is based on an objective, "neutral" assessment of a non-government perspective—in this case, a "substantial composite of the referenced group." As in *Davenport* and *Ysursa*, there is no "realistic possibility that official suppression of ideas is afoot," *Davenport*, 551 U.S. at 190, 127 S. Ct. 2372 and the content-based regulation here is not subject to heightened First Amendment scrutiny.

IV

Even in subsidy cases, however, the government needs some interest sufficient to justify its regulation defined in terms of "reasonableness." *See Ysursa*, 555 U.S. at 359, 129 S. Ct. 1093; *Regan*, 461 U.S. at 550, 103 S. Ct. 1997. In my view, the protection of disparaged groups is sufficient. As demonstrated on college campuses across the nation, members of some groups, whether or not justified, are particularly sen-

sitive to disparaging material.[7] There is significant social science evidence demonstrating the harmful psychological effects of holding a minority group up for ridicule on a national stage, particularly on children and young adults.[8] In the case of core protected speech, as discussed above, the government has no legitimate interest in protecting disparaged groups. The groups must tolerate the disparagement in pursuit of the greater goal of a free marketplace of ideas. But, as discussed above, commercial speech is different. Disparagement as defined by the Board "is essentially a violation of one's right of privacy—the right to be let alone from contempt or ridicule." TMEP § 1203.03(c).

The government has an interest in "proscribing intrusive and unpleasant formats" for commercial expression. *Taxpayers for Vincent*, 466 U.S. at 806, 104 S. Ct. 2118; *see also Lehman*, 418 U.S. at 304, 94 S. Ct. 2714; *Metromedia*, 453 U.S. at 514, 101 S. Ct. 2882. The Supreme Court's "precedents [] leave no room for doubt that the protection of potential clients' privacy is

---

[7] *See, e.g.*, Chuck Culpepper, *How Missouri foot-ball's boycott helped bridge a familiar campus divide*, Wash. Post (Nov. 13, 2015), https://www.washingtonpost.com/sports/colleges/how missouri-footballs-boycott-helped-unite-a-troubled-campus/2015/11 /13/64fe68ea-8a0f-11e5-be8b-1ae2e4f50f76-story.html.

[8] *See, e.g.*, American Psychological Ass'n, *APA Resolution Recommending the Immediate Retirement of American Indian Mascots, Symbols, Images, and Personalities by Schools, Colleges, Universities, Athletic Teams, and Organizations* (2011), *available at* http://www.apa.org/about/policy/mascots.pdf (citing many studies finding psychological harm of exposure to negative stereotypes).

a substantial state interest." *Florida Bar*, 515 U.S. at 625, 115 S. Ct. 2371 (internal quotations marks omitted). We need not decide whether this interest is sufficiently compelling to justify a ban of disparaging commercial speech. It is more than sufficient to justify the government's "decision not to assist" disparaging commercial expression. *Ysursa*, 555 U.S. at 360 n.2, 129 S. Ct. 1093; *Taxpayers for Vincent*, 466 U.S. at 806, 104 S. Ct. 2118. At the same time, there is no countervailing First Amendment interest. It is certainly difficult to imagine, for example, how the disparaging elements of an advertisement such as "CHLORINOL SODA BLEACHING—we are going to use Chlorinol and be like de white nigger,"[9] or "The Plucky Little Jap Shredded Wheat Biscuit,"[10] or "Dr. Scott's Electric Hair Brush—will not save an Indian's scalp from his enemies but it will preserve yours from dandruff,"[11] further any legitimate "informational function" associated with the relevant product.

V

Finally, contrary to the majority's implication, it is quite feasible to distinguish between core and commercial speech. Congress has already determined

---

[9] Julian Casablancas, *15 Shockingly Racist Vintage Ads*, Business Pundit (Dec. 17, 2012), http://www.businesspundit.com/15-shockingly-racist-vintage-ads/?img=42884.

[10] Dan Beard, 24 *Recreation* 1 (1905) *available at* https://books.google.com/books?id=LPQXAAAAYAAJ&pg=PA474-IA18#v=onepage&g&f=false.

[11] Brian D. Behnken & Gregory D. Smithers, *Racism in American Popular Media: From Aunt Jemima to the Frito Bandito* 39 (2015).

that trademark law should distinguish between pure commercial speech and fully protected speech. Section 1125(c)(3) of title 15 excludes from liability for dilution parody, criticism, and any noncommercial use of a mark. And the noncommercial use of a mark, for parody, as an example, weighs against likelihood of confusion. *See, e.g., Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989); *Davis v. Walt Disney Co.*, 430 F.3d 901 (8th Cir. 2005); *see also Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Group, Inc.*, 886 F.2d 490, 494-95 (2d Cir. 1989) ("the expressive elements of titles require[] more protection than the labeling of ordinary commercial products . . . so here the expressive element of parodies requires more protection than the labeling of ordinary products."). Congress has made a similar judgment in the copyright context. *See* 17 U.S.C. § 107 (one of four fair use factors includes assessing whether the use is commercial). I see no reason why the Board would be unable to make such distinctions here.

VI

Turning from the application of § 2(a) to commercial speech to the facts of this case, I agree with the majority that the bar on registration of disparaging marks is unconstitutional as applied to Mr. Tam. Here there can be no doubt that Mr. Tam's speech is both political and commercial. Unlike *Friedman*, where the trade name proponent did "not wish to editorialize on any subject, cultural, philosophical, or political," 440 U.S. at 11, 99 S. Ct. 887, Mr. Tam's choice of mark reflects a clear desire to editorialize on cultural and political subjects. Mr. Tam chose THE

SLANTS at least in part to reclaim the negative racial stereotype it embodies: "We want to take on these stereotypes that people have about us, like the slanted eyes, and own them. We're very proud of being Asian —we're not going to hide that fact." *In re Simon Shiao Tam*, 108 U.S.P.Q. 2d 1305, 2013 WL 5498164 at *2 (T.T.A.B. 2013). *See* Maj. Op. at 1332 (Mr. Tam "selected the mark in order to 'own' the stereotype it represents.").

Given the indisputably expressive character of Mr. Tam's trademark in this case, the government's recognized interests in protecting citizens from targeted, demeaning advertising and proscribing intrusive formats of commercial expression—interests that are sufficient to justify the provision as applied to commercial speech—are insufficient to justify application of the provision to Mr. Tam. As discussed, because of the fundamental values underlying the First Amendment's robust protection of offensive speech that are unique to core political expression, the government cannot justify restricting disparaging trademarks when those marks, like Mr. Tam's, actually consist of core expression. *See, e.g., Snyder*, 562 U.S. at 459-61, 131 S. Ct. 1207. Accordingly, because no government interest can justify restricting Mr. Tam's core speech on the basis of its capacity to injure others, § 2(a) is invalid as applied. This also explains why the majority's concern regarding copyright is misplaced. *See, e.g.*, Maj. Op. at 1354-55. Copyrights, unlike trademarks, principally cover core protected expression. Thus, as for Mr. Tam, any government interest related to suppressing offensive speech would be insufficient to jus-

tify a comparable restriction as applied to copyright registration except for commercial advertising.

No case before the majority's opinion today has imposed an obligation on the government to subsidize offensive, commercial speech. As Judge Lourie points out, the bar on registration of disparaging marks is longstanding, and we have previously upheld it in a number of decisions. I see no basis for invalidating it now as applied to commercial speech. I would adhere to those decisions in this respect, and I respectfully dissent.

LOURIE, Circuit Judge, dissenting.

I join Parts I-IV of Judge Dyk's concurrence-in-part, dissent-in-part, but I respectfully dissent with respect to the result reached by the majority holding the disparagement provision of § 2(a) unconstitutional as violating the First Amendment. For the following additional reasons, I would affirm the USPTO's decision refusing to register Mr. Tam's trademark.

First, one wonders why a statute that dates back nearly seventy years—one that has been continuously applied—is suddenly unconstitutional as violating the First Amendment. Is there no such thing as settled law, normally referred to as *stare decisis*? Since the inception of the federal trademark registration program in 1905, the federal government has declined to issue registrations of disparaging marks. The Trademark Act of 1905 provided specific authority to refuse to register immoral or scandalous marks, *see* Act of Feb. 20, 1905, ch. 592, 33 Stat. 724; the USPTO refused to register disparaging marks on those grounds before

the Lanham Act of 1946 was enacted, which explicitly incorporated a disparagement proscription, *see* Appellee's En Banc Br. 6. The USPTO's authority to refuse to issue trademark registrations with certain offensive content has thus existed in U.S. law for over one hundred years. As the majority notes, these are not prohibitions that have lain unused and latent for all of those years. The USPTO has been rejecting applications for trademark registrations on this basis throughout this period of time. By finding § 2(a) unconstitutional, we interfere with the long-standing Congressional policy of delegating authority to the USPTO to filter out certain undesirable marks from the federal trademark registration system. We should not further the degradation of civil discourse by overturning our precedent that holds that the First Amendment is not implicated by § 2(a)'s prohibition against disparaging trademarks.

In addition, the refusal of the USPTO to register a trademark is not a denial of an applicant's right of free speech. The markholder may still generally use the mark as it wishes; without federal registration, it simply lacks access to certain federal statutory enforcement mechanisms for excluding others from confusingly similar uses of the mark. Mr. Tam may use his trademark as he likes, whether it be encouraging discussion on or taking ownership of racial slurs, or identifying goods and services with his band. In fact, it seems quite likely that Mr. Tam will continue to use his band name to make a statement regardless of federal registration—the expressive purpose of his mark undoubtedly overshadows the commercial considerations. The argument, therefore, that a trademark ap-

plicant's right of free speech has been impaired by the failure of the USPTO to grant a federal registration is unconvincing.

Furthermore, it is not entirely clear that a trademark, speech. The lack of a federal registration does not alter the informational function of a trademark: disparaging marks may still be used to identify the source of goods or services. The government's decision to support certain choices and not others will invariably have some discouraging effect, but the government does not necessarily violate an individual's constitutional rights merely by refusing to grant registration and thereby provide additional assistance in the enforcement of trademark rights.

Moreover, trademark rights, as amicus International Trademark Association informs us, are not limited to those marks deemed registrable by the USPTO. "Section 43(a) of the Lanham Act is available to protect all designations of origin, even—indeed, especially —those that cannot be registered under Section 2(a)." Br. of amicus curiae Int'l. Trademark Ass'n 4. The fear that mark-holders would be left with absolutely no recourse for trademark protection, once an application for federal registration is denied, appears unfounded. Rather, all that is at issue here is the government's decision not to facilitate enforcement with the additional mechanisms attendant to federal registration. The denial of federal trademark registration thus does not deprive the mark-holder of trademark protection because of the content of its mark; the markholder still has trademark rights under the Act in addition to its common law rights.

Finally, it has been questioned whether federal registration imparts the "imprimatur" of the federal government on a mark, such that registration could be permissibly restricted as government speech. I believe that such action is justified. The USPTO does in fact "publish" trademarks, in the Trademark Official Gazette. Despite being in electronic form, it is still a form of government speech that is partially controlled or affected by government action. The USPTO may also require that a disclaimer of unregistrable components be included for publication. Moreover, a federally registered mark is usually "stamped" with some indication of government oversight, *viz.*, the use of the ® symbol or a phrase that the mark is registered in the USPTO, giving proof to the public that the government has in some sense approved the mark. Without that designation, the markholder cannot take advantage of some of the benefits of federal registration, *e.g.*, constructive notice for damages.

Similarly to specialty license plate designs, federally registered trademarks can be identified with two message contexts: one from the provider of goods or services, who has chosen to use a certain mark to link its product or services to itself, and one from the government, which has deemed the mark qualified for the federal registration program. The evaluation of disparagement is not based on the government's moral judgment, despite any distaste expressed in its briefing for cancelled or applied-for marks; a mark is disqualified based only on evidence of its perception by the affected persons. The government action does not include a judgment on the worthiness or the effectiveness of the mark; if it did, it might—but not nec-

essarily—venture into viewpoint-discrimination territory. And while a trademark alone, as a word placed on private property, is not government speech, once it claims that federally registered status, it becomes more than the private owner's speech. It is not simply private speech as is the holding of a placard in a parade.

In my view, holding the disparagement provision of § 2(a) unconstitutional would be unsound, and the USPTO's refusal to register Mr. Tam's disparaging mark should therefore be affirmed.

Accordingly, I respectfully dissent.

REYNA, Circuit Judge, dissenting.

The Majority holds today that Mr. Tam's speech, which disparages those of Asian descent, is valuable political speech that the government may not regulate except to ban its use in commerce by everyone but Mr. Tam. I believe the refusal to register disparaging marks under § 2(a) of the Lanham Act is an appropriate regulation that directly advances the government's substantial interest in the orderly flow of commerce. Because I would uphold the constitutionality of § 2(a), I respectfully dissent.

Trademarks are commercial speech. And precisely because trademarks are commercial speech, the government's decision to grant or deny registration must be reviewed under an intermediate standard of scrutiny. Intermediate scrutiny is satisfied whenever the decision is narrowly tailored to directly advance a substantial government interest. When the commercial or political content of a trademark threatens the

government's substantial interest in the orderly flow of commerce, appropriate regulation may be justified.

DISCUSSION

A. Intermediate Scrutiny Applies Because Trademarks Are Commercial Speech

The Supreme Court has held that trademarks are "a form of commercial speech and nothing more." *Friedman v. Rogers*, 440 U.S. 1, 11, 99 S. Ct. 887, 59 L. Ed. 2d 100 (1979); *accord San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 563, 107 S. Ct. 2971, 97 L. Ed. 2d 427 (1987). The purpose of a trademark is merely to "propos[e] a commercial transaction" by identifying the source of goods or services. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of New York*, 447 U.S. 557, 562, 100 S. Ct. 2343, 65 L. Ed. 2d 341 (1980).

Because "the Constitution accords less protection to commercial speech than to other constitutionally safeguarded forms of expression," *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 64-65, 103 S. Ct. 2875, 77 L. Ed. 2d 469 (1983), the government may regulate the use of trademarks to ensure the orderly flow of commerce. For example, the government may disallow trade names that create "[t]he possibilities for deception," even if the names are not untruthful. *Friedman*, 440 U.S. at 13, 99 S. Ct. 887. The government may similarly implement a trademark registration program, as it did through the Lanham Act, which provides certain speakers exclusive rights to their chosen marks in commerce. Such regulation is permissible under the First Amendment only because the speech being regulated is commercial and because the gov-

ernment has a substantial interest in facilitating commerce by "insuring that the stream of commercial information flows cleanly as well as freely." *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 771-72, 96 S. Ct. 1817, 48 L. Ed. 2d 346 (1976).

The courts have long recognized that some trademarks can include expressive elements concerning matters of public interest, and that such trademarks nevertheless remain commercial speech. Historically, commercial speech received no First Amendment protection, *see Valentine v. Chrestensen*, 316 U.S. 52, 54, 62 S. Ct. 920, 86 L. Ed. 1262 (1942), and the seminal cases bringing commercial speech within the First Amendment's purview did so, at least in part, because commercial speech often communicates on matters of public interest. *Virginia State Bd.*, 425 U.S. at 764-65, 96 S. Ct. 1817. As the Supreme Court recognized in *Virginia State Board*, "not all commercial messages contain the same or even a very great public interest element," but "[t]here are few to which such an element, however, could not be added." *Id.*

The protections of commercial speech are therefore based, at least in part, on the recognition that commercial speech is not always entirely commercial, but that it may contain political messages that make the speech "'commercial' in widely varying degrees." *Bigelow v. Virginia*, 421 U.S. 809, 826, 95 S. Ct. 2222, 44 L. Ed. 2d 600 (1975). For this reason, the Supreme Court has routinely held that various examples of speech "constitute commercial speech notwithstanding the fact that they contain discussions of im-

portant public issues." *Bolger*, 463 U.S. at 67, 103 S. Ct. 2875; *see also Bd. of Trustees of State Univ. of New York v. Fox*, 492 U.S. 469, 109 S. Ct. 3028, 106 L. Ed. 2d 388 (1989). Put simply, commercial speech does not transform into core political speech with full First Amendment protections simply because it "links a product to a current public debate." *Cent. Hudson*, 447 U.S. at 563, 100 S. Ct. 2343.

To determine whether speech is commercial, we consider "the nature of the speech taken as a whole." *Riley v. Nat'l Fed'n of the Blind*, 487 U.S. 781, 796, 108 S. Ct. 2667, 101 L. Ed. 2d 669 (1988). For example, in *Bolger*, the Supreme Court found that certain pamphlets were commercial speech, despite containing "discussions of important public issues," because (1) the speaker conceded that the pamphlets were advertisements, (2) the pamphlets referenced a specific product, and (3) the speaker had an economic motivation for mailing the pamphlets. *Bolger*, 463 U.S. at 66-68, 103 S. Ct. 2875. The Court concluded that "[t]he combination of *all* these characteristics" supported the conclusion that "the informational pamphlets are properly characterized as commercial speech." *Id.*

All three factors from *Bolger* are necessarily also present in trademarks. Trademarks are used to identify specific products and to advertise the sources of those products. Trademarks, and in particular those federally registered for exclusive use in interstate commerce, are necessarily tools of commerce used

with an "economic motive."[1] A trademark is therefore commercial speech, and as such, it lacks full First Amendment protections, regardless of whether it also includes a political element.

The Majority reasons that because the commercial and political elements of trademarks are "inextricably intertwined," the combined whole must be treated as expressive speech. Maj. Op. at 1339 (*citing Riley*, 487 U.S. at 796, 108 S. Ct. 2667). But as explained above, commercial speech is frequently intertwined with political elements, and this intertwining does not necessarily alter the essentially commercial character of the speech. *Riley*, on which the Majority relies, is not to the contrary. *Riley* only reiterates that "in deciding what level of scrutiny to apply" we must consider "the nature of the speech taken as a whole." *Riley*, 487 U.S. at 796, 108 S. Ct. 2667. The nature of trademarks seeking federal registration for use in interstate commerce, when considered as a whole, is indisputably commercial, not political.

Judge Dyk concurs in the result today only because he believes the *content* of Mr. Tam's mark is so "indisputably expressive" that it cannot be regulated under the lesser standards applied to commercial speech. Dyk, J., concurring at 1373-74. But if the expressive *content* of the mark precludes regulation, on what au-

---

[1] The registration of a trademark confers a competitive advantage in the marketplace to the owner of the mark. Typically, in trademark disputes, opposition to the registration or use of a certain mark involves the commercial activities of a competitor. In such cases, the interests of both the owner and competitor are fundamentally commercial in nature.

thority may the government grant Mr. Tam the exclusive right to use this mark in commerce? Whatever standard of scrutiny protects the content of Mr. Tam's trademark from government regulation, that same standard must necessarily be overcome by the government's substantial interest in the orderly flow of commerce, or no trademark could issue.

B. Intermediate Scrutiny Applies Because Section 2(a) is Content-Neutral

The Majority applies strict scrutiny not necessarily because of the expressive content of Mr. Tam's mark, but because of the government's supposed *purpose* of suppressing the political elements of the mark. Maj. Op. at 1337-39. The Majority thus invokes the modern test for content-neutrality, under which the "principal inquiry" is "whether the government has adopted a regulation of speech because of disagreement with the message it conveys." *Ward v. Rock Against Racism*, 491 U.S. 781, 791, 109 S. Ct. 2746, 105 L. Ed. 2d 661 (1989). Under *Ward*, "[t]he government's purpose is the controlling consideration." *Id.* The Supreme Court has endorsed the applicability of this test to commercial speech. *Sorrell v. IMS Health Inc.*, — U.S. —, 131 S. Ct. 2653, 2664, 180 L. Ed. 2d 544 (2011).

If this appeal turns on a content-neutrality analysis, we should be clear that the government has never stated that the purpose of § 2(a) is to suppress speech. Only the Majority has advanced this rationale, and it has done so only by default after eliminating all other interests of which it could conceive. I do not think we need to search so hard and so far. The purpose of

§ 2(a) is the same as the purpose of the Lanham Act as a whole—to promote the orderly flow of commerce.

The Lanham Act declares unequivocally that "[t]he intent of this chapter is to regulate commerce." 15 U.S.C.A. § 1127. In analyzing content-neutrality, an apparently content-based law is nevertheless considered content-neutral if the government's purpose is *not* to suppress speech, but to address the harmful secondary effects of that speech. *See City of Renton v. Playtime Theatres, Inc.*, 475 U.S. 41, 106 S. Ct. 925, 89 L. Ed. 2d 29 (1986); *Young v. Am. Mini Theatres*, 427 U.S. 50, 96 S. Ct. 2440, 49 L. Ed. 2d 310 (1976). The Supreme Court has repeatedly applied this "Secondary Effects" doctrine to uphold not only time, place, and manner restrictions on particular types of speech, *id.* (upholding regulations on the locations of adult businesses), but also regulations on the content of expression itself, *see, e.g.*, *City of Erie v. Pap's A.M.*, 529 U.S. 277, 120 S. Ct. 1382, 146 L. Ed. 2d 265 (2000) (upholding ban on fully nude dancing); *Barnes v. Glen Theatre*, 501 U.S. 560, 111 S. Ct. 2456, 115 L. Ed. 2d 504 (1991) (same). For example, applying *Ward*, the Supreme Court upheld a city's ban on fully nude dancing because the ban was only a minimal burden on speech and was narrowly tailored to advance the "substantial government interest in protecting order and morality." *Barnes*, 501 U.S. at 569, 111 S. Ct. 2456. In *City of Erie*, the Court upheld a nearly identical statute as content-neutral because it did "not attempt to regulate the primary effects of the expression" but rather, "the secondary effects, such as impacts on public health, safety, and welfare." *City of Erie*, 529 U.S. at 291, 120 S. Ct. 1382.

The Supreme Court has also permitted regulation of speech based on the speech's effect on commerce. For instance, it was under *Ward* that the Supreme Court upheld the FCC's must-carry provisions as content-neutral, despite the provisions' mandate that cable providers transmit particular types of content. *Turner Broad. Sys., Inc. v. F.C.C.*, 512 U.S. 622, 647, 114 S. Ct. 2445, 129 L. Ed. 2d 497 (1994). The Court upheld the must-carry regulations because they furthered the substantial government interest in "protecting non-cable households from loss of regular television broadcasting service." *Id.* The Court has also upheld regulations on highly-protected private speech where the government sought to eliminate the secondary effects of that speech on the market for illegal goods. *See Osborne v. Ohio*, 495 U.S. 103, 110 S. Ct. 1691, 109 L. Ed. 2d 98 (1990). Thus, when a regulation's purpose is to address the secondary effects of certain speech, intermediate scrutiny is appropriate, even if the regulation implicates content.

Section 2(a) serves the same substantial government interest as the Lanham Act as a whole—the orderly flow of commerce. Commercial speech that insults groups of people, particularly based on their race, gender, religion, or other demographic identity, tends to disrupt commercial activity and to undermine the stability of the marketplace in much the same manner as discriminatory conduct. The government's refusal to promote such speech in commerce is not an effort to suppress free expression, but to mitigate the disruptive secondary effects that a particular type of low-value speech may have when used in a commercial context. Because the government's purpose is to

mitigate these secondary effects on commerce rather than to suppress speech, the regulation is content-neutral and intermediate scrutiny applies.

C. Section 2(a) Advances the Substantial Government Interest in the Orderly Flow of Commerce

The government's interest in the orderly flow of commerce is substantial. If it were not, the government would be powerless to implement a trademark registry because doing so necessarily requires a ban on infringing commercial speech. The government has a substantial interest in regulating "deceptive or misleading" commercial speech, even if that speech is not wholly false, because of the government's substantial interest in "insuring that the stream of commercial information flow cleanly as well as freely." *Virginia State Bd. of Pharmacy*, 425 U.S. at 771, 96 S. Ct. 1817. The Supreme Court has never held, however, that deceptive and misleading speech is the *only* type of commercial speech subject to regulation for its disruptive effect. *See Cent. Hudson*, 447 U.S. at 566, 100 S. Ct. 2343 ("For commercial speech to come within that provision, it *at least* must concern lawful activity and not be misleading.") (emphasis added). Instead, any speech that substantially undermines the orderly flow of commerce may potentially be subject to at least some regulation.

The marketplace of ideas differs dramatically from the marketplace of goods and services. While the marketplace of ideas may tolerate or even benefit from the volatility that accompanies disparaging and insulting speech, the marketplace of goods and services

is a wholly different animal. Commerce does not benefit from political volatility, nor from insults, discrimination, or bigotry. Commerce is a communal institution regulated for the mutual economic benefit of all. Commercial speech that discredits or brings reproach upon groups of Americans, particularly based on their race, has a discriminatory impact that undermines commercial activity and the stability of the marketplace in much the same manner as discriminatory conduct.

That discriminatory *conduct* disrupts commerce is long established. In upholding Title II of the Civil Rights Act, for example, the Supreme Court noted a record "replete with testimony of the burdens placed on interstate commerce by racial discrimination." *Katzenbach v. McClung*, 379 U.S. 294, 299, 85 S. Ct. 377, 13 L. Ed. 2d 290 (1964). The Court cited an "impressive array of testimony that discrimination in restaurants had a direct and highly restrictive effect upon interstate travel," and that such discrimination therefore "obstructs interstate commerce." *Id.* at 300, 85 S. Ct. 377. It cited "many references" to discrimination causing "a depressant effect on general business conditions in the respective communities" and it noted evidence that discrimination "deterred professional, as well as skilled, people from moving into areas where such practices occurred and thereby caused industry to be reluctant to establish there." *Id.* The Court thus found "ample basis for the conclusion that established restaurants in such areas sold less interstate goods because of the discrimination, that interstate travel was obstructed directly by it, that business in

general suffered and that many new businesses refrained from establishing there as a result of it." *Id.*

Although these findings were specific to public accommodations, they are applicable to commerce generally. Commercial goods and services pervade all economic channels, including all public accommodations, such as stores, restaurants, hotels, theaters, and the like. Discriminatory messages within such commercial channels threaten the same disruptive effects as the discrimination itself. Although the Majority distinguishes between conduct and speech, Maj. Op. at 1356-57, the distinction is without a difference in this context. Whether a restaurant named "SPICS NOT WELCOME" would actually serve a Hispanic patron is hardly the point. The mere use of the demeaning mark in commerce communicates a discriminatory intent as harmful as the fruit produced by the discriminatory conduct.

Because even speech without accompanying conduct can have a discriminatory impact, other parts of the Civil Rights Act expressly regulate pure speech in commerce. For instance, Title VIII specifically bans advertising that indicates a discriminatory preference, even where discriminatory conduct is legal. *See* 42 U.S.C. § 3604(c); *see also* § 3603(b) (listing exemptions). Title VII places similar restrictions on job advertisements. *See* 42 U.S.C. § 2000e-3(b). Title VII also bans pure speech in the workplace when the speech is harassing, even when unaccompanied by any adverse employment action, because such speech creates a discriminatory impact. *See Harris v. Forklift Sys., Inc.*, 510 U.S. 17, 114 S. Ct. 367, 126 L. Ed. 2d 295

(1993); *see also Burlington Indus., Inc. v. Ellerth*, 524 U.S. 742, 118 S. Ct. 2257, 141 L. Ed. 2d 633 (1998).

Nearly every disparaging mark identified in the voluminous briefing and opinions in this case has involved disparagement of race, gender, ethnicity, national origin, religion, sexual orientation, and similar demographic classification. The impact of advancing these bigoted messages through the ubiquitous channels of commerce may be discriminatory, and even if not discriminatory, at least *disruptive* to commerce. The only question is whether the government's interest in avoiding this commercial disruption outweighs the modest "burden" that its refusal to register the offending marks places on the freedom of speech. I believe it does.

D. Section 2(a) Survives Intermediate Scrutiny

To be clear, I do not believe that the government may ban any speech it finds commercially undesirable, but only that when we are presented with a regulation, we must engage meaningfully in "the task of assessing the First Amendment interest at stake and weighing it against the public interest allegedly served by the regulation." *Bigelow*, 421 U.S. at 826, 95 S. Ct. 2222. Here, the government's substantial interest in the orderly flow of commerce is counterbalanced only by a minimal "burden" on a small subset of low-value commercial speech. Section 2(a) should survive intermediate scrutiny because it is only an "incidental restriction on First Amendment freedom [that] is no greater than is essential to the furtherance of the governmental interest" in the orderly flow of commerce. *See Barnes*, 501 U.S. at 561, 111 S. Ct. 2456.

Section 2(a) imposes only a modest "burden" on speech. First, the statute applies only in the commercial context, meaning that it does nothing to impact private speech. Mr. Tam remains free to spread his chosen message to all who would listen without fear of government intervention or reprisal. Second, § 2(a) does not strictly "burden" Mr. Tam's speech, but only denies him a government-created benefit—the exclusive right to use that speech in commerce in connection with the sale of particular goods or services. At bottom, the only burden the application of § 2(a) imposes in this case is that Mr. Tam is free to communicate his chosen message within or without commerce, so long as he is willing to permit others to do the same.

Section 2(a) also implicates only a modest sliver of particularly low-value speech. Speech that disparages is a narrow subset of speech that offends, and it is a particularly low-value subset at that. *See Am. Freedom Def. Initiative v. Mass. Bay Transp. Auth.*, 989 F. Supp. 2d 182, 192 (D. Mass. 2013), *aff'd*, 781 F.3d 571 (1st Cir. 2015) (distinguishing speech that "crosses the line from being offensive or hurtful to being demeaning or disparaging"). To borrow a phrase from Justice Stevens, few of us would march our sons and daughters off to war to preserve the citizen's right to be the exclusive purveyor of "OLD COON SMOKING TOBACCO." *See Young*, 427 U.S. at 70, 96 S. Ct. 2440; *McCann v. Anthony*, 21 Mo. App. 83, 91-92 (1886).

The Supreme Court has routinely considered the relative value of burdened speech in its First Amendment analysis. *See, e.g., Bethel Sch. Dist. No. 403 v.*

Fraser, 478 U.S. 675, 683, 106 S. Ct. 3159, 92 L. Ed. 2d 549 (1986); *Young*, 427 U.S. at 70-71, 96 S. Ct. 2440; *Tinker v. Des Moines Indep. Cmty. Sch. Dist.*, 393 U.S. 503, 510-11, 89 S. Ct. 733, 21 L. Ed. 2d 731 (1969). For instance, the Court has held that a student's interest in high-value political speech outweighed his school's interest in avoiding a "substantial disruption," *Tinker*, 393 U.S. at 510-11, 89 S. Ct. 733, but that a student's interest in low-value "insulting" speech did not, *Fraser*, 478 U.S. at 683, 106 S. Ct. 3159. When low-value materials are concerned, "the State may legitimately use the content of these materials as the basis for placing them in a different classification" of First Amendment protection. *Young*, 427 U.S. at 71, 96 S. Ct. 2440.

At the extremes, disparaging speech enjoys no First Amendment protection. *Chaplinsky v. New Hampshire*, 315 U.S. 568, 62 S. Ct. 766, 86 L. Ed. 1031 (1942). "Insulting" words, which "by their very utterance inflict injury" are part of the "limited classes of speech, the prevention and punishment of which have never been thought to raise any Constitutional problem." *Id.* at 571-72, 62 S. Ct. 766. To whatever extent "disparaging" speech differs from "insulting" speech, its value is not much greater.

Additionally, any minimal value disparaging speech might offer in the marketplace of ideas is far diminished in the marketplace of goods and services, which is the only context at issue in this appeal. One can hardly imagine what legitimate interest a vendor of goods or services may have in insulting potential customers. Whatever value disparaging speech might

possess when used in private life, it loses when used in commerce.

When we balance the government's substantial interest in the orderly flow of commerce against the modest imposition of § 2(a) on a narrowly tailored portion of particularly low-value speech, the standards of intermediate scrutiny are satisfied. Whatever modest imposition the statute makes on the free flow of public discourse, it is nothing more than an "incidental restriction on First Amendment freedom [that] is no greater than is essential to the furtherance of the governmental interest" in the orderly flow of commerce. *See Barnes*, 501 U.S. at 561, 111 S. Ct. 2456. For the foregoing reasons, I believe that § 2(a) is constitutional. I respectfully dissent.

APPENDIX B

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

No. 2014-1203

IN RE SIMON SHIAO TAM, APPELLANT

Apr. 20, 2015

OPINION

Before: LOURIE, MOORE, and O'MALLEY, Circuit Judges

MOORE, Circuit Judge.

Simon Shiao Tam appeals from the decision of the Trademark Trial and Appeal Board (the Board) affirming the examining attorney's refusal to register the mark THE SLANTS because it is disparaging. We *affirm*.

BACKGROUND

Mr. Tam is the "front man" for Asian-American dance rock band The Slants. In 2010, Mr. Tam filed Application No. 77/952,263 ('263 application) seeking to register the mark THE SLANTS for "Entertainment, namely, live performances by a musical band." Mr. Tam attached specimens featuring the band name set against Asian motifs to the '263 application. The

examining attorney found the mark disparaging to people of Asian descent under 15 U.S.C. § 1052(a) ("§ 2(a)") and therefore refused to register it. Mr. Tam appealed that refusal to the Board, but the case was dismissed for failure to file a brief and the application was deemed abandoned. On November 14, 2011, six days after the abandonment of the '263 application, Mr. Tam filed a second application (Application No. 85/472,044, or the '044 application) seeking to register the mark THE SLANTS for essentially identical services as in the '263 application. In the '044 application, Mr. Tam claims use of the mark since 2006. Unlike the specimens attached to the '263 application, the specimens attached to the '044 application do not contain Asian motifs. The examining attorney again found the mark THE SLANTS disparaging and declined to register it. In making this determination, the examining attorney cited to materials that he had gathered in response to Mr. Tam's earlier application. Mr. Tam responded and a final office action issued.

The Board affirmed the examining attorney's refusal to register the mark. The Board found that "it is abundantly clear from the record not only that THE SLANTS . . . would have the 'likely meaning' of people of Asian descent but also that such meaning has been so perceived and has prompted significant responses by prospective attendees or hosts of the band's performances." *In re Tam*, No. 85472044, 2013 WL 5498164, at *5 (TTAB Sept. 26, 2013). To support this conclusion, the Board pointed to the band's website, which displayed the mark next to "a depiction of an Asian woman, utilizing rising sun im-

agery and using a stylized dragon image," and to a statement by Mr. Tam that he selected the mark in order to "own" the stereotype it represents. *Tam*, 2013 WL 5498164, at *5. The Board also found that the mark is disparaging to a substantial component of people of Asian descent because "[t]he dictionary definitions, reference works, and all other evidence unanimously categorize the word 'slant,' when meaning a person of Asian descent, as disparaging," and because there was record evidence of individuals and groups in the Asian community objecting to Mr. Tam's use of the word "slant." *Tam*, 2013 WL 5498164, at *7. The Board therefore disqualified the mark for registration under § 2(a). Mr. Tam appeals. We have jurisdiction under 28 U.S.C. § 1295(a)(4).

DISCUSSION

Mr. Tam argues that the Board erred in finding the mark THE SLANTS disparaging under § 2(a) of the Lanham Act and therefore unregistrable. Mr. Tam also challenges the constitutionality of § 2(a).

I. Disparagement Analysis

Section 2(a) of the Lanham Act provides that the Patent and Trademark Office (PTO) may refuse to register a trademark that "[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." 15 U.S.C. § 1052(a). A disparaging mark "'dishonors by comparison with what is inferior, slights, deprecates, degrades, or affects or injures by unjust comparison.'" *In re Geller*, 751 F.3d 1355,

1358 (Fed. Cir. 2014) (quoting *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 124 (D.D.C. 2003)) (alterations omitted). In *Geller*, we applied a two-part test to determine if a mark may be disparaging:

> (1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
>
> (2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

Id. This determination is "a conclusion of law based upon underlying factual inquiries." *Id.* We review the Board's factual findings for substantial evidence, and its ultimate conclusion de novo. *Id.*

A. Use of Prior Applications

As a threshold matter, Mr. Tam argues that the examining attorney and the Board should not have considered evidence gathered by the examining attorney while evaluating the earlier '263 application. We disagree. The examining attorney may look to evidence outside the application, such as dictionary definitions and newspaper articles, when determining the "manner of use" of the mark. *See In re Bayer Aktiengesellschaft*, 488 F.3d 960, 966-69 (Fed. Cir. 2007). Mr. Tam claims use of the mark THE SLANTS back to 2006, before he filed the '263 application. Evidence

gathered in response to the '263 application is relevant to determining the mark's manner of use for the time period during which Mr. Tam asserts the mark was in use. While the evidence gathered during the evaluation of the '263 application derives from an abandoned application dated before the '044 application's filing date, its use was not improper.

B. Likely Meaning

To determine if a mark is disparaging, we first consider "the likely meaning of the matter in question." *Geller*, 751 F.3d at 1358. The Board found that the mark THE SLANTS refers to people of Asian descent. Substantial evidence supports this finding. Mr. Tam argues that the mark does not refer to people of Asian descent. His argument seems to rely on 1) the fact that the term "slant" has a number of alternative, more common meanings; 2) that none of the specimens attached to the '044 application include Asian imagery or otherwise reference people of Asian descent; and 3) that the PTO has granted a number of unrelated trademark applications containing the term "slant." We are not persuaded by Mr. Tam's argument.

There is no dispute that the term "slants" has a number of meanings, one of which refers to people of Asian descent. The Board cited a number of traditional and slang dictionaries defining the word with reference to people of Asian descent, ranging from *Oxford Reference Online* to www.urbandictionary.com. *Tam*, 2013 WL 5498164, at *1-2 & n.3. Even the dictionary entries supplied by Mr. Tam include as possible definitions for the term "slant" "a disparaging term

for a person of East Asian birth or ancestry," J.A. 219 (*The American Heritage Dictionary of the English Language*), and "[a] person with slanting eyes, spec. one of Oriental descent," J.A. 234-36 (*Oxford English Dictionary*).

The fact that the term "slants" has some innocuous meanings—and that some trademarks have issued with those innocuous meanings—does not foreclose the possibility that the term may also be used in an offensive manner, even when the non-disparaging meanings are more common. *See Tam*, 2013 WL 5498164, at *5. Rather, the existence of these other meanings makes it necessary to examine how the applicant uses the mark in the marketplace to determine its likely meaning—as the Board did.

The evidence here supports the Board's finding that the mark THE SLANTS likely refers to people of Asian descent. For example, an article in the record includes a quote attributed to Mr. Tam where he describes the genesis of the band's name by explaining: "I was trying to think of things that people associate with Asians. Obviously, one of the first things people say is that we have slanted eyes. . . . " J.A. 130. The record also contains the band's entry in Wikipedia, which states that the band's name is "derived from an ethnic slur for Asians." J.A. 57. The Wikipedia entry quotes Mr. Tam: "We want to take on these stereotypes that people have about us, like the slanted eyes, and own them. We're very proud of being Asian—we're not going to hide that fact. The reaction from the Asian community has been positive." *Id.* Furthermore, the record includes an image from

the band's website in which the mark THE SLANTS is set against "a depiction of an Asian woman, utilizing rising sun imagery and using a stylized dragon image," as described by the Board. *Tam*, 2013 WL 5498164, at *2, *5 (citing J.A. 59). Finally, the record includes evidence that both individuals and Asian groups have perceived the term as referring to people of Asian descent. *Tam*, 2013 WL 5498164, at *2-3 (citing, e.g., J.A. 95 ("[Mr. Tam] was initially slated to give the keynote address at the 2009 Asian American Youth Leadership Conference in Portland. But some conference supporters and attendees felt the name of the band was offensive and racist, and out of respect for these opinions the conference organizers decided to choose someone less controversial.")). On this record, we find that substantial evidence supports the Board's determination that the mark THE SLANTS likely refers to people of Asian descent.

Mr. Tam also argues that we should not consider this evidence because it is unauthenticated hearsay and does not satisfy the requirements of 37 C.F.R. § 2.122(a), which applies the Federal Rules of Evidence to inter partes proceedings. However, § 2.122(a) does not apply to ex parte proceedings. For ex parte proceedings, the Board has adopted a "somewhat more permissive stance with respect to the admissibility and probative value of evidence." TRADEMARK TRIAL & APPEAL BOARD MANUAL OF PROCEDURE § 1208. In ex parte proceedings, the Board permits the examining attorney to consider Internet material. *Id.* § 1208.03. We see no error in the Board's procedures.

C. Whether the Meaning May Be Disparaging to a Substantial Composite of the Referenced Group

If the likely meaning of the mark "is found to refer to identifiable persons, institutions, beliefs or national symbols," we next consider "whether that meaning may be disparaging to a substantial composite of the referenced group." *Geller*, 751 F.3d at 1360. Substantial evidence supports the Board's finding that the mark THE SLANTS is likely offensive to a substantial composite of people of Asian descent.

First, the definitions in evidence universally characterize the word "slant" as disparaging, offensive, or an ethnic slur when used to refer to a person of Asian descent. *Tam*, 2013 WL 5498164, at *1-2, *7 & n.3. This includes the dictionaries provided by Mr. Tam in his response to office action. J.A. 219, 234-36. Additionally, the record includes a brochure published by the Japanese American Citizens League describing the term "slant," when used to refer to people of Asian descent, as a "derogatory term" that is "demeaning" and "cripple[s] the spirit." J.A. 48-49. The record also includes news articles and blog posts discussing the offensive nature of the band's name, which led to the cancellation of the band's scheduled performance at a conference for Asian youth. *Tam*, 2013 WL 5498164, at *2-3 (citing J.A. 45, 51, 94-98, 100). We find there is substantial evidence—even without a marketing survey or some other quantitative measure of the term's offensiveness—supporting the Board's finding that the mark is disparaging to a substantial composite of people of Asian descent. The Board

does not have the resources, nor is it required, to conduct a marketing survey each time it evaluates whether a term is disparaging. *See In re Loew's Theatres, Inc.*, 769 F.2d 764, 768 (Fed. Cir. 1985).

II. Constitutionality of § 2(a)

Having affirmed the Board's holding that the mark is disparaging, we next turn to Mr. Tam's constitutional challenges.

A. First Amendment

Mr. Tam argues that the Lanham Act's restrictions on disparaging trademarks are unconstitutional under the First Amendment both facially and as applied to his case because § 2(a) conditions a benefit—trademark registration—on the relinquishment of speech. This argument is foreclosed by our precedent. In *In re McGinley*, our predecessor court wrote:

> With respect to appellant's First Amendment rights, it is clear that the PTO's refusal to register appellant's mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark.

660 F.2d 481, 484 (C.C.P.A. 1981). In subsequent cases, we have accepted this reasoning. *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) ("[T]he refusal to register a mark does not proscribe any conduct or suppress any form of expression because it does not affect the applicant's right to use the mark in question."); *In re Mavety Media Grp.*, 33 F.3d

1367, 1374 (Fed. Cir. 1994); *see also In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012) ("Because a refusal to register a mark has no bearing on the applicant's ability to use the mark, we have held that § 1052(a) does not implicate the First Amendment rights of trademark applicants."). We here follow our precedent.

B. Vagueness

Mr. Tam also argues that the disparagement standard of § 2(a) is unconstitutionally vague. He claims that key terms of § 2(a), such as "scandalous" and "disparage," are not "clearly defined" and are necessarily subjective. He argues that § 2(a) therefore does not give "the person of ordinary intelligence a reasonable opportunity to know what is prohibited." *Grayned v. City of Rockford*, 408 U.S. 104, 108, 92 S. Ct. 2294, 33 L. Ed. 2d 222 (1972).

We have noted with respect to § 2(a)'s bar on scandalous subject matter the "inherent difficulty in fashioning a single objective measure like a substantial composite of the general public from the myriad of subjective viewpoints." *Mavety*, 33 F.3d at 1371. Nonetheless, we found the standard "sufficiently precise to enable the PTO and the courts to apply the law fairly and to notify a would-be registrant that the mark he adopts will not be granted a federal registration." *McGinley*, 660 F.2d at 485. The same is true for the bar on disparaging marks. The Board follows a well-established two-part test to determine if a mark is disparaging. *See Geller*, 751 F.3d at 1358. This standard is not unconstitutionally vague.

C. Due Process

Mr. Tam argues that the PTO applies the disparagement provisions arbitrarily and without clear guidelines. He points to registered trademarks containing slurs against homosexuals such as DYKES ON BIKES, U.S. Registration No. 3323803, as evidence of the arbitrary nature of trademark adjudication.

We have rejected similar due process challenges to § 2(a). In both *Boulevard Entertainment*, 334 F.3d at 1343, and *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174 (Fed. Cir. 2009), the applicant argued that by refusing to register his mark while granting similar marks, the PTO had violated the Due Process clause. In these cases, we found no due process violation because the applicant "was provided a full opportunity to prosecute his applications and to appeal the examining attorney's final rejections to the Board." 571 F.3d at 1174. The same is true here. We also noted that "allegations regarding similar marks are irrelevant because each application must be considered on its own merits." *Id.* (citing *Boulevard Entm't*, 334 F.3d at 1343). Furthermore, "[e]ven if all of the third-party registrations should have been refused registration under [§ 2(a)], such errors do not bind the USPTO to improperly register [the a]pplicant's marks." *Id.* (citing *Boulevard Entm't*, 334 F.3d at 1343). This reasoning compels us to reject Mr. Tam's due process argument.

D. Equal Protection

Lastly, Mr. Tam argues that because the examining attorney's disparagement analysis hinged on his and

his bandmates' ethnic identities, the rejection of the mark violated the equal protection clause. To support this argument, Mr. Tam points to the Final Office Action, which states:

> Here, the evidence is uncontested that applicant is a founding member of a band (The Slants) that is self described as being composed of members of Asian descent. . . . Thus, the association of the term SLANTS with those of Asian descent is evidenced by how the applicant uses the Mark—as the name of an all Asian-American band.

J.A. 244. Mr. Tam argues the examining attorney's race-based determination is neither justified by a compelling government interest nor narrowly tailored towards achieving that goal.

We reject Mr. Tam's equal protection argument. The record shows that the Board denied Mr. Tam the registration because he used the mark THE SLANTS in a disparaging manner, not on account of his race. The Board wrote that "[a]n application by a band comprised of non-Asian-Americans called THE SLANTS that displayed the mark next to the imagery used by applicant . . . would also be subject to a refusal under Section 2(a)." *Tam*, 2013 WL 5498164, at *6. Furthermore, we have held that a trademark refusal does not violate equal protection so long as there are nondiscriminatory reasons for denying registration. *Shinnecock Smoke Shop*, 571 F.3d at 1175. Here there are nondiscriminatory reasons for denying Mr. Tam's application.

CONCLUSION

We *affirm* the Board's decision affirming the examining attorney's refusal to register the mark THE SLANTS because it is disparaging.

AFFIRMED.

MOORE, Circuit Judge, additional views.

It is time for this Court to revisit *McGinley*'s holding on the constitutionality of § 2(a) of the Lanham Act. Under § 2(a), the PTO may refuse to register immoral, scandalous, or disparaging marks. 15 U.S.C. § 1052(a). In *In re McGinley*, our predecessor court held without citation to any legal authority in just a few sentences that § 2(a) does not implicate the First Amendment:

> With respect to appellant's First Amendment rights, it is clear that the PTO's refusal to register appellant's mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark.

660 F.2d 481, 484 (C.C.P.A. 1981). More than thirty years have passed since *McGinley*, and in that time both the *McGinley* decision and our reliance on it have been widely criticized.[1] Furthermore, First Amend-

---

[1] *See, e.g.*, *Ritchie v. Simpson*, 170 F.3d 1092, 1103 & n.1 (Fed. Cir. 1999) (Newman, J., dissenting); *Pro-Football Inc. v. Harjo*, No. 99-1385(CKK), 2000 WL 1923326, at *4 (D.D.C. Dec. 11, 2000); Stephen Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trade-*

ment jurisprudence on the "unconstitutional conditions" doctrine and the protection accorded to commercial speech has evolved significantly since the *McGinley* decision. In 1991, the source of the PTO's funding shifted from the taxpayers to application fees. The constitutionality of § 2(a) is an important and timely issue that raises a number of constitutional questions. The time has come to give this issue the consideration it is due.

---

marks, 83 TRADEMARK REPORTER 661, 685-86 (1993); Justin G. Blankenship, *The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words That Offend?*, 72 U. COLO. L. REV. 415, 443-44 (2001); Terence Dougherty, *Group Rights to Cultural Survival: Intellectual Property Rights in Native American Cultural Symbols*, 29 COLUM. HUM. RTS. L. REV. 355, 383 (1998); Bruce C. Kelber, *"Scalping the Redskins:" Can Trademark Law Start Athletic Teams Bearing Native American Nicknames and Images on the Road to Racial Reform?*, 17 HAMLINE L. REV. 533, 556 (1994); Paul Kuruk, *Goading a Reluctant Dinosaur: Mutual Recognition Agreements as a Policy Response to the Misappropriation of Foreign Traditional Knowledge in the United States*, 34 PEPP. L. REV. 629, 662 n.209 (2007); Michelle B. Lee, *Section 2(a) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?*, 4 SPORTS LAW J. 65, 66-67 (1997); Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of Redskins?*, 52 STAN. L. REV. 665, 676-77 (2000); Nell Jessup Newton, *Memory and Misrepresentation: Representing Crazy Horse*, 27 CONN. L. REV. 1003, 1030 n.109 (1995); Ron Phillips, *A Case for Scandal and Immorality: Proposing Thin Protection of Controversial Trademarks*, 17 U. BALT. INTELL. PROP. L.J. 55, 67-68 (2008); Jendi Reiter, *Redskins and Scarlet Letters: Why "Immoral" and "Scandalous" Trademarks Should Be Federally Registrable*, 6 FED. CIR. BAR. J. 191, 197 (1996); Lilit Voskanyan, *The Trademark Principal Register as a Nonpublic Forum*, 75 U. CHI. L. REV. 1295, 1302 (2008).

There are three requirements for finding a violation of the First Amendment. The speech at issue must be protected speech. *See, e.g., Roth v. United States*, 354 U.S. 476, 77 S. Ct. 1304, 1 L. Ed. 2d 1498 (1957) (obscenity is not protected by the First Amendment); *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 94 S. Ct. 2997, 41 L. Ed. 2d 789 (1974) (defamation under certain circumstances is not protected by the First Amendment); *Chaplinsky v. New Hampshire*, 315 U.S. 568, 62 S. Ct. 766, 86 L. Ed. 1031 (1942) ("fighting words" are not protected by the First Amendment); *see also R.A.V. v. City of St. Paul*, 505 U.S. 377, 382-83, 112 S. Ct. 2538, 120 L. Ed. 2d 305 (1992) ("'[T]he freedom of speech' referred to by the First Amendment does not include a freedom to disregard these traditional limitations."); *United States v. Alvarez*, — U.S. —, 132 S. Ct. 2537, 2543-44, 183 L. Ed. 2d 574 (2012) (plurality opinion). There must be government action that abridges that speech in a manner that implicates the First Amendment, as, for example, when the government bans flag-burning, *Texas v. Johnson*, 491 U.S. 397, 405, 109 S. Ct. 2533, 105 L. Ed. 2d 342 (1989), or imposes taxes on certain publications, *Ark. Writers' Project, Inc. v. Ragland*, 481 U.S. 221, 229-30, 107 S. Ct. 1722, 95 L. Ed. 2d 209 (1987). And the abridgement must be unconstitutional when analyzed under the appropriate framework—for example, the *Central Hudson* four-part test for determining the constitutionality of restrictions on commercial speech. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 566, 100 S. Ct. 2343, 65 L. Ed. 2d 341 (1980).

I. Are Trade Names Protected Speech?

For many years, commercial speech lay outside the ambit of the First Amendment. In 1975, the Supreme Court ruled that the First Amendment protects commercial speech, *Bigelow v. Virginia*, 421 U.S. 809, 818, 95 S. Ct. 2222, 44 L. Ed. 2d 600 (1975), and five years later the Supreme Court laid out the four-part test for determining the constitutionality of restrictions on commercial speech, *Central Hudson*, 447 U.S. at 566, 100 S. Ct. 2343.

Today, however, it is unquestionably true that trademarks are protected speech under Supreme Court commercial speech jurisprudence. Commercial speech is the "dissemination of information as to who is producing and selling what product, for what reason, and at what price." *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 765, 96 S. Ct. 1817, 48 L. Ed. 2d 346 (1976). Protecting the flow of this type of information is "indispensable." *Id.* Four years after *Bigelow*, the Supreme Court held that the trade name of an optometrist is commercial speech. *Friedman v. Rogers*, 440 U.S. 1, 11, 99 S. Ct. 887, 59 L. Ed. 2d 100 (1979) ("The use of trade names in connection with optometrical practice, then, is a form of commercial speech and nothing more."). Trade names identify the source of a product or service for users, and thus provide some of the information labeled indispensable by the Supreme Court in *Virginia State Board*. Indeed, the government has conceded that "[t]rademarks are a form of commercial speech." Appellee's Br. 34 n.5. Because a trade-

mark identifies the source of a product or service for users, it is protected commercial speech.

While it may be true that many marks are used solely as a source identifier, that is not the case here. Mr. Tam's mark THE SLANTS does more than merely identify the band in the commercial arena. In *Friedman*, the Court reasoned that the optician seeking the trade name "does not wish to editorialize on any subject, cultural, philosophical, or political. He does not wish to report any particularly newsworthy fact, or to make generalized observations even about commercial matters." 440 U.S. at 11, 99 S. Ct. 887. Here, by contrast, Mr. Tam seeks to trademark the name of a musical group, selecting the name "The Slants" to "reclaim" and "take ownership" of Asian stereotypes. J.A. 129-30. The band draws inspiration for its lyrics from childhood slurs and mocking nursery rhymes, J.A. 130, and its albums include "The Yellow Album" and "Slanted Eyes, Slanted Hearts." The band "feel[s] strongly that Asians should be proud of their cultural heritage, and not be offended by stereotypical descriptions." J.A. 52. With their lyrics, performances, and band name, Mr. Tam and The Slants weigh in on cultural and political discussions about race and society that are within the heartland of speech protected by the First Amendment.

II. Is § 2(a) an Abridgement of Speech?

A. Benefits of Trademark Registration

The *McGinley* court held that the refusal to register a mark under § 2(a) does not bar the applicant from using the mark, and therefore does not implicate the

First Amendment. It is true that § 2(a) does not bar the applicant from using the mark. Here, for example, Mr. Tam's band can continue to perform and advertise using the name "The Slants." However, as the *McGinley* court wrote, § 2(a) denies the applicant access to "benefits provided by the Lanham Act which enhance the value of a mark." 660 F.2d at 486 n.12. "Registration is significant. The Lanham Act confers important legal rights and benefits on trademark owners who register their marks." *B & B Hardware, Inc. v. Hargis Ind., Inc.*, — U.S. —, 135 S. Ct. 1293, 1300, 191 L. Ed. 2d 222 (2015).

These benefits—unavailable in the absence of federal registration—are numerous, and include both substantive and procedural rights. First, the holder of a federal trademark has a right to exclusive nationwide use of that mark where there was no prior use by a party other than the markholder. *See* 15 U.S.C. §§ 1072, 1115. Because under the common law, a markholder only has the right to exclusive use where he has used his mark before, *see* 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 26:32 (4th ed.), holders of a federal trademark have an important substantive right they could not otherwise obtain. Also, a registered mark is presumed to be valid, 15 U.S.C. § 1057(b), and the mark becomes incontestable (with certain exceptions) after five years of consecutive post-registration use, *id.* § 1065; *see also B & B Hardware*, 135 S. Ct. at 1310 ("Incontestability is a powerful protection"). A markholder may sue in federal courts to enforce his trademark, 15 U.S.C. § 1121, and he may recover treble damages if he can show infringement was willful,

id. § 1117. He may also obtain the assistance of U.S. Customs and Border Protection in restricting importation of infringing or counterfeit goods, *id.* § 1124; 19 U.S.C. § 1526, or prevent "cybersquatters" from misappropriating his domain name, 15 U.S.C. § 1125(d). In effect, § 2(a) of the Lanham Act conditions trademark registration and all of its attendant benefits on the applicant's selection of a suitable mark. Section 2(a)'s registerability conditions are not tethered to the trade-mark's functioning as a source identifier or to any concern over the mark creating confusion or being misleading. Instead, § 2(a) allows the PTO to determine whether the trademark is suitable for registration, in this case whether it is disparaging, which is a moral judgment based solely and indisputably on the mark's expressive content.

Not only is a disparaging trademark denied federal registration, but it cannot be protected by its owner by virtue of a § 43(a) unfair competition claim. *Id.* § 1125(a). Section 43(a) allows for a federal suit, much like state common law, to protect an unregistered trademark. As many courts have noted, it is the use of a trademark in commerce, not its registration, which gives rise to a protectable right. *Miller v. Glenn Miller Prods., Inc.*, 454 F.3d 975, 979 (9th Cir. 2006) ("Registration does not create a mark or confer ownership; only use in the marketplace can establish a mark."); *In re Int'l Flavors & Fragrances, Inc.*, 183 F.3d 1361, 1366 (Fed. Cir. 1999) ("The federal registration of a trademark does not create an exclusive property right in the mark. The owner of the mark already has the property right established by prior use. . . . However, those trademark owners who

register their marks with the PTO are afforded additional protection not provided by the common law."). Equally clear, however, is that § 43(a) protection is only available for unregistered trademarks that could have qualified for federal registration. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 112 S. Ct. 2753, 120 L. Ed. 2d 615 (1992) (section 43(a) "protects qualifying unregistered trademarks and . . . the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)"); *Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1215 (10th Cir. 2004) (plaintiff must establish that its mark is protectable to prevail in a claim under § 43(a)); *Yarmuth-Dion, Inc. v. D'ion Furs, Inc.*, 835 F.2d 990, 992 (2d Cir. 1987) (requiring a plaintiff to "demonstrate that his [unregistered] mark merits protection under the Lanham Act"). Thus, no federal cause of action is available to protect a trademark deemed disparaging, regardless of its use in commerce.

Section 2(a)'s bar on disparaging marks was a creation of the federal government, first developed when Congress enacted the Lanham Act. *See infra* at 583-84. Three years later, the United States Trademark Association prepared the Model State Trademark Bill—a bill patterned on the Lanham Act in many respects. McCarthy at § 22:5. The Model Bill contained language barring a mark from registration if it "consists of or comprises matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." 1964 Model State Trademark

Act, § 2. Following the lead of the federal government, virtually all states have adopted the Model Bill and its disparagement provision. McCarthy at § 22:5. Thus, not only are the benefits of federal registration unavailable to Mr. Tam, so too are the benefits of trademark registration in nearly all states. And as commentators have noted, state statutory and common law schemes mirror Lanham Act protections, making it likely that an unregisterable trademark will have no state protection. McCarthy at § 22:1.50; *see also* 1964 Model State Trademark Act, § 1.C ("The term 'mark' as used herein includes any trademark or service mark *entitled to registration* under this Act whether registered or not.") (emphasis added).

While denial of registerability and the attendant rights of protection both federal and state do not prevent a trademark owner from using its mark, such denial severely burdens use of such marks. Section 2(a)'s content-based restrictions on registerability were adopted to reduce use of trademarks the government deemed unsuitable (such as those that disparage)—no doubt a chilling effect on speech.

B. The "Unconstitutional Conditions" Doctrine

The Supreme Court has repeatedly held that the government cannot deny access to a benefit because of the recipient's exercise of constitutionally protected speech. Under the "unconstitutional conditions" doctrine,

> [E]ven though a person has no 'right' to a valuable governmental benefit and even though the government may deny him the benefit for any number of

> reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech. For if the government could deny a benefit to a person because of his constitutionally protected speech or associations, his exercise of those freedoms would in effect be penalized and inhibited.

Perry v. Sindermann, 408 U.S. 593, 597, 92 S. Ct. 2694, 33 L. Ed. 2d 570 (1972). Under this doctrine, the Supreme Court held that a state college could not refuse to retain a professor because of his public criticism of that college's policy, even though the professor had no right to reemployment and even though the government had not directly prohibited the professor from speaking. *Id.* at 597-98, 92 S. Ct. 2694. This is because "[t]o deny [a benefit] to claimants who engage in certain forms of speech is in effect to penalize them for such speech." *Speiser v. Randall*, 357 U.S. 513, 518, 78 S. Ct. 1332, 2 L. Ed. 2d 1460 (1958).

Since *Perry*, the Supreme Court has wrestled with the inherent tension between applying the "unconstitutional conditions" doctrine and protecting Congress' ability to direct government spending. As the Supreme Court has noted, the Spending Clause of the U.S. Constitution, which grants Congress the power "[t]o lay and collect Taxes, Duties, Imposts and Excises, to pay the Debts and provide for the common Defence and general Welfare of the United States," U.S. Const. Art. I, § 8, cl. 1, "provides Congress broad discretion to tax and spend for the 'general Welfare,'

including by funding particular state or private programs or activities." *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, — U.S. —, 133 S. Ct. 2321, 2327-28, 186 L. Ed. 2d 398 (2013). This includes "the authority to impose limits on the use of such funds to ensure they are used in the manner Congress intends," even when these limits are conditioned on the recipients' constitutional rights. *Id.* at 2328 (citing *Rust v. Sullivan*, 500 U.S. 173, 195 n.4, 111 S. Ct. 1759, 114 L. Ed. 2d 233 (1991)). The Court reasoned that "if a party objects to a condition on the receipt of federal funding," it can always decline the funds. *Id.*

Thus, "when the Government appropriates public funds to establish a program it is entitled to define the limits of that program." *United States v. Am. Library Ass'n, Inc.*, 539 U.S. 194, 211, 123 S. Ct. 2297, 156 L. Ed. 2d 221 (2003) (quoting *Rust*, 500 U.S. at 194, 111 S. Ct. 1759). Under this reasoning, the Supreme Court upheld regulations prohibiting the use of federal family planning funds for abortion counseling and referral services. *Rust*, 500 U.S. at 192, 111 S. Ct. 1759. Similarly, the Court held that conditioning public libraries' receipt of federal subsidies on their use of Internet filtering software was a valid exercise of Congress' spending power, because Congress was entitled to insist that "public funds be spent for the purposes for which they were authorized." *Am. Library Ass'n*, 539 U.S. at 211-12, 123 S. Ct. 2297 (quotation marks omitted). This spending limitation applies to indirect forms of public funding such as tax exemptions as well as direct subsidies. *Regan v. Taxation with Representation of Wash.*, 461 U.S. 540, 544, 103 S. Ct. 1997, 76 L. Ed. 2d 129 (1983) ("Both tax exemp-

tions and tax-deductibility are a form of subsidy that is administered through the tax system.").

The government's discretion under the Spending Clause, while broad, is not unbounded. If a program arises from the Spending Clause, Congress is free to attach "conditions that define the limits of the government spending program—those that specify the activities Congress wants to subsidize." *Agency for Int'l Dev.*, 133 S. Ct. at 2328. However, Congress does not have the authority to attach "conditions that seek to leverage funding to regulate speech outside the contours of the program itself." *Id.* For example, the Court held that Congress could not restrict appropriations aimed at combating the spread of AIDS to only organizations having policies explicitly opposing prostitution and sex trafficking. *Id.* at 2230-31.

Thus, the analysis of whether Congress has imposed an unconstitutional condition on a federal benefit is affected by the nature of the Congressional benefit—namely, was the benefit authorized pursuant to Congress' Spending power. Courts have examined whether the conditioned benefit was pursuant to the Spending Clause. For example, the Ninth Circuit considered whether the "unconstitutional conditions" doctrine prevented the government from implementing a treaty under which certain "educational, scientific, and cultural" audio-visual materials were subject to benefits, including exemption from import duties. *Bullfrog Films, Inc. v. Wick*, 847 F.2d 502, 503 (9th Cir. 1988). Film makers, producers, and distributors argued that the treaty violated the First Amendment. *Id.* at 504. The government responded by arguing, as

it does here, that the regulations stemming from the treaty did not "punish or directly obstruct plaintiffs' ability to produce or disseminate their films," and that any benefits flowing from the regulations were "a case of the government simply declining to pay a subsidy." *Id.* at 509. The Ninth Circuit disagreed with the government's "benign characterization" of the effect of the regulations and reasoned that the trade benefits were not a subsidy because "no Treasury Department funds [were] involved," and therefore the spending exception did not apply. *Id.* at 509. The Ninth Circuit held that "by conditioning a valuable governmental benefit on the basis of speech content, the [government] forces film makers to choose between exercising their right to free speech and foregoing benefits under the [treaty], or curtailing their speech and obtaining the benefits." *Id.* at 511. It reasoned that "this sort of dilemma patently transgresses the well-established principle that government may not condition the conferral of a benefit on the relinquishment of a constitutional right." *Id.*

The Fifth Circuit recently considered, en banc, the constitutionality of a Texas law allowing charitable organizations to hold bingo games so long as the resulting funds were not used for lobbying. *Dep't of Tex., Veterans of Foreign Wars v. Tex. Lottery Comm'n*, 760 F.3d 427, 430 (5th Cir. 2014) (en banc). The Texas Lottery Commission argued that the law's restrictions were not unconstitutional because they fell within the state government's spending power, which is analogous to the federal government's spending power. *Id.* at 434. The Fifth Circuit agreed that "the government may attach certain speech restrictions to funds

linked to the public treasury—when either granting cash subsidies directly from the public coffers . . . or approving the withholding of funds that otherwise would go to the public treasury." *Id.* at 435. However, the Fifth Circuit found the Texas bingo program "wholly distinguishable . . . because no public monies or 'spending' by the state are involved." *Id.* at 436. The Fifth Circuit reasoned that the bingo program's primary function is regulatory, further "underscor[ing] the incongruity of [applying] the 'subsidy' paradigm to the bingo program." *Id.* at 437. The Fifth Circuit therefore applied the "unconstitutional conditions" doctrine to the bingo program, and found its lobbying provision unconstitutional. *Id.* at 437-41.

The D.C. Circuit similarly held that a presidential directive barring lobbyists from serving on international trade advisory committees implicated the First Amendment. *Autor v. Pritzker*, 740 F.3d 176, 177 (D.C. Cir. 2014). The government argued that "when [it] appropriates public funds to establish a program, its decision not to use program funds to subsidize the exercise of a fundamental right does not infringe." *Id.* at 182 (quotations and alterations omitted). The D.C. Circuit rejected the government's argument because membership in the advisory committees was a non-financial—albeit valuable—benefit. *Id.* at 182-83. It noted that advisory committee members are not paid for their service, "absorbing even their out of pocket expenses." *Id.* at 183. Because "[t]he Supreme Court has never extended the [spending exception] to situations not involving financial benefits," the D.C. Circuit found the directive could be an unconstitutional condition, and remanded so the district court

could consider the lobbyists' claims further. *Id.* at 183-84.

In another case, satellite carriers objected to the "must carry" provision in a federal law that granted satellite carriers a copyright license to retransmit local television stations in a given market so long as they also retransmitted all local television stations in that market upon request. *Satellite Broad. & Commc'ns Ass'n v. FCC*, 146 F. Supp. 2d 803, 808-09 (E.D. Va. 2001), *aff'd*, 275 F.3d 337 (4th Cir. 2001). The district court reasoned that Congress' grant of a copyright license to satellite carriers did not arise from the Spending Clause (and therefore qualify as a "subsidy") because "it [did] not entail the grant of government funds, or other benefits obtained through the use of government funds (i.e., property, government-created jobs, etc.), to confer a benefit." *Id.* at 829. The court then considered the constitutionality of the "must carry" condition attached to the copyright license, and held the law constitutional both because it satisfied intermediate scrutiny and because, if a carrier opted not to accept the copyright license granted by the statute, it could still negotiate for the right to transmit the local stations. *Id.* at 830-31.

C. Applying the "Unconstitutional Conditions" Doctrine to Trademark Registration

McGinley is the only case of ours to consider, if only briefly, the First Amendment implications of § 2(a). Since *McGinley*, a number of cases raised a First Amendment challenge to § 2(a), but in each case, the panel held itself bound by *McGinley*. *See In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir.

2003); *In re Mavety Media Grp.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994); *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012). Neither the court in *McGinley* nor any other court has analyzed § 2(a) under the "unconstitutional conditions" doctrine. This is error. Federal trademark registration confers valuable benefits, and under § 2(a), the government conditions those benefits on the applicants' choice of a mark. Because the government denies benefits to applicants on the basis of their constitutionally protected speech, the "unconstitutional conditions" doctrine applies.

However, we are faced with a fundamental predicate question: does the "unconstitutional conditions" doctrine apply with full force in the context of trademark registration, or is it tempered by virtue of Congress' spending power? The benefits of trademark registration, while valuable, are not monetary. Unlike tangible property, a subsidy, or a tax exemption, bestowal of a trademark registration does not result in a direct loss of any property or money from the public fisc. Rather, a trademark redefines the nature of the markholder's rights as against the rights of other citizens, depriving others of their rights to use the mark. Like the programs in *Bullfrog* and *Texas Lottery Commission*, the system of trademark registration is a regulatory regime, not a government subsidy program.

Furthermore, the act of registering a trademark does not involve the federal treasury. In 1981, as noted by the McGinley court, trademark registration was "underwritten by public funds." 660 F.2d at 486. That is no longer true today. Since 1991, PTO operations have been funded entirely by registration fees,

not the taxpayer. *Figueroa v. United States*, 466 F.3d 1023, 1028 (Fed. Cir. 2006); *see also* 56 Fed. Reg. 65147 (1991); Omnibus Budget Reconciliation Act of 1990, Pub. L. No. 101-508, S. 10101, 1990 U.S.C.C.A.N. (104 Stat.) 1388.

While PTO operations are fully funded by registration fees, some federal funds are nonetheless spent to facilitate the registration and enforcement of trademarks. For example, PTO employee benefits, which include pensions, health insurance, and life insurance, are administered by the Office of Personnel Management and funded from the general treasury. *Figueroa*, 466 F.3d at 1028. And registering a trademark may lead to additional government spending, such as when the trademark owner seeks to enforce the trademark through the federal courts and U.S. Customs and Border Patrol. This spending, however, is attenuated from the benefits bestowed by trademark registration. Trademark registration does not implicate the Spending Clause merely because of this attenuated spending, else every benefit or program provided by the government would implicate the Spending Clause. The programs in *Bullfrog* and *Texas Lottery Commission* were likely funded in some part by the government—perhaps also by government benefits paid to employees administering the programs—but the Ninth Circuit and the Fifth Circuit considered only whether the conditioned benefits were paid for by government spending, and not whether the government subsidized the program in more indirect manners. And while the government argued in *Autor* that the government had appropriated public funds to establish the international trade advisory committees, 740 F.3d at 182, the

D.C. Circuit nonetheless found that membership on these advisory committees was not a financial benefit, *id.* at 183.

The purpose and nature of trademark registration support the conclusion that trademark registration is not a government-funded benefit. The Lanham Act derives from the Commerce Clause, not the Spending Clause, and its purpose is to regulate marks used in interstate commerce—not to subsidize the markholders. 15 U.S.C. § 1127. Furthermore, it is the markholder, and not the government, that must spend money (on advertising using its mark) to obtain the benefits of trademark registration. Registration of a trademark is not a federally funded financial benefit to the applicant.

McGinley was written only one year after *Central Hudson* and was decided against a background of law where the First Amendment had only recently begun to apply to commercial speech. Given the drastic changes since *McGinley* in constitutional jurisprudence and the PTO's shift from a taxpayer-funded organization to a user-funded program, the *McGinley* court's analysis of the constitutionality of § 2(a) of the Lanham Act no longer suffices. This analysis did not discuss the "unconstitutional conditions" doctrine, despite the doctrine's clear relevance. And because trademark registration is no longer funded by the federal treasury, there is no longer any argument that trademark registration implicates Congress' power to spend. To the contrary, the trademark registration scheme is a prototypical example of a regulatory regime. As a result, the "unconstitutional conditions"

doctrine applies. The government cannot hinge the benefits of federal trademark registration on constitutionally protected speech—here, the applicant's selection of a suitable mark—unless the government's actions pass constitutional scrutiny.

III. Is § 2(a) Unconstitutional?

A. Viewpoint Discriminatory Regulations

"Content-based regulations are presumptively invalid." *R.A.V.*, 505 U.S. at 382, 112 S. Ct. 2538; *Ashcroft v. ACLU*, 542 U.S. 656, 660, 124 S. Ct. 2783, 159 L. Ed. 2d 690 (2004). Viewpoint-based regulations are even more suspect, as they "raise[] the specter that the government may effectively drive certain ideas or viewpoints from the marketplace." *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 116, 112 S. Ct. 501, 116 L. Ed. 2d 476 (1991); *see Sorrell v. IMS Health Inc.*, — U.S. —, 131 S. Ct. 2653, 2667, 180 L. Ed. 2d 544 (2011); *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 828, 115 S. Ct. 2510, 132 L. Ed. 2d 700 (1995). As a result, these regulations receive the strictest of scrutiny. "In the ordinary case it is all but dispositive to conclude that a law is content-based and, in practice, viewpoint-discriminatory." *Sorrell*, 131 S. Ct. at 2667.

Section 2(a) of the Lanham Act bars the registration of disparaging speech. Under this law, it is possible to register trademarks that refer to a certain group in a positive, or non-disparaging manner, but not trademarks that refer negatively to the same group. *See R.A.V.*, 505 U.S. at 391, 112 S. Ct. 2538

(finding that an ordinance forbidding the use of "fighting words" that insulted "on the basis of race, color, creed, religion or gender" was viewpoint discriminatory because certain fighting words could be used only by those arguing in favor of tolerance, not their opponents). Section 2(a) discriminates against disparaging or offensive viewpoints.[2] Under this analysis, § 2(a) is presumptively invalid, and must satisfy strict scrutiny to be found constitutional.

Although the Supreme Court has yet to decide whether strict scrutiny attaches to restrictions on commercial speech that are viewpoint discriminatory, there is reason to believe it is an issue worth considering. *Sorrell*, 131 S. Ct. at 2664. This uncertainty is likely of no consequence, however, because it seems likely that section 2(a) cannot survive even the intermediate scrutiny that any restriction on commercial speech receives under *Central Hudson*.

B. *Central Hudson* Test for Commercial Speech

In *Central Hudson*, the Supreme Court laid out the framework for determining the constitutionality of restrictions on commercial speech. 447 U.S. at 566, 100 S. Ct. 2343. First, commercial speech "must con-

---

[2] It is incorrect to imply that the Lanham Act treats "laudatory" and disparaging trademarks the same. The Lanham Act always prohibits registration of disparaging marks. In contrast, the Lanham Acts prohibits the registration of "merely descriptive" marks unless or until they acquire distinctiveness or secondary meaning. 15 U.S.C. § 1052(f). Once a laudatory or descriptive mark attains secondary meaning as a source identifier, such marks are eligible for registration; disparaging trademarks are never eligible for registration.

cern lawful activity and not be misleading." *Id.* If this is the case, we ask whether (1) "the asserted governmental interest is substantial," (2) "the regulation directly advances the governmental interest asserted," and (3) the regulation "is not more extensive than is necessary to serve that interest." *Id.*

First, we ask whether the regulated activity is lawful and not misleading. *Id.* at 563-64, 100 S. Ct. 2343. There is nothing illegal about a disparaging trademark such as THE SLANTS, and Mr. Tam does not challenge the Lanham Act's proscription on the registration of misleading marks. Disparaging trademarks satisfy the first prong of the *Central Hudson* framework.

Next, for speech that is lawful and not misleading, a substantial government interest independent of disapproving the speech's message must justify the regulation. *Id.* at 566, 100 S. Ct. 2343; *Sorrell*, 131 S. Ct. at 2668 (2011) (law must not "seek to suppress a disfavored message"); *Sorrell*, 131 S. Ct. at 2670 (rejecting message-based interest as "contrary to basic First Amendment principles"). The government has not put forth any substantial interests that would justify § 2(a)'s bar against disparaging marks. One purpose of the disparagement provision of § 2(a) is evident on its face, and it is message-based: to discourage the use of trademarks that are disparaging to persons, institutions, beliefs, or national symbols. The legislative history reinforces the conclusion that Congress enacted § 2(a) because it disapproved of the message conveyed by disparaging marks. *See* Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the

House Comm. on Patents, 76th Cong., 1st Sess. 18-21 (1939) (statement of Rep. Thomas E. Robertson) (Rep. Maroney) ("[W]e would not want to have Abraham Lincoln gin."). This is plainly true of the reason for denying registration here, as in other disparagement cases. *See, e.g., In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014) (affirming rejection of STOP THE ISLAMISATION OF AMERICA); *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q. 2d 1080 (TTAB June 18, 2014) (cancelling registration of REDSKINS); *In re Lebanese Arak Corp.*, 94 U.S.P.Q. 2d 1215 (TTAB Mar. 4, 2010) (refusing to register KHORAN for wine); *In re Heeb Media, LLC*, 89 U.S.P.Q. 2d 1071 (TTAB Nov. 26, 2008) (refusing to register HEEB); *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q. 2d 1264 (TTAB May 23, 2006) (refusing to register SQUAW VALLEY for one class of goods, but registering it for another). And there is no doubt that these marks are protected speech, not categorically excluded from First Amendment protection.[3]

---

[3] Disapproval of the message is also the apparent basis for denying under § 2(a) the registration of many "scandalous" marks that are not obscene. *See, e.g., In re Fox*, 702 F.3d 633 (Fed. Cir. 2012) (affirming rejection of COCK SUCKER for chocolate rooster lollipops); *In re Boulevard Entm't, Inc.*, 334 F.3d 1336 (Fed. Cir. 2003) (affirming rejection of 1-800-JACK-OFF and JACK-OFF for adult entertainment services over telephone); *In re Betty Bangs, LLC*, 2013 WL 5407261 (TTAB July 9, 2013) (refusing to register I BANGED BETTY); *In re Kirby*, 2008 WL 4674566 (TTAB Sept. 22, 2008) (refusing to register COCAINE for energy drinks); *In re Love Bottling Co.*, 2005 WL 1787238 (TTAB June 22, 2005) (refusing to register W.B. WIFE BEATER); *In re Zaharoni*, 2005 WL 363392 (TTAB Jan. 4, 2005) (refusing to register THE COM-

While the government may argue that it has an interest in discouraging the use of disparaging marks that may be offensive to persons, institutions, beliefs, or national symbols, this is not a legitimate government interest. *See Sorrell*, 131 S. Ct. at 2670. The Supreme Court has "consistently held that the fact that protected speech may be offensive to some does not justify its suppression." *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71, 103 S. Ct. 2875, 77 L. Ed. 2d 469 (1983). It is a "bedrock principle underlying the First Amendment . . . that the Government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." *United States v. Eichman*, 496 U.S. 310, 319, 110 S. Ct. 2404, 110 L. Ed. 2d 287 (1990).

Courts have attributed an additional government interest to § 2(a), reasoning that it acts as "a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government." *See, e.g., McGinley*, 660 F.2d at 486. This cannot warrant the government's regulation of these marks. Trademark registration is entirely user-funded, not taxpayer-funded, so registering these marks costs the government little money. Furthermore, the government must expend significant funds defending its refusal decisions under the statute as it currently stands, so it is not clear that the statute succeeds in saving the government money. *See McGinley*, 660 F.2d at 487 (Rich, J., dissenting) ("More 'public funds'

PLETE A**HOLE'S GUIDE TO . . .); *In re Runsdorf*, 171 U.S.P.Q. 443 (TTAB 1971) (refusing to register BUBBY TRAP for brassieres).

are being expended in the prosecution of this appeal than would ever result from the registration of the mark.").

Finally, labeling this sort of interest as substantial would create an end-run around the "unconstitutional conditions" doctrine, as virtually all government benefits involve the time, services, or funds of the federal government. Nearly every benefit could be justified under this ground, no matter how minimal.

Another interest that has been proposed to justify § 2(a)'s ban on disparaging marks is the government's interest in maintaining a well-functioning trademark system that harmonizes state and federal trademark law. In enacting the Lanham Act, Congress codified a number of long-standing common law trademark principles; the argument posits that striking down § 2(a)'s bar on disparaging marks would disrupt these principles. However, this argument relies on the notion that § 2(a)'s bar on disparaging marks is merely a codification of a common law bar on disparaging marks. That is not the case. While states have long refused to enforce vulgar or misleading trademarks, there is no similar history of a bar on disparaging marks. In drafting § 2(a)'s bar on disparaging marks, Congress was creating new law, not codifying clear and established principles. *See Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 1376 (Fed. Cir. 1983) ("Although not articulated as such, it appears that the drafters sought by § 2(a) to embrace concepts of the right to privacy, an area of the law then in an embryonic state."); *see also* Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 724 (1905) (barring reg-

istration of scandalous and immoral marks, but not disparaging marks). Section 2(a)'s bar on disparaging marks was employed only rarely until recently, and its application was inconsistent. *See, e.g., Doughboy Indus., Inc. v. The Reese Chemical Company*, 88 U.S.P.Q. (BNA) ¶ 227 (P.T.O. Jan. 25, 1951) (refusing to register mark "Dough-boy" in connection with "a prophylactic preparation for the prevention of venereal diseases"); *In re Anti-Communist World Freedom Cong., Inc.*, 161 U.S.P.Q. (BNA) ¶ 304 (TTAB Feb. 24, 1969) (refusing to register mark consisting of hammer and sickle with an "X" over it); *In re Condas S.A.*, 188 U.S.P.Q. (BNA) ¶ 544 (P.T.O. July 31, 1975) (finding mark JAP not disparaging to Americans of Japanese ancestry); *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q. 2d 1635 (TTAB Mar. 30, 1988) (finding that mark depicting a defecating dog disparaged Greyhound's trademarked running dog logo). And in the early disparagement cases, courts did not base the contours of what it means to be disparaging on the common law. *See generally id.* Striking down § 2(a)'s bar on disparaging marks would not disrupt long-standing, well-balanced common law traditions.

Trademarks—which are applied to private goods to identify the source of the goods for consumers—are private speech, not "government speech." *Cf. Pleasant Grove City v. Summum*, 555 U.S. 460, 467, 129 S. Ct. 1125, 172 L. Ed. 2d 853 (2009) ("The Free Speech Clause restricts government regulation of private speech; it does not regulate government speech."). Although the government publishes registered trademarks in the Trademark Principal Register, it does so not to communicate a particular message

or select a particular viewpoint; rather, it publishes trademarks to provide notice that a mark has been registered. Despite this, supporters of § 2(a) have claimed that the government has an interest in not being seen to give a stamp of approval, imprimatur, to scandalous and disparaging terms. For this interest to be substantial, the public must believe that trademarks carry the stamp of government approval. The U.S. government recently explained that "'issuance of a trademark registration' does not 'amount[] to the awarding of the U.S. Government's 'imprimatur.'" Brief of United States at 21, *Pro-Football, Inc. v. Blackhorse*, No. 14-cv-1043 (GBL/IDD) (E.D. Va. Mar. 23, 2015), ECF No. 109 (quoting *In re Old Glory Condom Corp.*, 26 U.S.P.Q. 2d 1216, 1219-20 n.3 (TTAB Mar. 3, 1993) (alterations in original)). As the Trademark Trial and Appeal Board wrote:

> The duty of this Office . . . in reviewing applications for registration is nothing more and nothing less than to register those marks that are functioning to identify and distinguish goods and services in the marketplace. . . . Just as the issuance of a trademark registration by this Office does not amount to a government endorsement of the quality of the goods to which the mark is applied, *the act of registration is not a government imprimatur or pronouncement that the mark is a "good" one in an aesthetic, or any analogous, sense.*

Old Glory Condom Corp., 26 U.S.P.Q. 2d at 1219-20 n.3 (emphasis added). The public is not likely to believe that a registered trademark conveys the imprimatur of

the government. The trademark is printed on private property, in fact commercial goods, not on any government property. The purpose served by trademarks, to identify the source of the goods, is antithetical to the notion that the trademark is tied to the government.

We have yet to be presented with any substantial government interests that would justify the PTO's refusal to register disparaging marks. Without this, § 2(a) cannot satisfy the *Central Hudson* test. It is time to revisit the holding in *McGinley* in light of subsequent developments in the law and the trademark registration funding regime.

APPENDIX C

UNITED STATES PATENT AND
TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Serial No. 85472044

IN RE SIMON SHIAO TAM

Sept. 26, 2013

OPINION

Before: ROGERS, Chief Administrative Trademark Judge, and KUHLKE and TAYLOR, Administrative Trademark Judges.

Opinion by KUHLKE, Administrative Trademark Judge:

Applicant, Simon Shiao Tam, seeks registration on the Principal Register of the mark THE SLANTS in standard characters for services identified as "entertainment in the nature of live performances by a musical band," in International Class 41.[1]

---

[1] Application Serial No. 85472044 was filed on November 14, 2011, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on an allegation of first use and use in commerce on November 15, 2006.

Registration has been refused under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), on the ground that applicant's mark "consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols under Trademark Act Section 2(a)."[2] E.A. Br. p. 3.

When the refusal was made final, applicant appealed and requested reconsideration. On December 20, 2012, the examining attorney denied the request for reconsideration. Subsequently, the appeal was resumed and has been fully briefed. We affirm the refusal.

Arguments and Evidence

The examining attorney contends that THE SLANTS is a highly disparaging reference to people of Asian descent, that it retains this meaning when used in connection with applicant's services, and that a substantial composite of the referenced group finds it to be disparaging. In support of this contention the examining attorney has submitted several definitions from various dictionaries and reference works that label "slant" as a derogatory word, including the following definitions:

> Slant/Slant-eye n. a derog. Term for an Oriental person The Cassell Dictionary of Slang (1999);

---

[2] This is applicant's second application for the mark THE SLANTS for nearly identical services. Application Serial No. 77952263 was also refused under Section 2(a) as disparaging. Applicant appealed that refusal to the Board, but the case was dismissed for failure to file a brief. E.A. Br. n.1; Office Action n.1 (June 20, 2012).

Slant 1. A derogatory term used to refer to those of Asian descent. More accurately, it tends to refer to anybody with slanted eyes. Urban Dictionary (www.urbandictionary.com);

Slant noun US, derog. and offensive = slant-eye noun. Oxford Reference Online www.oxford reference.com;

Slant noun a. South Asian person US 1942 Offensive The New Partridge Dictionary of Slang and Unconventional English Vol. II (2006) (http://books.google.com); and

[S]lant a derogatory nickname for any Oriental. From the shape of the Oriental eyes. Slang and Euphemism (2d abridged ed. 1991).[3]

---

[3] Other definitions from reference works and websites include:

"Slant-eye, Slant pejorative term for a person of Far Eastern origin (Chinese, Japanese, Korean, Vietnamese etc.) Derived from the term for those who have epicanthic folds." List of ethnic slurs (www.wikipedia.org);

"Slant . . . The noun is from 1655. Derogatory slang sense of 'Oriental, slant-eyed person' is recorded from 1943, from earlier slant-eyes (1929)." Online Etymology Dictionary (www.etymonline.com);

"Slant - Asians - Facial Description—referring to the eyes." Ethnic Slurs www.asianjoke.com;

"Slant, slanteye, slant-eye. A derogatory reference to Asians, based on the epicanthic fold, or flap, over the eyes of some Asian peoples, giving the eyes a slanted look." The color of words: an encyclopaedic dictionary of ethnic bias in the United States (1997);

In one of the submissions other contextual meanings are included in the definition:

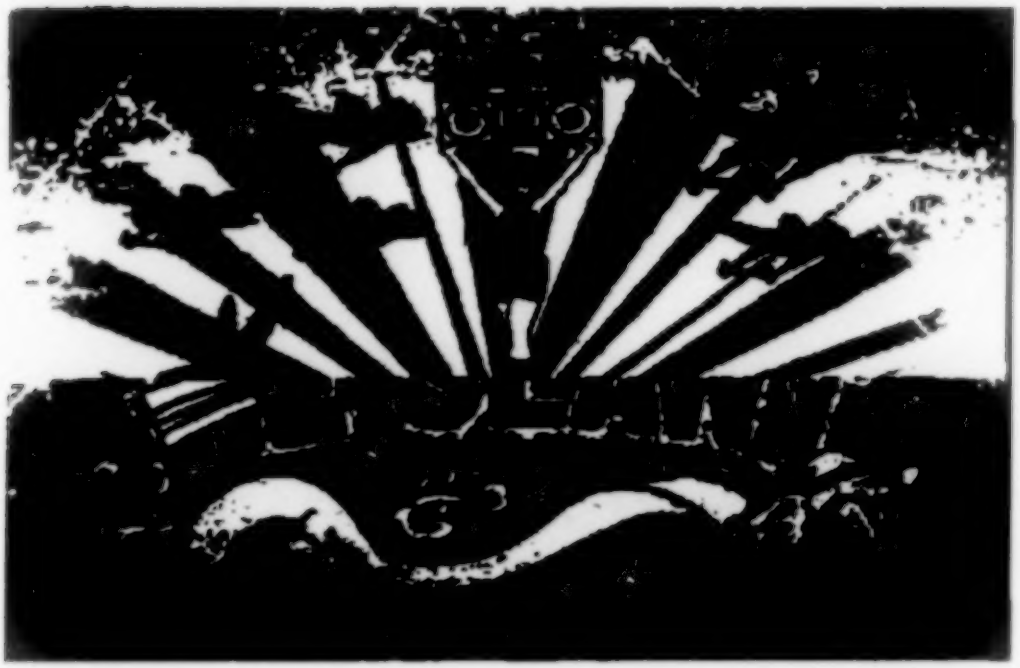
> Slant n. 1. a. A line, plane, course, or direction that is other than perpendicular or horizontal, a slope, b. A sloping thing or piece of ground; 2. *Printing* A virgule; 3. a. A personal point of view or opinion, b. A bias; **4. Offensive Slang Used as a disparaging term for a person of East Asian birth or descent.** The American Heritage Dictionary of the English Language retrieved from Credo Reference www.credoreference.com and Wordnik www.wordnik.com (emphasis added).

The examining attorney also included printouts from applicant's web page located at www.myspace.com/theslants, including the one depicted below:

"Forbidden Terminology Derogatory Racial Terms Slant refers to the perceived shape of Asian eyelids" 21st Century American English Compendium (3rd rev. ed. 2006);

"slope and slant, slanteye(s) an East Asian [including Japanese] or Southeast Asian person having the 'oriental' epicanthic folds. (Intended and perceived as derogatory. User is considered to be racially bigoted. . . .)" Forbidden American English (1995); and

"'Jap' is a derogatory term! . . . And, so are terms like 'chink' . . . and "slant.'" Japanese American Citizens League Anti-Hate Program www.lacl.org. "The Japanese American Citizens League is a national organization whose ongoing mission is to secure and maintain the civil rights of Japanese Americans and all others who are victimized by injustice and bigotry." www.jacl.org.



Further, the band's entry in Wikipedia is of record and references that "The band name, The Slants, is derived from an ethnic slur for Asians." www.wikipedia.org.[4] This entry also includes the following quote attributed to applicant: "We want to take on these stereotypes that people have about us, like the slanted eyes, and own them. We're very proud of being Asian—we're not going to hide that fact. The reaction from the Asian community has been positive."

---

[4] This Wikipedia entry was attached to the First Office Action (January 6, 2012); therefore, applicant had an opportunity to rebut it. *In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1382 n.2 (TTAB 2012); *In re Carrier Consulting Group*, 84 USPQ2d 1028, 1032-33 (TTAB 2007). Applicant did not do so. As will be discussed *infra*, applicant does not dispute the historical pejorative use of the term but, rather, can be characterized as intending to embrace and redefine the term.

Finally, the examining attorney submitted printouts of online articles which report that individuals representing Asian groups or in their individual capacity consider the term "slant," its plural "slants" and even specifically applicant's mark THE SLANTS to be disparaging terms. A few examples are set forth below:

> A few years back, the **Oregon Commission on Asian Affairs** AND the **Asian American Youth Leadership Conference**, both LOCAL Oregon organizations, pulled support from the Slants, citing their offensive name. I've got nothing against the Slants other than their name, which is racially offensive . . . "bigWOWO" at www.bigwowo.com (2010) (emphasis in original);
>
> Earlier this year, the band experienced first-hand the complex and diverse political perspectives of Asian Americans. Young[5] was initially slated to give the keynote address at the 2009 Asian American Youth Leadership Conference in Portland. But some conference supporters and attendees felt the name of the band was offensive and racist, and out of respect for these opinions the conference organizers decided to choose someone less controversial. "The Asian Reporter" (August 4, 2009);
>
> "Young [applicant] called the new band The Slants —a name that has been controversial from the

---

[5] Applicant, Simon Shiao Tam, is also known as Simon Young. See Office Action (January 6, 2012) p. 57 (www.bigwowo.com/2011/04/the-slants-and-bigwowos-support-of-the-u-s-patent-and-trademark-office).

> start. . . . It wasn't until he posted advertisements for Asian bandmates and people responded by calling him racist that Young realized the name pushed some hot buttons." The Oregonian (December 4, 2010); and
>
> Oregon Governor Cancels Asian Band the Slants' Performance at Asian Youth Conference . . . However, the OCAA withdrew support of the event because they found The Slants' name to be offensive towards the Asian community. Fearing that the action would trigger similar responses with other supporters, the AAYLC had no choice but to select an alternate speaker and cancel the band's appearance. "The Daily Swarm" http://64.34.174.165/headlines (2010);

In response to the refusal, applicant submitted the following dictionary definition:[6]

> Slant n. 1. a. A line, plane, course, or direction that is other than perpendicular or horizontal; a slope. b. A sloping thing or piece of ground. 2. *Printing* A virgule. 3. a. A personal point of view or opinion b. a bias 4. Offensive Slang Used as a disparaging term for a person of East Asian birth or ancestry.[7]

---

[6] We only include the noun definitions inasmuch as the verb definitions have less relevance to the mark THE SLANTS wherein "slants" is used as a noun, as determined by use of the definite article "the" immediately preceding the word "slants."

[7] American Heritage Dictionary of the English Language (http://ahdictionary.com May 2, 2012). Applicant also submitted the full excerpt of definitions for "slant" from the Oxford English Diction-

In addition, applicant submitted four third-party registrations and an application for marks that contain the word "slant." See Reg. No. 4123704 for the mark SLANT for, *inter alia*, skateboards, water skis, surf skis, skis, snow boards; Reg. No. 3894536 for the mark SLANT for, *inter alia*, motion picture film productions, production of radio or television programs; and two marks for serving ware for serving food, the standard character mark SLANT (Reg. No. 3437230) and the design mark

(Reg. No. 3437238).[8]

Applicant's primary contention is that his trademark has been "refused registration on the basis of Applicant's race . . . [and given the] failure of proof and misapplication of law, the evidentiary record does not support the PTO's conclusions that the Application for registration of THE SLANTS should be

---

ary which includes ten different meanings with the offensive slang meaning as the last entry.

[8] The fifth example is an application (Serial No. 85269787) and, as such, is of limited probative value. *Glamorene Products Corp. v. Earl Grissmer Co., Inc.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) (an application is evidence only of its filing).

denied." App. Br. pp. 3-4. Applicant asserts that the examining attorney failed to provide evidence that the mark is "inherently offensive" and takes issue with the examining attorney's reliance on one possible meaning of the word "slant," which resulted in the examining attorney's search parameters using the words "slant" and "derogatory" to "confirm" his refusal. App. Br. pp. 12-14.

As to the Office's evidence pertaining to applicant's services and manner of use, applicant argues that "the grounds for refusal constituted error [for] at least two reasons . . . (1) They improperly condition registration on the ethnic background of an applicant, and (2) they amount to an unprecedented prohibition against registration by a particular individual or group of people because of their past use of a mark." App. Br. p. 17. Specifically, applicant contends that, based on the examining attorney's logic, non-Asians would be entitled to registration of the word "slants" but Asians are not. Id. Applicant goes on to suggest that the only rebuttal to the examining attorney's refusal "would have been a submission proving that the band was not entirely Asian and hence entitled to registration, a patently offensive proposition." App. Br. p. 18. With regard to applicant's second point concerning its past use, applicant asserts that the refusal is "dependent on the identity of the person, rather than the content of the application."[9] Id.

---

[9] The "past use" is in reference to the examining attorney's evidence of applicant's use and public perception of that use that is prior to applicant's November 14, 2011 filing date.

Applicant concludes that:

> The refusal, rather, is based on who the Applicant is. It follows that if anyone else on earth—Asian or otherwise—submitted an application to register THE SLANTS that was identical to the Application here, registration would have been allowed. Concomitantly, Applicant could never register THE SLANTS no matter the content of the application.
>
> This result would be a surprising and troubling reading of 15 U.S.C. § 1052(a), and one that is not supported by law, policy or common sense. Neither the ethnic identity of Applicant, the extent to which he associates in his use of the mark with other Asians, the degree to which he makes use of his own cultural heritage, or his identity in any sense at all should be of relevance concerning registration of THE SLANTS as a trademark for "entertainment in the nature of live performances by a musical band."

App. Br. p. 19.

Law

Registration of a mark which consists of matter which may disparage, *inter alia*, "persons," is prohibited under Section 2(a) of the Trademark Act. To determine whether a proposed mark is disparaging the Board applies the following two-part test:

> 1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the

mark is used in the marketplace in connection with the goods or services; and

2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

In re Lebanese Arak Corp, 94 USPQ2d 1215, 1217 (TTAB 2010);[10] *In re Heeb Media LLC*, 89 USPQ2d 1071, 1074 (TTAB 2008); *In re Squaw Valley Development Co.*, 80 USPQ2d 1264, 1267 (TTAB 2006). The burden of proving that a mark is disparaging rests with the USPTO. *Squaw Valley*, 80 USPQ2d at 1271.

Whether a proposed mark is disparaging must be determined from the standpoint of a substantial composite of the referenced group (although not necessarily a majority) in the context of contemporary attitudes. *Squaw Valley*, 80 USPQ2d at 1269; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1758 (TTAB 1999), *rev'd on other grounds* 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003).

Depending on the facts of the case, a proposed mark may be: (1) an innocuous term that in the context of the goods or services is disparaging, *Lebanese Arak*, 94 USPQ2d at 1223 (likely meaning of KHORAN is the Islamic holy text and use for wine disparages religion and beliefs of Muslim-Americans); *see also Doughboy Industries, Inc. v. Reese Chemical Co.*, 88 USPQ 227 (PTO Exmr. In Chief 1951) (Doughboy refers to World

---

[10] See the *Lebanese Arak* decision for a discussion of the various provisions of Section 2(a) and the differentiation between terms asserted to be disparaging and those asserted to be scandalous.

War I American soldier as reinforced by picture of soldier on packaging and use on "a prophylactic preparation for the prevention of venereal diseases" disparages the soldiers); (2) a disparaging term that may have a nondisparaging meaning in a specific context, *Squaw Valley*, 80 USPQ2d 1264 (SQUAW when used with ski-related goods and services means Squaw Valley ski resort under the first part of the test, but disparaging meaning remains as to other non ski-related goods and services); or (3) a disparaging term that has no nondisparaging meanings in any context, and remains disparaging despite the applicant's goods or services, actual use or intent, *In re Heeb Media LLC*, 89 USPQ2d 1071 (TTAB 2008) (applicant's good intentions and inoffensive goods and services do not obviate finding that HEEB is disparaging in context of the goods and services; and mixed opinion among members of the referenced group does not erase the perception of a substantial composite who find it disparaging).

Findings/Analysis

We must first determine, based on the evidence of record, the "likely meaning" of THE SLANTS; and then, if there is a meaning that invokes a group of persons, turn to consider whether that meaning may be disparaging to a substantial composite of the referenced group.

What is the likely meaning?

The mere fact that the term has several meanings, even when many may be innocuous, does not, as applicant seems to argue, foreclose the possibility that the

proposed mark is disparaging to a group of persons.[11] When we take into account the "nature of the identified services," in this case, live performances by a musical band, we are faced with a term that necessarily identifies people, i.e., the live performers. Thus, those who attend the live performances will necessarily understand THE SLANTS to refer to the persons who comprise the musical band. Further, we must consider the "manner in which the mark is used in the marketplace in connection with the services," *Lebanese Arak*, 94 USPQ2d at 1217, which the record in this case shows to involve touting the slang meaning of "slants." Thus, it is abundantly clear from the record not only that THE SLANTS, used for the identified services, would have the "likely meaning" of people of Asian descent but also that such meaning has been so perceived and has prompted significant responses by prospective attendees or hosts of the band's performances. The evidence of public perception of the meaning of THE SLANTS, as used in connection with applicant's services, shows that meaning to be a derogatory reference to people of Asian descent.

Applicant argues that 1) the proposed mark is not inherently disparaging and there are no additional elements to make it so, and 2) there is nothing about the services that make it disparaging. The problem

---

[11] It appears to be applicant's position that a term is "inherently disparaging" when there is only one meaning for the word and that meaning is disparaging. However, when there are multiple definitions of a word and the manner of use of the word in the marketplace only points to the disparaging meaning, the term cannot be saved by the other irrelevant meanings.

with applicant's analysis is that it ignores "the manner in which the mark is used in the marketplace." *Id.* The musical group, in its advertising and on its website, promotes the "likely meaning" of the mark to be people of Asian descent by, for example, displaying the wording "THE SLANTS" next to a depiction of an Asian woman, utilizing rising sun imagery and using a stylized dragon image. In addition, applicant actively seeks to associate his services with this meaning as a way to embrace this slang meaning and to "own" the stereotype represented by THE SLANTS. That applicant, or even the entire band, may be willing to take on the disparaging term as a band name, in what may be considered an attempt not to disparage, but rather to wrest "ownership" of the term from those who might use it with the intent to disparage, and that some members of the referenced group may support applicant's use, does not mean that all members of the referenced group of persons share applicant's view. In *Heeb Media*, 89 USPQ2d at 1077, we faced and rejected a similar argument, holding that "[t]he fact that applicant has good intentions with its use of the term does not obviate the fact that a substantial composite of the referenced group find the term objectionable."

Applicant contends that the examining attorney based his conclusion as to "likely meaning" on the fact that "applicant is a founding member of a band (the Slants) that is self-described as being composed of members of Asian descent." App. Br. p. 4, quoting examining attorney's brief. Applicant argues further that:

> The Examining Attorney's rationale turned the entire policy justification for Section 2(a) on its head. It was a refusal to register based on the ethnic background of Applicant and his associates that was offensive. Unless reversed by the Board this formulation inevitably will involve the Patent and Trademark Office in inappropriate and constitutionally suspect inquiries concerning the ethnicity of applicants, their associates and their activities.

App. Br. p. 4.

Applicant is effectively arguing that because he actively seeks to convey a message that he has taken ownership of the term and its meaning, and intends no disparagement of members of the referenced group, the Office is prohibited from finding that THE SLANTS is disparaging to others, precisely because of applicant's race. In other words, applicant intentionally adopted the mark because it is disparaging to some, but we should ignore that because he is Asian and should not be perceived as intending to disparage other Asians but, rather, as redefining the term in a positive way. In essence, applicant does not address the injury that use of THE SLANTS may cause to other members of the referenced group and instead focuses on the asserted injury to himself, which he attributes to the examining attorney's improper consideration of his ethnicity. In the same way the particular ethnicity of the people behind the corporate applicant in *Heeb Media* did not serve to obviate or remove the disparaging nature of the term for others, here, too, applicant's ethnicity does not make his use

unlikely to be perceived as conveying the disparaging meaning of the term SLANTS for Asian Americans.

The focus of the inquiry into whether a mark is disparaging is not on applicant's race but rather on the referenced group's perception of the likely meaning of the mark.[12] The evidence clearly shows both that members of the referenced group ascribe the derogatory meaning based on applicant's manner of use and that members of the referenced group find it objectionable. There are no "other elements" in the mark to affect its meaning, and there is nothing about the way the mark is used in the marketplace from which one would understand the term as meaning anything other than an Asian person. Thus, the refusal is properly based on the perceptions of the referenced group and not on applicant's or his band-mates' ethnic background.

The interpretation of "slant" as meaning "person of Asian descent" (as opposed to other definitions of this word) arises because applicant's mark is used in a manner to mean "person of Asian descent." Applicant cannot claim ownership and redefine the term without a use that acknowledges the meaning that must be overcome. However, it is very important to note that a finding that THE SLANTS is disparaging is not dependent on applicant's ethnicity, but on the circumstances related to his use of the term. An

---

[12] Section 2(a), 15 U.S.C. § 1052(a) focuses on the nature of the mark, not the applicant: "No *trademark* . . . shall be refused registration . . . on account of *its* nature unless *it* . . . [c]onsists of or comprises . . . matter which may disparage. . . . " (emphasis added).

application by a band comprised of non-Asian-Americans called THE SLANTS that displayed the mark next to the imagery used by applicant shown supra would also be subject to a refusal under Section 2(a).

Finally, applicant's objection that the evidentiary record includes applicant's "past use," (i.e., use prior to the filing date of this application) and that such evidence is not within the four corners of the application, ignores the first prong of the test where we look to the "manner of use" which necessarily goes beyond the "four corners" of the application. Moreover, a determination about the view of the referenced group requires the USPTO to go outside the four corners of the application even if only to reference a dictionary definition that labels a term as derogatory. As to the date of the evidence, applicant bases his application on his use of the mark since 2006 and all evidence from then until the present is relevant.[13] Notably, appli-

---

[13] Regarding the four corners of an application, in its brief, applicant acknowledges in general that specimens may demonstrate disparaging use. App. Br. p. 10. As noted earlier, applicant abandoned his prior application by failing to file a brief on *ex parte* appeal. Applicant then filed this application, presumably with different specimens of use. As noted by the examining attorney:

> [T]hat applicant cleverly chose specimens that avoided associations with Asians or Asian culture is not evidence that the mark is not used in a way to conjure up the derogatory meaning and to be disparaging to Asians. . . . It is worth mentioning that applicant appears to have reversed course on its arguments for registrability, arguing in the prior application that because the applied-for mark was being used by Asian- Americans as a self-descriptor, it could not be dispar-

cant has not submitted evidence rebutting the evidence of likely meaning, to support, for example, the proposition that due to applicant's change in its manner of use members of the referenced group no longer perceive it as having a disparaging meaning.

> aging, while in this case arguing that there is no indication in the application that the mark is in any way associated with Asians or Asian-Americans. . . . Applicant's argument that the Office is limited to the four-corners of the application in determining the disparaging nature of the mark is too clever by half. Were applicant's theory correct, any smart applicant (or smart attorney) could easily draft an identification of goods and services that skates around any mention of a group or persons associated with a particular term, while at the same time, using the mark in such a way as to associate the mark with the disparaged group. Office Action (June 20, 2012).

In response to the examining attorney, applicant, in its Request for Reconsideration, states that the refusal:

> . . . is premised entirely on outside evidence of Applicant's aggressively Asian-themed artistic and commercial identity as used in the past with the mark. [and the refusal is based on] his use of the mark in circumstances not reflected in the Application but relied on as grounds for refusal in a previous application [that has] been deemed offensive by third parties. Req. Recon. pp. 6-7.

Applicant's own actions highlight the wisdom of our well-settled test for determining whether a mark is disparaging, which requires not only an assessment of information on the "four corners" of the application, such as the mark and the goods or services, but also looks at the manner in which the applicant uses the mark. Indeed, we also look at an applicant's manner of use to inform analysis of other types of refusals, such as those based on genericness. *See, e.g., In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1439-40 (TTAB 2005).

Is it disparaging to a substantial composite?

Having determined the likely meaning (in the context of the goods and services and how applicant uses the mark), we look to the second prong: is the mark disparaging to a substantial composite of the referenced group? The record establishes that the slang term "slant" or its plural "slants," when used to indicate ethnicity, is disparaging to a substantial composite of the referenced group.

While there is some mention in the record of support for applicant's mark in the Asian community (to be clear, quoted statements from applicant noting such support), "[o]ur consideration of whether the term is disparaging is not restricted to the perception of applicant's" fans who have no objection to the name of applicant's band. *Heeb Media*, 89 USPQ2d 1077. Rather, we are charged with taking into account the views of the entire referenced group who may encounter applicant's music entertainment services in any ordinary course of trade for the identified services. Thus, all members of the Asian-American public may encounter the mark THE SLANTS in advertising in newspapers, billboards or on a website.

The dictionary definitions, reference works and all other evidence unanimously categorize the word "slant," when meaning a person of Asian descent, as disparaging. Moreover, the record includes evidence of individuals and groups in the Asian community objecting to use of the term in the context of applicant's band. Taken as a whole we find the record contains substantial evidence to support the refusal. *Squaw Valley*, 80 USPQ2d at 1272. Finally, applicant does

not dispute that the band's name is derived from an ethnic slur and the evidence thereof stands unrebutted.

The fact that applicant has good intentions underlying his use of the term does not obviate the fact that a substantial composite of the referenced group find the term objectionable. *Heeb Media*, 89 USPQ2d at 1077. As the examining attorney states "while applicant may not find the term [disparaging], applicant does not speak for the entire community of persons of Asian descent and the evidence indicates that there is still a substantial composite of persons who find the term in the applied-for mark offensive." Office Action (January 6, 2012). Thus, despite applicant's assertion that "this is not yet another case of a member of an ethnic group seeking registration of a supposedly offensive slur on the ground that group members, or he in particular, have 'embraced' the term" (App. Br. p. 3), in fact it is just such a case.

Applicant's argument that other SLANT marks have been registered merely underscores why, in cases such as these, where a term may have different meanings depending on the context, the USPTO looks to the manner of use to ascertain whether potential consumers would perceive the term as disparaging. None of the marks in these third-party registrations refer to people.

We emphasize that this decision only pertains to applicant's right to register the term and "it is clear that the PTO's refusal to register [applicant's] mark does not affect [his] right to use it. No conduct is proscribed, and no tangible form of expression is sup-

pressed. Consequently, [applicant's] First Amendment rights would not be abridged by the refusal to register [his] mark." *In re McGinley*, 211 USPQ at 672, *citing Holiday Inn v. Holiday Inn, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 n.6 (CCPA 1976). *See also Mavety*, 31 USPQ2d at 1928. This case is solely about whether the applicant may "call upon the resources of the federal government" to obtain federal registration of the mark on the Principal Register in order to assist applicant in enforcing the mark. *See In re Fox*, 702 F.3d 633, 105 USPQ2d 1247, 1252. Because we find it disparaging, however, the mark is disqualified under Section 2(a) for registration.

Decision: The refusal to register under Section 2(a) is affirmed.

APPENDIX D

15 U.S.C. 1052 provides:

Trademarks registrable on principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the

goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a pro-

ceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.

RECORD
AND
FILE

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

SIMON SHIAO TAM

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF FOR THE PETITIONER

IAN HEATH GERSHENGORN
Acting Solicitor General
Counsel of Record
Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217

TABLE OF CONTENTS

Page

A. The Court should review and reverse the court of appeals' decision invalidating Section 1052(a)'s disparagement provision 2
B. Respondent's alternative arguments in support of the judgment below lack merit 6

TABLE OF AUTHORITIES

Cases:

Boulevard Entm't, Inc., In re, 334 F.3d 1336 (Fed. Cir. 2003) 3, 10, 11
Chevron U.S.A. Inc. v. *NRDC*, 467 U.S. 837 (1984) 8
Clinton v. *Jones*, 520 U.S. 681 (1997) 9
Cutter v. *Wilkinson*, 544 U.S. 709 (2005) 8
Geller, In re, 751 F.3d 1355 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 2239 (2015) 6, 10, 11
Lebanese Arak Corp., In re, 94 U.S.P.Q.2d 1215, 2010 WL 766488 (T.T.A.B. 2010) 7, 8
National Endowment for the Arts v. *Finley*, 524 U.S. 569 (1998) 5, 10
Rust v. *Sullivan*, 500 U.S. 173 (1991) 4
Shinnecock Smoke Shop, In re, 571 F.3d 1171 (Fed. Cir. 2009), cert. denied, 558 U.S. 1149 (2010) 11
Walker v. *Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015) 4

Constitution and statutes:

U.S. Const. Amend. I ..... *passim*
Speech Clause 1
Lanham Act, 15 U.S.C. 1051 *et seq.* 3
15 U.S.C. 1052(a) ..... *passim*

Statutes—Continued: Page

15 U.S.C. 1052(c) 9
15 U.S.C. 1064 11
15 U.S.C. 1070 11
15 U.S.C. 1071 11

In the Supreme Court of the United States

No. 15-1293

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

SIMON SHIAO TAM

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF FOR THE PETITIONER

The en banc court of appeals held that 15 U.S.C. 1052(a), which prohibits federal registration of trademarks that disparage persons, institutions, beliefs, or national symbols, is unconstitutional under the Speech Clause of the First Amendment to the Constitution. The court of appeals' facial invalidation of an Act of Congress warrants this Court's review. As the certiorari petition explains, the court of appeals' decision is fundamentally flawed, and the decision, if uncorrected, will effectively preclude the United States Patent and Trademark Office (PTO) from enforcing Section 1052(a)'s disparagement provision against any applicant for trademark registration.

Respondent agrees that this Court should grant certiorari to review the court of appeals' First Amendment holding. In addition to defending that holding, respondent makes two statutory arguments (one of

which was never raised below, and one of which was raised only in a substantially different form) and another constitutional argument in support of the judgment below. Those arguments lack merit and do not warrant this Court's review. In any event, respondent recognizes that his assertion of those alternative arguments provides no reason for this Court to deny review of the Federal Circuit's First Amendment holding.

A. The Court Should Review And Reverse The Court Of Appeals' Decision Invalidating Section 1052(a)'s Disparagement Provision

1. The en banc court of appeals invalidated the disparagement provision in 15 U.S.C. 1052(a) in all of its applications. See Pet. App. 20a n.5, 68a. Respondent agrees that the Court should review that holding. Resp. Br. 1, 10-13. The question presented is "undeniably important" (*id.* at 10), and the PTO has suspended action on trademark applications implicating Section 1052(a)'s disparagement provision while the government seeks review in this Court. This Court should grant review to provide the guidance necessary for continued operation of the trademark-registration system.

Respondent notes (Br. 11) that the First Amendment question also is presented in a petition for a writ of certiorari before judgment in *Pro-Football* v. *Blackhorse*, petition for cert. before judgment pending, No. 15-1311 (filed Apr. 25, 2016). Respondent agrees (Br. 11), however, that the petition in *Pro-Football* provides no reason to withhold or delay review in this case.[1]

---

[1] As the government's brief in opposition to the *Pro-Football* petition explains, that petition should be denied because the case

2. Respondent defends the court of appeals' First Amendment holding by arguing that Section 1052(a)'s disparagement provision imposes an impermissible burden on expression. Resp. Br. 21-30. But Section 1052(a) does not prohibit any speech, proscribe any conduct, or restrict the use of any mark. See *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) ("[T]he refusal to register a mark does not proscribe any conduct or suppress any form of expression because it does not affect the applicant's right to use the mark in question.").

Respondent may use any term he wishes in his songs, in his advertising, in his band's name, or in his mark. See Pet. 11-12; see also Pet. App. 105a (Lourie, J., dissenting) (respondent "may use his trademark as he likes" without federal registration). Nothing prevents him from "tak[ing] on stereotypes" about Asian-Americans (Resp. Br. 3) or using any words he likes—including the disparaging terms for African-Americans, women, and gay people he uses throughout his brief (*id.* at 2, 14, 19, 31-33)—in everyday speech or in his music.

Respondent therefore is wrong to characterize the denial of federal registration as a "burden" (Br. 25). Section 1052(a) does not make him any worse off than he would be in a pure free-market environment. The Lanham Act, 15 U.S.C. 1051 *et seq.*, provides certain

---

does not meet the demanding standard for certiorari before judgment. *Inter alia*, the petitioner in *Pro-Football* raises several arguments in addition to its First Amendment challenge, and those alternative arguments, if accepted by the court of appeals, would obviate the need for further review of the First Amendment issue in that case. Gov't Br. in Opp. at 9-22, *Pro-Football*, *supra* (No. 15-1311).

rights and remedies to unregistered marks, see Pet. 3-4, 11-12; disparaging marks simply do not obtain the additional benefits of registration under the Act. The denial of those benefits is not a burden on respondent's speech.

Congress acted permissibly in declining to open the federal trademark-registration program to disparaging marks. This Court has recognized in a variety of contexts that the government has significant flexibility in setting the criteria for participation in a government program. See *Rust* v. *Sullivan*, 500 U.S. 173, 193 (1991); see also Pet. 14-17 (citing cases). The government has a substantial interest in creating a federal trademark-registration program and in declining to use its resources to encourage use of offensive or disparaging terms as marks. See Pet. App. 81a (Dyk, J., concurring in part and dissenting in part); *id.* at 117a (Reyna, J., dissenting).

Respondent identifies ways in which the federal registration system differs from those programs this Court already has considered. Resp. Br. 25-29; see Pet. 16-22. Those distinctions, however, ignore the unifying principle that animates the decisions cited in the certiorari petition, namely that First Amendment scrutiny is significantly more relaxed when the government establishes eligibility criteria for a voluntary government program than when it restricts private speech. Just as a State is not required to place racist, misogynistic, or bigoted terms on license plates issued by the State, see *Walker* v. *Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2245-2250 (2015), the PTO is not required to use its resources to issue certificates of registration for marks containing disparaging terms, publish them in the PTO's *Official*

Gazette, and record them on the Principal Register. Pet. 15-16. And just as the government is not required to treat all speakers equally when it confers subsidies pursuant to a federal grant program, *National Endowment for the Arts* v. *Finley*, 524 U.S. 569, 572, 587-588 (1998), the PTO is not required to open the trademark-registration program to disparaging marks. That is especially true because the registration program concerns only commercial activity—the use of a mark to identify the source of goods and services in commerce—and does not restrict any expressive activity outside of the program.

3. Respondent asserts (Br. 2) that his mark should be registered because he is attempting to "reappropriat[e]" a racial slur and to use it as a "badge[] of pride." Respondent does not make clear whether he views his own lack of intent to disparage Asians as a ground for holding the statute unconstitutional as applied, or as a ground for holding that his mark does not "disparage * * * persons" within the meaning of Section 1052(a). In either event, respondent is wrong to suggest (Br. 14) that trademark registration should depend on the mark holder's intent—specifically, on whether a disparaging term is or will be "used with pride and understood that way." Under such an approach, the application of Section 1052(a) would depend on subjective judgments about the trademark owner's intentions, and thus would entail the very type of viewpoint discrimination that the Court generally disfavors. See Pet. 13 n.6. In implementing Section 1052(a), the PTO has appropriately avoided that result by using an objective test that applies without regard to whether a trademark holder intends to convey a

negative or positive message through use of a racial slur. See Pet. 5, 12-13.

B. Respondent's Alternative Arguments In Support Of The Judgment Below Lack Merit

In addition to defending the court of appeals' First Amendment holding, respondent contends that his mark is not "disparag[ing]" within the meaning of Section 1052(a), Resp. Br. 13-17; that Section 1052(a) does not apply to marks that disparage groups of people, but only to those that disparage particular individuals, *id.* at 17-21; and that Section 1052(a)'s disparagement provision is unconstitutionally vague, *id.* at 30-33. None of those arguments provides a basis for upholding the court of appeals' judgment.

1. Respondent contends (Br. 13-17) that Section 1052(a) does not bar registration of his mark because it is not "disparag[ing]." The en banc court of appeals disagreed and specifically reinstated the panel's holding that respondent's mark "is disparaging." Pet. App. 12a n.3. And the arguments that respondent presented to the court of appeals are significantly different from the arguments he now makes. In the Federal Circuit, respondent did not take issue with the PTO's two-part test for determining whether a mark is "disparag[ing]"; instead, he accepted that test and argued that the Board's conclusion was not supported by substantial evidence in the record. Resp. C.A. Br. 16-42; Resp. C.A. Reply Br. 5-19. Respondent does not contend that this fact-bound argument warrants this Court's review.

Instead, respondent now contends (Br. 15-16) that the PTO's test for identifying disparaging marks is infirm. The PTO administers the statutory provision at issue here by determining the meaning of a mark

and then asking whether that meaning is a disparaging one. Pet. App. 171a-172a; see *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 944 (2015). As respondent acknowledges (Br. 15), the PTO's test for determining a mark's meaning considers "not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services." *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 2010 WL 766488, at *3 (T.T.A.B. 2010).

Respondent's objection to the PTO's analysis is not that it fails to consider context, but that it does not turn on whether the owner of a disparaging mark has a good or bad intent. Although respondent argued below that he chose his mark with "good intentions," Pet. App. 181a, he did not contend that either the statutory or constitutional analysis depended on whether the mark holder intends offense, see Resp. Br. 2 n.1. In any event, although the PTO has historically considered objective circumstances going beyond dictionary definitions of particular terms, it has not treated the subjective intent of the would-be registrant as relevant to the determination whether a mark "[c]onsists of * * * matter which may disparage * * * persons, living or dead, institutions, beliefs, or national symbols." 15 U.S.C. 1052(a). The agency's objective approach is consistent with Section 1052(a)'s text, which focuses on the "matter" for which registration is sought, not on the state of mind of the would-be registrant. And, consistent with this Court's First Amendment doctrine, the agency's approach avoids having

the availability of the benefits of registration turn on the viewpoint of the registrant.

2. Respondent further argues (Br. 17-21) that Section 1052(a)'s disparagement provision applies to marks that disparage individuals, but not to marks that disparage groups of people. Respondent did not present that argument to the Board or the court of appeals.[2] The Court's ordinary practice in such circumstances is to decline to address the issue, see, *e.g.*, *Cutter* v. *Wilkinson*, 544 U.S. 709, 718 n.7 (2005) ("[W]e are a court of review, not of first view."), and the Court should adhere to that practice here. That course is especially appropriate because respondent identifies no court that has ever decided the issue.

In any event, respondent's new statutory argument is wrong on the merits. Section 1052(a) refers to a mark that contains matter disparaging "persons," 15 U.S.C. 1052(a), and persons of Asian descent are "persons." The Board has held that "persons" includes an ethnic group, see *Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 2010 WL 766488, at *2-*3, and that reasonable construction of the statute is entitled to deference, see *Chevron U.S.A. Inc.* v. *NRDC*, 467 U.S. 837, 843-844 (1984).

The PTO's construction makes particular sense in the context of the disparagement provision as a whole, which refers to disparagement of "persons, living or dead, institutions, beliefs or national symbols." 15 U.S.C. 1052(a). Congress's inclusion of "institutions," "beliefs," and "national symbols" makes clear that the provision is not limited to marks that disparage individual persons. While acknowledging that Section

---

[2] None of the amici in the court of appeals raised this argument either.

1052(a) reaches disparagement of "collective entities," respondent contends (Br. 17-21) that Congress intended to cover marks that disparage individual persons, companies, institutions, beliefs, and national symbols, but to exclude marks that disparage groups of people. Respondent identifies no sensible reason that Congress would leave such a gap in an otherwise broad provision. If Congress had intended that result, it could have used the term "particular individuals" or similar language, as it did in Section 1052(c), rather than the more general term "persons." See 15 U.S.C. 1052(c) (prohibiting registration of a mark that consists of "a name, portrait, or signature identifying a particular living individual").

The Court generally is reluctant "to decide any constitutional question in advance of the necessity for its decision," *Clinton* v. *Jones*, 520 U.S. 681, 690 n.11 (1997) (citation omitted), and it could elect as a matter of discretion to overlook respondent's forfeiture below and consider his new statutory argument before deciding the First Amendment question. The government does not recommend that course because it would encourage litigants to raise new issues in this Court, instead of presenting them to the lower courts in the first instance. But if the Court grants certiorari on the First Amendment question and wishes to consider the statutory issue as well, it should explicitly request briefing on that issue in order to provide appropriate notice to the parties and potential amici.

3. Respondent further contends (Br. 30-33) that Section 1052(a)'s disparagement provision is unconstitutionally vague. That argument lacks merit, and neither the court below nor any other court of appeals has accepted it.

Respondent is wrong to suggest that a "stringent" vagueness test applies. Resp. Br. 30 (citation omitted). Section 1052(a) does not prohibit speech or impose any civil or criminal penalties, but simply precludes the federal government from providing a certain type of assistance to marks that contain disparaging terms. See *Boulevard Entm't, Inc.*, 334 F.3d at 1343; see also Pet. 11-12. When a statute neither prohibits nor penalizes speech, but simply confers benefits on speakers whose expression satisfies certain criteria, the vagueness standard is relaxed because there is less concern about chilling speech. See *Finley*, 524 U.S. at 588-589. Under that relaxed standard, the Court has upheld even criteria that are "undeniably opaque" because "in the context of selective subsidies," "the consequences of imprecision are not constitutionally severe." *Ibid.*; see *id.* at 599 (Scalia, J., concurring in the judgment) ("Insofar as it bears upon First Amendment concerns, the vagueness doctrine addresses the problems that arise from government *regulation* of expressive conduct, not government grant programs.") (citation omitted). Denial or cancellation of a trademark registration does not trigger civil or criminal penalties, and the PTO's denial of registration here left respondent free to use "THE SLANTS" as the name of his band and in any promotional materials he wished to disseminate (as he had for the previous five years, see Pet. App. 10a, 162a n.1).

The term "disparage" in Section 1052(a) has been given a settled legal meaning, applying to any mark that "slight[s], deprecate[s], degrade[s], or affect[s] or injure[s] by unjust comparison." *Geller*, 751 F.3d at 1358 (citations omitted; brackets in original). In applying that standard to determine whether particular

marks are registrable, the PTO does not allow its examiners to rely on their own subjective views, but rather directs them to consider whether record evidence establishes that a "substantial composite of the referenced group" would find the mark disparaging. *Ibid.* Because the agency uses an objective, established test for disparagement, the contours of which have been explored and elaborated in published administrative and judicial decisions, the public has fair notice as to the standards for, and evidence relevant to, determining which marks are unregistrable.

Respondent argues (Br. 32-33) that Section 1052(a) is arbitrarily enforced, citing instances in which superficially similar marks were treated differently during registration. But analysis of whether a mark is disparaging requires consideration of the mark's meaning in relation to the particular goods and services for which registration is sought and the context in which the mark is used. See *Boulevard Entm't, Inc.*, 334 F.3d at 1341-1343. The superficial similarities that respondent identifies therefore do not establish that the PTO has erred in treating different marks differently.

In any event, the PTO examines more than 300,000 trademark applications each year. If an individual PTO employee improperly allows a mark to be registered or improperly refuses registration, "such errors do not bind the USPTO to improperly register" or refuse to register similar marks in the future. *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174 (Fed. Cir. 2009), cert. denied, 558 U.S. 1149 (2010). Congress authorized administrative and judicial review to ensure that such errors may be corrected, see 15 U.S.C. 1070, 1071, and if they are not, Congress authorized cancellation of erroneous registrations "[a]t any time," 15

U.S.C. 1064. Those provisions reflect Congress's recognition that registration errors occasionally occur. Thus, even if respondent could identify a clear inconsistency between particular registration decisions, there would be no sound basis for concluding that Section 1052(a)'s disparagement provision is incapable of principled application.

* * * * *

For the foregoing reasons and those stated in the petition for a writ of certiorari, the petition should be granted.

Respectfully submitted.

IAN HEATH GERSHENGORN
Acting Solicitor General

JULY 2016

AND
BRIEFS

No. 15-1293

IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF *AMICUS CURIAE* PRO-FOOTBALL, INC. IN SUPPORT OF RESPONDENT

ROBERT L. RASKOPF
TODD ANTEN
JESSICA A. ROSE
QUINN EMANUEL URQUHART & SULLIVAN, LLP
51 Madison Ave.,
22nd Floor
New York, NY 10010
(212) 849-7000
robertraskopf@quinnemanuel.com

LISA S. BLATT
Counsel of Record
ROBERT A. GARRETT
R. STANTON JONES
ELISABETH S. THEODORE
ARNOLD & PORTER LLP
601 Massachusetts Ave. NW
Washington, DC 20001
(202) 942-5000
lisa.blatt@aporter.com

Counsel for Amicus Curiae

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20002

RULE 29.6 STATEMENT

Pro-Football, Inc. is wholly owned by WFI Group, Inc., which in turn is wholly owned by Washington Football, Inc. No corporation or publicly held company owns ten percent or more of Washington Football, Inc.'s stock.

TABLE OF CONTENTS

	Page
RULE 29.6 STATEMENT	i
TABLE OF AUTHORITIES	iv
INTEREST OF *AMICUS CURIAE*	1
INTRODUCTION AND SUMMARY OF ARGUMENT	2
ARGUMENT	3
I. THE COURT SHOULD DENY THE PETITION OR HOLD IT PENDING RESOLUTION OF THE TEAM'S FOURTH CIRCUIT APPEAL	3
A. *Tam* Was Correctly Decided And Does Not Warrant This Court's Review	3
B. The Team's Case Is A Better Vehicle	8
C. There Is No Urgent Need To Grant The Petition Here Before The Fourth Circuit Rules	9
II. ALTERNATIVELY, THE COURT SHOULD DIRECT THE PARTIES TO ADDRESS WHETHER § 2(a) IS IMPERMISSIBLY VAGUE AND WHETHER § 2(a) APPLIES TO GROUPS	13
A. This Court Should Direct The Parties To Brief Whether § 2(a) Is Impermissibly Vague	13
B. The Court Should Direct The Parties To Brief Whether § 2(a) Applies Only To Identifiable Persons And Not To Groups	15
CONCLUSION	17

TABLE OF AUTHORITIES

CASES	Page(s)
Almendarez-Torres v. United States, 523 U.S. 224 (1998)	16
B & B Hardware, Inc. v. Hargis Indus., Inc., 135 S. Ct. 1293 (2015)	5
Bond v. United States, 134 S. Ct. 2077 (2014)	16
Cleveland v. United States, 531 U.S. 12 (2000)	7
In re Geller, 751 F.3d 1355 (Fed. Cir. 2014)	14
Greater New Orleans Broad. Ass'n, Inc. v. United States, 527 U.S. 173 (1999)	12
I.N.S. v. St. Cyr, 533 U.S. 289 (2001)	16
Neese v. S. Ry. Co., 350 U.S. 77 (1955)	16
Pitt News v. Pappert, 379 F.3d 96 (3d Cir. 2004)	5
Pro-Football, Inc. v. Blackhorse, 112 F. Supp. 3d 439 (E.D. Va. 2015)	1
Rosenberg v. Fleuti, 374 U.S. 449 (1963)	16
Sorrell v. IMS Health Inc., 564 U.S. 552 (2011)	5

TABLE OF AUTHORITIES—Continued

TRADEMARK TRIAL AND APPEAL BOARD DECISIONS — Page(s)

Boswell v. Mavety Media Grp. Ltd., 1999 WL 1040108 (T.T.A.B. 1999) 14

In re Condas S.A., 1975 WL 20869 (T.T.A.B. 1975) 14

In re Over Our Heads Inc., 1990 WL 354546 (T.T.A.B. 1990) 14

CONSTITUTIONAL PROVISIONS

U.S. Const. amend. I. .....*passim*

STATUTES

15 U.S.C. § 1052(a).....*passim*

15 U.S.C. § 1064 15

OTHER AUTHORITIES

M. Kern-Foxworth, *Aunt Jemima, Uncle Ben, and Rastus: Blacks in Advertising, Yesterday, Today, and Tomorrow* (1994)... 11

PTO, Official Gazette Publication Confirmation, U.S. Serial No. 86857969, http://goo.gl/RlJNCB..... 14

PTO, *Trademark Trial and Appeal Board Manual of Procedure* (June 2015) 15

INTEREST OF *AMICUS CURIAE*[1]

Amicus Pro-Football, Inc. (the "Team") owns and operates the NFL's Washington Redskins. The Team owns six federal registrations for trademarks bearing the Redskins name or an iteration of the name. The Team adopted the Redskins name in 1933, and the PTO registered the Redskins marks on six separate occasions from 1967 to 1990.

The Team has a substantial interest in the question presented here: whether the disparagement clause in § 2(a) of the Lanham Act is facially invalid under the First Amendment. In this case, the PTO invoked § 2(a) to deny registration for a rock band's mark, THE SLANTS, that the PTO thought disparages Asian Americans. Separately, in 2014, the PTO invoked the same clause to cancel the Team's longstanding registrations. The PTO did so not because the marks are disparaging *today*, but because the PTO believed the marks disparaged Native Americans *decades ago*, when the PTO first registered the marks in 1967. The U.S. District Court for the Eastern District of Virginia affirmed the cancellations, rejecting the Team's arguments that § 2(a) violates the First Amendment, that § 2(a) is unconstitutionally vague, and that the government's nearly 50-year delay between the first registration and the cancellation violates procedural due process. *Pro-Football, Inc. v. Blackhorse*, 112 F.

---

[1] No counsel for a party authored this brief in whole or in part. No one other than amicus curiae, its members, the National Football League, or amicus's counsel made a monetary contribution intended to fund the preparation or submission of this brief. Counsel of record for all parties received notice at least ten days prior to the due date of amicus's intention to file this brief. The parties have consented to the filing of this brief, and copies of the letters of consent are on file with the Clerk's Office.

Supp. 3d 439 (E.D. Va. 2015). The Team appealed, and the appeal is fully briefed and awaiting oral argument in the Fourth Circuit. *Pro-Football, Inc. v. Blackhorse*, No. 15-1874.

Like this case, the Team's appeal presents the question whether § 2(a) is invalid under the First Amendment. The Team's appeal also presents two additional, intertwined constitutional challenges to § 2(a), as well as a narrowing construction that would avoid any constitutional question in both this and the Team's cases.

INTRODUCTION AND SUMMARY OF ARGUMENT

Five days after the government filed its petition for a writ of certiorari here, the Team filed a petition for a writ of certiorari before judgment in its pending Fourth Circuit case. *See* Pet. for Certiorari, *Pro-Football, Inc. v. Blackhorse*, No. 15-1311 (Apr. 25, 2016). The Team's petition explains that if this Court grants certiorari here, the Court also should grant certiorari before judgment in the Team's case as an indispensable and invaluable complement.

As the Team's petition states, however, the Team believes that *Tam* was correctly decided and does not warrant this Court's review. The en banc Federal Circuit applied settled First Amendment doctrine and rightly concluded that § 2(a)'s disparagement clause burdens speech on the basis of content and viewpoint, and fails both strict and intermediate scrutiny. This Court accordingly should deny the government's petition in this case.

But at a minimum, the Court should hear this case together with the Team's case. The Team's case presents the First Amendment question in the setting

of a cancellation, an essential context in which § 2(a) applies, and also presents two related constitutional questions and a narrowing construction of § 2(a) that would avoid all the constitutional questions. The Court can hear the two cases together by granting both the government's and the Team's petitions now. But if the Court does not wish to grant certiorari before judgment in the Team's case, the Court should hold the government's petition here until after the Fourth Circuit resolves the Team's appeal. There is no urgent need for this Court to hear this case now.

Alternatively, if the Court chooses to hear this case alone, the Court should direct the parties to address the additional questions of whether § 2(a) is unconstitutionally vague and whether § 2(a) applies only to identifiable individuals and juristic persons, not to groups as a whole. The Court regularly considers First Amendment and vagueness challenges together, and here the vagueness challenge to § 2(a) is at least as strong as the First Amendment challenge. In addition, the Court has an obligation to construe § 2(a), if possible, in a manner that avoids constitutional questions. The Court should not grant the petition in this case without directing the parties to address these critical issues.

ARGUMENT

I. THE COURT SHOULD DENY THE PETITION OR HOLD IT PENDING RESOLUTION OF THE TEAM'S FOURTH CIRCUIT APPEAL

A. *Tam* Was Correctly Decided And Does Not Warrant This Court's Review

The Federal Circuit in *Tam* correctly held that § 2(a)'s disparagement clause is facially invalid under

the First Amendment. That decision does not warrant this Court's review.

Section 2(a) reflects paradigmatic and rank viewpoint discrimination. "The PTO rejects marks under § 2(a) when it finds the marks refer to a group in a negative way, but it permits the registration of marks that refer to a group in a positive, non-disparaging manner." Pet. App. 21a. The PTO thus refused to register THE SLANTS because it disparages people of Asian descent, but repeatedly "registered marks that refer positively to people of Asian descent," including CELEBRASIAN and ASIAN EFFICIENCY. *Id.* The PTO similarly registered THINK ISLAM, but refused to register STOP THE ISLAMISATION OF AMERICA under § 2(a). *Id.* at 21a-22a. The government's petition only highlights the government's disdain for the viewpoint of the speech § 2(a) targets and penalizes. *See* Pet. 10, 16, 21 ("racial slurs"); 12 ("racial slur"); 15, 16, 22 ("racial epithets"); 16 ("racist, misogynist or bigoted"); 21 ("offensive"); 22 ("the most vile racial epithets").

The government argues that § 2(a) is viewpoint-neutral because it bars registration of marks found to be disparaging "without regard to the ideology, opinion, or perspective of the trademark owner." *Id.* at 13 (quotation marks omitted). That is non-responsive. Section 2(a) bars registration based on the "ideology, opinion, or perspective" that the mark purportedly *conveys* to the referenced group. Because § 2(a) targets the message expressed by the mark, it facially discriminates on the basis of viewpoint.

In any event, "[i]t is beyond dispute"—and the government does not contest—"that § 2(a) discriminates on the basis of content in the sense that it 'applies to particular speech because of the topic discussed.'" Pet. App. 18a-19a (quoting *Reed v. Town*

of Gilbert, 135 S. Ct. 2218, 2227 (2015)). And strict scrutiny applies to any content-based law that imposes "more than an incidental burden on protected expression." *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 567 (2011). Non-incidental burdens include denials of otherwise available government benefits. *Id.* at 568-70 (discussing *Los Angeles Police Dep't v. United Reporting Publ'g Corp.*, 528 U.S. 32 (1999)).

The government defends § 2(a) on the theory that the PTO merely denied respondent the statutory benefits of registration while leaving him free to use the name THE SLANTS to perform his music. Pet. 12-14. But the Federal Circuit correctly rejected the government's argument that "§ 2(a) does not implicate the First Amendment because it does not prohibit any speech." Pet. App. 28a. "Lawmakers may no more silence unwanted speech by burdening its utterance than by censoring its content." *Sorrell*, 564 U.S. at 566; Pet. App. 18a, 29a (quoting same). That is because "[t]he threat to the First Amendment arises from the imposition of financial burdens that may have the effect of influencing or suppressing speech, and whether those burdens take the form of taxes or some other form is unimportant." *Pitt News v. Pappert*, 379 F.3d 96, 111-12 (3d Cir. 2004) (Alito, J.). And "§ 2(a) burdens some speakers and benefits others." Pet. App. 30a. "Registration is significant"—it confers "important legal rights and benefits," including many "procedural and substantive legal advantages." *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1300 (2015) (quotation marks omitted). Section 2(a) thus deprives would-be registrants of substantial legal rights afforded to other speakers, including competitors.

The government is equally off-base in arguing that this Court should review § 2(a) under anything other than strict scrutiny, including the intermediate scrutiny afforded to commercial speech. The Slants and the Redskins use their names to engage in speech that is purely expressive: entertainment. Their trademarks thus stand on equal footing with those of THE LION KING, COMEDY CENTRAL, THE BEATLES, NEW YORK TIMES, NEW YORK CITY BALLET, and METROPOLITAN MUSEUM OF ART. None of these institutions could function without a name. Moreover, even mark-owners who manufacture widgets use their marks to engage in core political speech. Pet. 26-27 (No. 15-1311).

The government also argues that § 2(a) is constitutional under cases involving government subsidies or government speech. Pet. 14-22. While expressing uncertainty about the right "doctrinal 'box'" for its argument, the government asserts that "First Amendment scrutiny is significantly more relaxed when the government establishes eligibility criteria for a voluntary government program." *Id.* at 15. The government thus argues that "the First Amendment does not bar Congress from using the resources of the federal government to encourage some forms of expressive conduct rather than others." *Id.* at 18-19. Under the government's view, Congress could withhold registration with respect to any goods it disfavors (*e.g.*, guns, fast food); services that risk injury (*e.g.*, sports, skydiving); goods that appeal to prurient interests (*e.g.*, pornography, dating services); or marks that touch upon topics regardless of viewpoint (*e.g.*, abortion, political activities).

Government speech, however, is the only "doctrinal 'box'" that would allow content and viewpoint

discrimination. But the government fails to confront the sheer absurdity of rendering all two million currently registered trademarks government speech. *See infra* pp. 10-11. More importantly, the government names not a single registered mark that the public associates with the government as the speaker. And surely no one associates the government with registered marks like THE CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS, REPUBLICAN NATIONAL COMMITTEE, MARIJUANA FOR SALE, and DOES THIS GUN MAKE MY BUTT LOOK BIG? *See also* Pet. App. 33a n.7, 43a. Registered marks like ACLU and NATIONAL RIFLE ASSOCIATION represent organizations that regularly oppose government regulation.

The government obliquely labels trademark registration a "voluntary government program" akin to a subsidy, Pet. 15, without naming a single analogous government program that engages in content and viewpoint discrimination. This case involves no cash, assistance, financial grants, or government employment. To the contrary, the PTO is funded by applicants' registration fees. *See* Pet. App. 57a.

The PTO engages in quintessentially regulatory activity when it reviews applications to determine if a mark is distinctive and not misleading. The fact that the registration process ends with a piece of government paper no more "relax[es]" (Pet. 15) the First Amendment "than when the government issues permits for street parades, copyright registration certificates, or, for that matter, grants medical, hunting, fishing, or drivers licenses, or records property titles, birth certificates, or articles of incorporation." Pet. App. 47a; *cf. Cleveland v. United States*, 531 U.S. 12, 20-22 (2000) (system of issuing patents is purely "regulatory").

In short, because the trademark registration scheme is regulatory and indistinguishable from the patent, copyright, and other registration schemes, this case is easy: no "doctrinal 'box'" permits Congress to condition trademark registration on a mark owner's refusal to change a name that the government finds odious.

B. The Team's Case Is A Better Vehicle

At a minimum, the Court should not grant review in this case without also granting review in the Team's case. As explained in the Team's pending petition, the Team's case is an essential complement to this case because it involves the cancellation context (as opposed to the application context of *Tam*). Pet. 13-16 (No. 15-1311). Section 2(a) applies in only two contexts: initial application for registration and cancellation of registration. *Tam* and the Team's case together thus round out the two scenarios in which § 2(a) applies. It therefore makes sense jurisprudentially to consider the cases together. And it makes no sense to consider § 2(a) only in the context of the initial refusal to register THE SLANTS when the First Amendment analysis is much bleaker for the government in the cancellation context, both in terms of the harms to speech and chilling effect, and the government's lack of any apparent interest in disassociation from marks that may no longer offend the referenced group. *Id.* at 14-15. In addition, the Team's case presents related constitutional questions as well as a narrowing construction of § 2(a). *Id.* at 16-25. The Court should have these issues before it when considering the First Amendment challenge to § 2(a).

The Court could consider the cases together through two possible avenues. First, if the Court grants certiorari in this case now, the Court should grant certiorari before judgment in the Team's case.

Alternatively, the Court should hold the government's petition in this case until after the Fourth Circuit resolves the Team's appeal. The Team will seek this Court's review if the Fourth Circuit affirms the district court's decision, and the government presumably will do the same if the Team prevails in the Fourth Circuit. The Court then could hear this case and the Team's case together.

C. There Is No Urgent Need To Grant The Petition Here Before The Fourth Circuit Rules

1. The government urges this Court not to wait for the Fourth Circuit's decision, reasoning that because the Team's case "involves other statutory and evidentiary challenges to the agency's decision, the court of appeals may decide the case without reaching the constitutional question." Pet. 23 n.8. The government has it backwards.

Three of the Team's "other" arguments are arguments that this Court should consider together with the First Amendment question raised by the government's petition. In addition to the Team's First Amendment challenge in the Fourth Circuit, the Team argues that § 2(a) is impermissibly vague, that the government's delay in cancelling the Team's decades-old registrations violates due process, and that § 2(a) does not apply to disparagement of groups such as Native (or Asian) Americans. The possibility that the Fourth Circuit might resolve the Team's appeal on one of these three grounds supports waiting for the Fourth Circuit to rule—not granting review in this case to decide the First Amendment issue alone.

To be sure, the Team also argues that the evidence did not support summary judgment against the Team

on the question whether the term Redskins was disparaging when registered, and that laches barred the petition to cancel the Team's registrations. But the possibility that the Fourth Circuit might rule in the Team's favor on one of these two grounds does not warrant hearing this case alone now. If the Court holds the government's petition in this case, the Court could simply grant that petition alone after the Fourth Circuit's decision.

2. The government argues that this Court's review is needed because preventing registration of offensive, racist, misogynistic, bigoted, immoral, or scandalous "terms and imagery" is a "longstanding and important part of the federal trademark-registration system." Pet. 16, 21-23. That argument is hard to accept at face value. The countless offensive marks that the PTO has already registered—many within the last twelve months—suggests that the government's interest is, at best, vastly overstated.

Just by way of example, the PTO refused to register THE SLANTS because the PTO found the term disparaging to Asian Americans in the context of an all-Asian American rock band. But the PTO has already registered WHITE TRASH COWBOYS and OFF-WHITE TRASH for two all-white rock bands, and registered N.W.A.—an acronym that includes a racial slur against African Americans—for an all-African American rap group. And since rejecting THE SLANTS, the PTO registered REFORMED WHORES for an all-woman country western comedy band. Unless the PTO thought that the descriptors whores, white trash, and N.W.A. flatter the referenced groups, the government is not rigorously enforcing § 2(a) to protect women, Caucasians, and African Americans. Yet the PTO did not hesitate to register these marks.

The examples do not end with musical groups. The PTO has registered DANGEROUS NEGRO, BAKED BY A NEGRO, CELEBRETARDS, RETARDIPEDIA, YELLOWMAN, RED MAN, STINKY GRINGO, GRINGO STYLE SALSA, GRINGO BBQ, YID DISH, LITTLE INDIAN GIVER, MIDGET-MAN, CRIPPLED OLD BIKER BASTARDS, OL GEEZER, WHITE GIRL WITH A BOOTY, OH! MY NAPPY HAIR, NAPPY ROOTS, BOYS ARE STUPID THROW ROCKS AT THEM, WHITE TRASH REBEL, DAGO SWAGG, REDNECK ARMY, CRACKA AZZ SKATEBOARDS, and DUMB BLONDE (twice), with no apparent regard to whether such marks may disparage women, men, racial groups, religious groups, elderly people, and disabled people. The government's concern for offensiveness likewise is not apparent from the PTO's routine registration of pornographers' marks and other lewd, graphic, and sexually explicit marks and images, including many with overt racial references and vulgar female nudity. *See, e.g.*, Team CA4 Br. 4, 24 & n.4; Team CA4 Reply 10 & n.1.

Equally dubious is the government's representation that § 2(a)'s disparagement clause "has guided the PTO's decisions for 70 years." Pet. 8. "There were few marks rejected under the disparagement provision following enactment of the Lanham Act." Pet. App. 7a. Indeed, in the fifty years following passage of the clause, we know of only four reported cases. Pet. 22 (citing Pet. App. 7a-8a). Moreover, the registered logos for AUNT JEMIMA, UNCLE BEN'S, and CREAM OF WHEAT are some of the oldest but most controversial trademarks in American history touching on race. The government registered these marks without regard to whether they may have disparaged African Americans, even though the marks were associated with slavery from their inception. *See, e.g.*, M. Kern-Foxworth, *Aunt Jemima, Uncle Ben, and Rastus:*

Blacks in Advertising, Yesterday, Today, and Tomorrow (1994).

In the Fourth Circuit, the government argues that its failure to enforce § 2(a) against such marks does not render the statute invalid. U.S. CA4 Br. 41. But the government's haphazard and seemingly incoherent enforcement vividly illustrates § 2(a)'s vagueness. And under the First Amendment, "[t]he agency's practice" cannot be "squarely at odds with the governmental interests asserted." *Greater New Orleans Broad. Ass'n, Inc. v. United States*, 527 U.S. 173, 191 (1999). The "inconsistencies" that permeate the Principal Register decisively undermine the notion that the government has an interest (much less a weighty one) in preventing registration of disparaging, immoral, or scandalous marks. *Id.* at 190.

In any event, the government's record of enforcing § 2(a) only sporadically—and even then wildly inconsistently (*infra* pp. 13-14)—shows that there is no urgent need for this Court to hear this case now. Again, the above marks are only a small sample. And as far as we are aware, the government has taken no steps to cancel any of the registrations discussed above and has no plans to do so. Indeed, the government sat idly by for decades with the REDSKINS registration. The government's utter passivity refutes any notion that the government's interest in keeping its "Principal Register" clean is either "longstanding" or "important." Pet. 22. The Court should not credit that unfounded assertion by the government. The government will suffer no harm if the Court holds its petition pending the Fourth Circuit's resolution of the Team's appeal.

II. ALTERNATIVELY, THE COURT SHOULD DIRECT THE PARTIES TO ADDRESS WHETHER § 2(a) IS IMPERMISSIBLY VAGUE AND WHETHER § 2(a) APPLIES TO GROUPS

If the Court chooses to hear this case now without also hearing the Team's case, the Court should direct the parties here to address the additional questions of whether § 2(a) is impermissibly vague and whether § 2(a) applies only to identifiable persons, not to groups as a whole.

A. This Court Should Direct The Parties To Brief Whether § 2(a) Is Impermissibly Vague

As set forth in the Team's petition, this Court should not consider the First Amendment question in this case without the interrelated question of whether § 2(a)'s disparagement clause is unconstitutionally vague. Pet. 16-20 (No. 15-1311).

This Court routinely considers First Amendment and vagueness challenges together. *See id.* at 16 (citing *FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2320 (2012); *Holder v. Humanitarian Law Project*, 561 U.S. 1, 8 (2010)). And here, the vagueness challenge to § 2(a) is at least as strong as the First Amendment challenge. The term "disparage" and the test the PTO applies to determine disparagement are hopelessly subjective, leading the PTO often to treat identical terms differently. Pet. 17-18 (No. 15-1311). The Team's petition listed six startling examples. *Id.* at 18.

But more exist. Just days after the government filed this petition, the PTO offered to register STOP ISLAMIZATION OF AMERICA and has since published the mark in the PTO's Official Gazette, even though

the PTO in 2010 refused to register STOP THE ISLAMISATION OF AMERICA because the PTO deemed the mark disparaging to Muslims under § 2(a). *See* PTO, Official Gazette Publication Confirmation, U.S. Serial No. 86857969, http://goo.gl/RlJNCB. It is hard to fathom how the PTO could have missed the blatant inconsistency. The earlier denial was challenged and became the subject of a decision by the Federal Circuit in *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014), a decision cited repeatedly in this very case. Pet. App. 7a, 8a, 9a, 21a, 25a, 33a n.6.

And there is even more. The PTO deems THE SLANTS disparaging to Asian Americans, Pet. App. 163a, and THE REDSKINS disparaging to Native Americans, Pet. App. 93a (No. 15-1311). But the PTO has registered YELLOWMAN and RED MAN, even though these marks unquestionably refer to Asian Americans and Native Americans. *See* http://www.yellowman.com/c/ABOUT/About+YellowMan.html; http://www.swedishmatch.com/en/Media/Articles/Red-Man--the-flagship-of-chewing-tobacco. And the PTO has offered comical explanations for why it concluded that BLACK TAIL does not disparage African-American women in the context of an adult entertainment magazine, *Boswell v. Mavety Media Grp. Ltd.*, 1999 WL 1040108, at *8-9 (T.T.A.B. 1999), that JAP does not disparage Japanese Americans, *In re Condas S.A.*, 1975 WL 20869, at *1 (T.T.A.B. 1975), and that MOONIES does not disparage members of The Unification Church, *In re Over Our Heads Inc.*, 1990 WL 354546, at *1 (T.T.A.B. 1990).

Furthermore, anyone who claims to be disparaged or offended by a mark can object to the PTO's registration of the mark or can seek cancellation of the registration at any time in the future, including

decades after the fact, as occurred with the Team's 1967 registration. 15 U.S.C. § 1064; PTO, *Trademark Trial and Appeal Board Manual of Procedure* § 309.03(b) (June 2015). Delegating enforcement discretion to the whim of 300 million citizens renders § 2(a) even more arbitrary, unpredictable, and discriminatory. As the government has told this Court, "to arm millions of private citizens with such potent relief . . . unacceptably chills speech." Brief for United States at 25, *Nike, Inc. v. Kasky*, No. 02-575 (U.S. Feb. 28, 2003).

The Court may well want to resolve § 2(a)'s constitutionality on the basis of vagueness rather than the First Amendment. If the parties brief only the First Amendment question, however, the Court would not have the benefit of briefing by the parties and interested *amici* on the vagueness question. And even were the Court to uphold § 2(a) under the First Amendment, a court of appeals likely would strike it down as impermissibly vague. The en banc Federal Circuit strongly suggested that § 2(a) is impermissibly vague, Pet. App. 32a-34a & nn.6-8, and two judges would have so held, *id.* at 68 (O'Malley, J., concurring, joined by Wallach, J.). It would be wasteful for this Court to consider the First Amendment and vagueness questions seriatim. If the Court grants the petition here alone, the Court should direct the parties to brief whether § 2(a)'s disparagement clause is unconstitutionally vague.

B. The Court Should Direct The Parties To Brief Whether § 2(a) Applies Only To Identifiable Persons And Not To Groups

In the Fourth Circuit, the Team vigorously advances a narrowing construction of § 2(a) that would avoid any constitutional question. Read naturally, § 2(a)'s

prohibition on disparagement of "persons, living or dead," 15 U.S.C. § 1052(a), refers only to identifiable individuals or juristic persons—not groups as a whole, like racial and ethnic groups. Indeed, the necessary implication of the government's contrary view is that § 2(a) prevents disparagement of all groups, including not only billionaires and politicians but also racists and misogynists.

The Court should not decide a constitutional issue "if there is some other ground upon which to dispose of the case." *Bond v. United States*, 134 S. Ct. 2077, 2087 (2014) (quotation marks omitted). Courts must adopt interpretations avoiding constitutional doubt absent a "clear and unambiguous" contrary interpretation. *I.N.S. v. St. Cyr*, 533 U.S. 289, 305 (2001). Stated differently, this Court will narrowly construe a statute to avoid a constitutional issue as long as the interpretation is "fairly possible." *Almendarez-Torres v. United States*, 523 U.S. 224, 237 (1998). For the reasons stated in the Team's petition, the Team's reading of § 2(a) is the most natural, and at a minimum it is "fairly possible." Pet. 24-25 (No. 15-1311).

In this case, neither the parties nor the Federal Circuit addressed this narrowing construction, and the government's petition does not mention it. But the doctrine of constitutional avoidance counsels that this Court should decide whether § 2(a) applies to groups as a whole, regardless of whether it was raised below. *See Rosenberg v. Fleuti*, 374 U.S. 449, 451 (1963); *Neese v. S. Ry. Co.*, 350 U.S. 77, 78, (1955). This Court accordingly should not consider respondent's First Amendment challenge to § 2(a) without directing the parties to brief this narrowing construction.

The third question presented in the Team's petition—whether the government's decades-long delay between

registering a trademark and cancelling the registration under § 2(a)'s disparagement clause violates due process—is equally worthy of this Court's attention. For the reasons explained in the Team's petition, the answer to that question has important implications for the First Amendment analysis. Pet. 21-24 (No. 15-1311). But that question is not presented in this case, and, accordingly, it would not be possible to direct the parties to brief it here. That is yet another reason why this case is an inferior vehicle for considering the constitutionality of § 2(a).

CONCLUSION

Unless the Court grants the Team's petition for a writ of certiorari before judgment, the government's petition in this case should be denied or held pending the Fourth Circuit's resolution of the Team's appeal. Alternatively, if the Court grants the government's petition alone, the Court should direct the parties to address the additional questions of whether § 2(a) is unconstitutionally vague and whether § 2(a) applies only to identifiable persons and not to groups.

Respectfully submitted,

ROBERT L. RASKOPF
TODD ANTEN
JESSICA A. ROSE
QUINN EMANUEL URQUHART & SULLIVAN, LLP
51 Madison Ave.,
22nd Floor
New York, NY 10010
(212) 849-7000
robertraskopf@quinnemanuel.com

LISA S. BLATT
Counsel of Record
ROBERT A. GARRETT
R. STANTON JONES
ELISABETH S. THEODORE
ARNOLD & PORTER LLP
601 Massachusetts Ave. NW
Washington, DC 20001
(202) 942-5000
lisa.blatt@aporter.com

Counsel for Amicus Curiae

RECORD AND BRIEFS

Supreme Court, U.S.
FILED
NOV 9 - 2016
OFFICE OF THE CLERK

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

SIMON SHIAO TAM

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

JOINT APPENDIX

IAN HEATH GERSHENGORN
Acting Solicitor General
Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217

Counsel of Record
for Petitioner

JOHN C. CONNELL
Archer & Greiner, P.C.
One Centennial Square,
P.O. Box 3000
Haddonfield, NJ 08033
jconnell@archerlaw.com
(856) 795-2121

Counsel of Record
for Respondent

PETITION FOR A WRIT OF CERTIORARI FILED: APR. 20, 2016
CERTIORARI GRANTED: SEPT. 29, 2016

TABLE OF CONTENTS

Page

Court of appeals docket entries 1

Trademark/Service Mark Application, Principal Register, Serial Number: 85472044 (Nov. 14, 2011) 12

U.S. Patent and Trademark Office (USPTO) Office Action (Official Letter) About Applicant's Trademark Application (Jan. 6, 2012) 25

U.S. Patent and Trademark Office (USPTO) Office Action (Official Letter) About Applicant's Trademark Application (June 20, 2012) 33

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Docket No. 14-1203

IN RE: TAM

SIMON SHIAO TAM, APPELLANT

v.

MICHELLE K. LEE, DIRECTOR, U.S.
PATENT AND TRADEMARK OFFICE, APPELLEE

DOCKET ENTRIES

DATE	DOCKET NUMBER	PROCEEDINGS
1/7/14	1	Appeal docketed. Date received: 01/02/2014. [127523] Entry of Appearance due 01/21/2014. Certificate of Interest is due on 01/21/2014. Docketing Statement due 02/06/2014. Appellant/Petitioner's brief is due 03/10/2014.
		* * * * *
1/23/14	20	Certificate of Interest for the Appellant Simon Shiao Tam. Service: 01/23/2014 by email. [131094]
1/23/14	21	Docketing Statement for the Appellant Simon Shiao Tam. Service: 01/23/2014 by email. [131095]

DATE	DOCKET NUMBER	PROCEEDINGS
		* * * * *
2/6/14	24	Docketing Statement for the Appellee Lee. Service: 02/06/2014 by US mail, email. [134255]
		* * * * *
4/21/14	28	BRIEF FILED for Appellant Simon Shiao Tam [27]. Title: Brief on Behalf of Appellant, [Non-Confidential version only]. Number of Pages: 57. Service: 04/21/2014 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 04/28/2014. Appellee Michelle K. Lee, Deputy Director, U.S. Patent and Trademark Office brief is due 06/05/2014. [149556]
		* * * * *
8/4/14	36	BRIEF FILED for Appellee Lee [35]. Title: OPENING BRIEF. Number of Pages: 40. Service: 08/04/2014 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 08/11/2014. Appellant Simon Shiao Tam reply brief is due 08/21/2014. [172949]

DATE	DOCKET NUMBER	PROCEEDINGS
		* * * * *
9/23/14	43	BRIEF FILED for Appellant Simon Shiao Tam [42]. Title: REPLY BRIEF. Number of Pages: 28. Service: 09/23/2014 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 09/29/2014. Appendix is due 10/03/2014. [185043]
		* * * * *
10/1/14	46	APPENDIX FILED for Simon Shiao Tam [45]. Title: JOINT APPENDIX. Number of Pages: 352. Service: 10/01/2014 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 10/07/2014. [187116]
		* * * * *
1/9/15	51	Submitted after ORAL ARGUMENT by Ronald D. Coleman, Esq. for Simon Shiao Tam and Ms. Molly R. Silfen for Lee. Panel: Judge: Lourie, Judge: Moore, Judge: O'Malley. [208419]
		* * * * *

DATE	DOCKET NUMBER	PROCEEDINGS
4/20/15	53	OPINION and JUDGMENT filed. The judgment or decision is: Affirmed. (Precedential Opinion). (For the Court: Lourie, Circuit Judge; Moore, Circuit Judge and O'Malley, Circuit Judge). Moore, Circuit Judge, additional views. [234068] Vacated pursuant to the court's order. See Doc No. [54]
4/27/15	54	PRECEDENTIAL ORDER filed vacating the opinion Precedential Opinion [53]; reopening appeal; additional briefing ordered Appellant/ Petitioner's brief is due 06/11/2015; en banc rehearing. By: En Banc (Per Curiam). Service as of this date by Clerk of Court. [235778]
		* * * * *
6/11/15	65	BRIEF FILED for Appellant Simon Shiao Tam [64]. Number of Pages: 30. Service: 06/11/2015 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/17/2015. Appellee Michelle K. Lee, Director, U.S. Patent and Trademark Office brief is due 07/16/2015. [247711]
		* * * * *

DATE	DOCKET NUMBER	PROCEEDINGS
6/18/15	93	AMICUS BRIEF FILED for International Trademark Association [70]. Number of Pages: 23. Service: 06/18/2015 by email. Pursuant to ECF-10, filer is directed to file six copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/24/2015. [249867]
6/18/15	94	AMICUS BRIEF FILED for Public Knowledge [78]. Number of Pages: 20. Service: 06/18/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/24/2015. [249884]
6/18/15	96	AMICUS BRIEF FILED for Pro-Football, Inc. [79]. Number of Pages: 35. Service: 06/18/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/24/2015. [249906]

DATE	DOCKET NUMBER	PROCEEDINGS
6/18/15	106	AMICUS BRIEF FILED for Cato Institite and The Rutherford Institute [89]. Number of Pages: 31. Service: 06/18/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/29/2015. [250399]
6/18/15	107	AMICUS BRIEF FILED for First Amendment Lawyers Association [90]. Number of Pages: 15. Service: 06/18/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 06/29/2015. [250408]
		* * * * *
6/18/15	120	AMICUS BRIEF FILED for Hugh C. Hansen [117]. Number of Pages: 16. Service: 06/18/2015 by US mail. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. [250883] This brief has been corrected. See Doc No. [123]
		* * * * *
6/22/15	105	ORDER filed scheduling oral argument. Oral argument en banc for

DATE	DOCKET NUMBER	PROCEEDINGS
		this appeal is scheduled for October 2, 2015 at 10:00 a.m. in courtroom 201. This appeal will have 30 minutes per side for a total argument time of one hour. By: En Banc (Per Curiam). Service as of this date by Clerk of Court. [250265]
		* * * * *
6/23/15	123	CORRECTED AMICUS BRIEF FILED for Hugh C. Hansen [122]. Number of Pages: 16. Service: 06/23/2015 by US mail. [251264]
		* * * * *
7/16/15	128	BRIEF FILED for Appellee Lee [127]. Number of Pages: 46. Service: 07/16/2015 by email. Pursuant to ECF-10, filer is directed to file an original and thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 07/22/2015. Appellant Simon Shiao Tam reply brief is due 08/04/2015. [257227]
		* * * * *
7/23/15	138	AMICUS BRIEF FILED for Richard L. Stanley [134]. Number of Pages: 29. Service: 07/23/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper

DATE	DOCKET NUMBER	PROCEEDINGS
		copies of the brief should be received by the court on or before 07/29/2015. [259193]
7/23/15	140	AMICUS BRIEF FILED for Fred T. Korematsu Center for Law and Equality, National Asian Pacific American Bar Association and South Asian Bar Association of Washington, D.C. [137]. Number of Pages: 24. Service: 07/23/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 07/29/2015. [259206]
7/23/15	148	AMICUS BRIEF FILED for Amanda Blackhorse, Marcus Briggs-Cloud, Phillip Gover, Jillian Pappan and Courtney Tsotigh [132]. Number of Pages: 30. Service: 07/23/2015 by email. [259473]
		* * * * *
8/4/15	150	REPLY BRIEF FILED for Appellant Simon Shiao Tam [149]. Number of Pages: 20. Service: 08/04/2015 by email. Pursuant to ECF-10, filer is directed to file thirty copies of the brief in paper format. The paper copies of the brief should be received by the court on or before 08/10/2015. [262085]

DATE	DOCKET NUMBER	PROCEEDINGS
		* * * * *
8/24/15	153	CORRECTED ENTRY: AMICUS BRIEF FILED for American Civil Liberties Union of Oregon, American Civil Liberties Unition of the Nations's Capital, and ACLU [152]. Pages: 28. Pursuant to ECF-10(D), the filer is directed to submit the approriate number of copies within two days. [266313]—[Edited 09/03/2015 by clerk to correct pdf]
		* * * * *
9/4/15	162	Citation of Supplemental Authority pursuant to Fed. R. App. P. 28(j) for Amicus Curiae Pro-Football, Inc.. Service: 09/04/2015 by email. [269883]
		* * * * *
10/2/15	168	Submitted after ORAL ARGUMENT by Lee Rowland for ACLU, ACLU-NCA and American Civil Liberties Union of Oregon, Ronald D. Coleman, Esq. for Simon Shiao Tam and Daniel Tenny for Lee. Panel: Judge: Prost, Judge: Newman, Judge: Lourie, Judge: Dyk, Judge: Moore, Judge: O'Malley, Judge: Reyna, Judge: Wallach, Judge: Taranto, Judge: Chen,

DATE	DOCKET NUMBER	PROCEEDINGS
		Judge: Hughes, Judge: Stoll. [277118]
12/22/15	169	OPINION and JUDGMENT filed. The judgment or decision is: Vacated and Remanded. (Precedential Opinion). (For the Court: Prost, Chief Judge; Newman, Circuit Judge; Lourie, Circuit Judge; Dyk, Circuit Judge; Moore, Circuit Judge; O'Malley, Circuit Judge; Reyna, Circuit Judge; Wallach, Circuit Judge; Taranto, Circuit Judge; Chen, Circuit Judge; Hughes, Circuit Judge and Stoll, Circuit Judge). Concurring opinion filed by Circuit Judge OMalley, in which Circuit Judge Wallach joins. Opinion concurring in part and dissenting in part filed by Circuit Judge Dyk, in which Circuit Judges Lourie and Reyna join with respect to parts I, II, III, and IV. Dissenting opinion filed by Circuit Judge Lourie. Dissenting opinion filed by Circuit Judge Reyna. [298033]
2/11/16	170	ERRATA to the Precedential Opinion Doc No. [169]. Service as of this date by Clerk of Court. [310201]

DATE	DOCKET NUMBER	PROCEEDINGS
2/12/16	171	Mandate issued to the United States Patent and Trademark Office. Service as of this date by Clerk of Court. [310624]
		* * * * *
4/21/16	173	Petition for writ of Certiorari filed on 04/20/2016 in the Supreme Court of the United States. Supreme Court #: 15-1293, Michelle K. Lee v. Simon Shiao Tam. [328533]
9/29/16	174	The petition for writ of certiorari, [15-1293], filed on 04/20/2016, was Granted on 09/29/2016. [370288]

PTO Form 1478 (Rev 9/2010)
OMB No. 0651-0009 (Exp 12/31/2011)

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 85472044

Filing Date: 11/14/2011

NOTE: Data fields with the * are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.

The table below presents the data as entered.

Input Field	Entered
TEAS Plus	**YES**
MARK INFORMATION	
***MARK**	THE SLANTS
***STANDARD CHARACTERS**	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	THE SLANTS
***MARK STATEMENT**	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	

***OWNER OF MARK**	Tam, Simon Shiao
***STREET**	**[REDACTED]**
***CITY**	**[REDACTED]**
***STATE (Required for U.S. applicants)**	**[REDACTED]**
***COUNTRY**	United States
***ZIP/POSTAL CODE (Required for U.S. applicants only)**	**[REDACTED]**
PHONE	**[REDACTED]**
LEGAL ENTITY INFORMATION	
***TYPE**	INDIVIDUAL
***COUNTRY OF CITIZENSHIP**	United States
GOODS AND/OR SERVICES AND BASIS INFORMATION	
***INTERNATIONAL CLASS**	041
IDENTIFICATION	Entertainment in the nature of live performances by **a musical band**
***FILING BASIS**	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 11/15/2006
FIRST USE IN COMMERCE DATE	At least as early as 11/15/2006
SPECIMEN FILE	\\TICRS\EXPORT11\IMAGEOUT11\854\720\85472044\

NAME(S)	xm11\FTK0003.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\854\720\85472044\xm11\FTK0004.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\854\720\85472044\xm11\FTK0005.JPG
SPECIMEN DESCRIPTION	Flyers advertising performances
ADDITIONAL STATEMENTS INFORMATION	
*TRANSLATION (if applicable)	
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	
*CONSENT (NAME/LIKENESS) (if applicable)	
*CONCURRENT USE CLAIM (if applicable)	
ATTORNEY INFORMATION	
NAME	Ronald Coleman
FIRM NAME	GOETZ FITZPATRICK LLP
INTERNAL ADDRESS	1 Penn Plaza
STREET	Suite 4401

CITY	New York
STATE	New York
COUNTRY	United States
ZIP/POSTAL CODE	10119
PHONE	2126958100
EMAIL ADDRESS	rcoleman@goetzfitz.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
CORRESPONDENCE INFORMATION	
***NAME**	Ronald Coleman
FIRM NAME	GOETZ FITZPATRICK LLP
INTERNAL ADDRESS	1 Penn Plaza
***STREET**	Suite 4401
***CITY**	New York
***STATE (Required for U.S. applicants)**	New York
***COUNTRY**	United States
***ZIP/POSTAL CODE**	10119
PHONE	2126958100
***EMAIL ADDRESS**	rcoleman@goetzfitz.com
***AUTHORIZED TO COMMUNICATE VIA EMAIL**	Yes
FEE INFORMATION	

NUMBER OF CLASSES	1
FEE PER CLASS	275
***TOTAL FEE PAID**	275
SIGNATURE INFORMATION	
***SIGNATURE**	/Simon Shiao Tam/
***SIGNATORY'S NAME**	Simon Shiao Tam
***SIGNATORY'S POSITION**	Owner
***DATE SIGNED**	11/14/2011

PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 12/31/2011)

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 85472044
Filing Date: 11/14/2011

To the Commissioner for Trademarks:

MARK: THE SLANTS (Standard Characters, see mark)

The literal element of the mark consists of THE SLANTS.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Simon Shiao Tam, a citizen of United States, having an address of

[REDACTED]

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 041: Entertainment in the nature of live performances by a musical band

In International Class 041, the mark was first used at least as early as 11/15/2006, and first used in commerce at least as early as 11/15/2006, and is now in use in such commerce. The applicant is submitting one specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Flyers advertising performances.

Specimen File1
Specimen File2
Specimen File3

The applicant's current Attorney Information:

Ronald Coleman of GOETZ FITZPATRICK LLP

1 Penn Plaza
Suite 4401
New York, New York 10119
United States

The applicant's current Correspondence Information:

Ronald Coleman
GOETZ FITZPATRICK LLP
1 Penn Plaza
Suite 4401
New York, New York 10119
2126958100(phone)
rcoleman@goetzfitz.com (authorized)

A fee payment in the amount of $275 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable

by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /Simon Shiao Tam/
Date Signed: 11/14/2011
Signatory's Name: Simon Shiao Tam
Signatory's Position: Owner

RAM Sale Number: 4120
RAM Accounting Date: 11/15/2011

Serial Number: 85472044
Internet Transmission Date: Mon Nov 14 16:48:48 EST 2011
TEAS Stamp:
USPTO/FTK-66.251.23.10-20111114164848549373-85472044-4808b9c85f3636e2c33bf8b705e545ba2b7-CC-4120-20111114153506454362

20

THE SLANTS

THE SUNSET PRESENTS SUNDAY BLOODY SUNSET
WITH
THE SUNSET
SEATTLE
SUNDAY MARCH 1ST - 4PM

THE VAGUE PROPHETS

THE SLANTS

THE SUBTERRANEAN HOWL

SUNDAY MAY 24TH 7:00

HIGH DIVE

BURNSIDE
SXSW SHOWCASE
SUBMERGED
WEDNESDAY MARCH 18TH
333 E. SECOND ST.
AT TRINITY
STARRING:
JACKIE BRITTON 8 PM
THE SUMMER WARDROBE 9 PM
THE SERVICE INDUSTRY 10 PM
SWEET WATER 11 PM
BLIND PILOT 12 AM
THE SLANTS 1 AM
SXSW '09
MUSIC
R
www.bddistribution.com
BD

THE SLANTS

Attachment – 159
Attachment – 160
Attachment – 161
Attachment – 162

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85472044

MARK: THE SLANTS

85472044

CORRESPONDENT ADDRESS:
RONALD COLEMAN
GOETZ FITZPATRICK LLP
1 PENN PLZ STE 4401
NEW YORK, NY 10119-0196

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Tam, Simon Shiao

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A

CORRESPONDENT E-MAIL ADDRESS:
rcoleman@goetzfitz.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE

TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 1/6/2012

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. § 1062(b); 37 C.F.R. §§ 2.62(a), 2.65(a); TMEP §§ 711, 718.03.

SEARCH OF OFFICE'S DATABASE OF MARKS

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP § 704.02; *see* 15 U.S.C. § 1052(d).

SECTION 2(A)—MARK IS DISPARAGING

Registration is refused because the applied-for mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols. Trademark Act Section 2(a), 15 U.S.C. § 1052(a); *see In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1267-79 (TTAB 2006); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1740-48 (TTAB 1999), *rev'd*, 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003) (finding "no error in the TTAB's articulation of [the Section 2(a)] test for disparagement"), *remanded on other grounds*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *and aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); TMEP §§ 1203.03, 1203.03(c).

The following two factors must be considered when determining whether matter may be disparaging under Trademark Act Section 2(a):

> (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods and/or services, and the manner in which the mark is used in the marketplace in connection with the goods and/or services; and
>
> (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

In re Squaw Valley Dev., 80 USPQ2d at 1267 (citing *Harjo*, 50 USPQ2d at 1740-41); TMEP § 1203.03(c).

To "disparage" means "to speak slighting[ly] of: run down: depreciate." *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1276 (TTAB 2006) (internal punctuation omitted) (quoting *Webster's Third New International Dictionary* (unabridged ed. 1993)). The determination of whether a mark is disparaging depends upon the perspective of the object of disparagement. *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1217 (TTAB 2010); *see also* TMEP § 1203.03(c). A mark may be disparaging in two ways:

> (1) Matter that is not, in and of itself, disgusting or otherwise unpleasant, may be applied or combined in such a way that it is offensive to the disparaged party. See, e.g., In re Anti-Communist World Freedom Cong., Inc., 161 USPQ 304, 305 (TTAB 1969) (holding design of an "X" superim-

posed over a hammer and sickle to disparage, and to bring into contempt and disrepute, a national symbol of the U.S.S.R.).; or

(2) Matter may be inherently offensive, and, when directed at a specific individual or entity, may become even more offensive. See, e.g., Greyhound Corp. v. Both Worlds Inc., 6 USPQ2d 1635, 1640 (TTAB 1988) (noting "the offensiveness of [applicant's mark, depicting a defecating dog,] becomes even more objectionable because it makes a statement about opposer itself").

The attached evidence shows the likely meaning of "THE SLANTS" to be a negative term regarding the shape of the eyes of certain persons of Asian descent. *See* attached definitions of "Slant". This refers to "persons of Asian descent" in a disparaging manner because it is an inherently offensive term that has a long history of being used to deride and mock a physical feature of those individuals. *See* Online Etymology Dictionary, Mother Chronicles, "Slant Eyes, Almond Eyes, What's in those Chinese Eyes?".

The term "slants" and the full equivalent "slant-eyes" has long been a derogatory term directed towards those of Asian descent. The etymology of the term suggests that its use became prevalent during the various wars of the 20 century, starting with World War II and increasing in use in the Vietnam war as a term to deride and mock the citizens of the countries at war with the United States and those of Asian descent in general. *See* The Color of Words: An Encyclopaedic Dictionary of Ethnic Bias in the United States.

Since that time, the research of the Office indicates that the term "slants" retains it's offensive and derogatory meaning. Importantly, the oldest and largest Asian American civil rights organization in the United States, the Japanese American Citizens League (JACL), has uissued a publication on hate speech that specially states that the term "slant" is derogatory and should not be used. *See* attached webpage excerpt and literature on hate speech from JACL. Moreover, numerous dictionaries define "slants" or "slant-eyes" as a derogatory or offensive term. *See* attached definitions from, among others, Oxford Dictionary of Modern Slang, American Heritage Dictionary, Online Etymology Dictionary, New Partridge Dictionary of Slang and Unconventional English, The Color of Words: An Encyclopedic Dictionary of Ethnic Bias in the United States, American English Compendium, and Urbandictionary.com. Further, many listings of slang and offensive terms include the word "slants" and its derivatives such as slant-eyes, slanted-eyes, and the pictoral representation as a slur or derogatory. *See* listing of racial slurs from Wikipedia.org, http://gyral.blackshell.com/names.html, http://www.asianjoke.com/others/ethnic_slurs.htm, and www.fact-index.com/list_of_ethnic_slurs.html.

More specifically, the band's name has been found offensive numerous times. First, a band performance and a speaking engagement for the lead singer were cancelled because there had been concerns raised over the name of his band. *See* The Daily Swarn, "Oregon Governor Cancels Asian Band the Slants' Performance at Asian Youth Conference." Second, articles on the band have noted that the name has been controversial and that the band chose the name, in part due to the

history of the term. *See* Northwest Asian Weekly, "Rock band to trademark Office: Our Name is Not Disparaging to Asians", "Shuffled! The Slants". Further, several bloggers and commenters to articles on the band have indicated that they find the term and the applied-for mark offensive, even after extensive dialogue with the applicant. *See* attached blogs and article comments, including BigWOWO and Ben Efsaneyim.

Applicant may have chosen the applied-for mark to be self-deprecating and to attempt tp reappropriate the disparaging term. The lack of a disparaging intent is not dispositive on the issue of Section 2(a) disparagement in the Federal registration analysis. The intent of an applicant to disparage the referenced group is not necessary to find that the mark does, in fact, disparage that group. *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1220 (TTAB 2010); *see also In re Anti-Communist World Freedom Cong., Inc.*, 161 USPQ 304, 305 (TTAB 1969) (finding applicant's intent to disparage the referenced group immaterial to the disparagement determination). Further, while applicant may not find the term offensive, applicant does not speak for the entire community of persons of Asian descent and the evidence indicates that there is still a substantial composite of persons who find the term in the applied-for mark offensive.

Please note that the denial of the trademark application does not mean that the applicant must use a different name with its music performances or is otherwise prohibited from using the wording "The Slants" in association with its music. Rather, it is a denial of a federally registered trademark, not the right to use

the words. *See In re Heeb Media LLC*, 89 USPQ2d 1071 (TTAB 2008) (quoting *In re McGinley*, 211 USPQ 668, 672 (CCPA 1981) ("[I]t is clear that the PTO's refusal to register [applicant's] mark does not affect [its] right to use it. No conduct is proscribed. . . . ").

The Office research indicates that the applied-for mark remains disparaging to a substantial composite of Asian-Americans. Accordingly, registration is refused under Section 2(a) as disparaging.

GENERAL INFORMATION

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. § 2.191; TMEP §§ 304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§ 705.02, 709.06.

/Mark Shiner/
Trademark Examining Attorney
Law Office 102
Phone: 571-272-1489
E-mail: mark.shiner@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before

using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at http://tarr.uspto.gov/. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/teas/eTEASpageE.htm.

To: Tam, Simon Shiao (rcoleman@goetzfitz.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85472044 - THE SLANTS - N/A
Sent: 6/20/2012 5:32:17 PM
Sent As: ECOM102@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85472044

MARK: THE SLANTS

85472044

CORRESPONDENT ADDRESS:
RONALD COLEMAN
GOETZ FITZPATRICK LLP
1 PENN PLZ STE 4401
NEW YORK, NY 10119-0196

CLICK HERE TO RESPOND TO THIS LETTER: http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Tam, Simon Shiao

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A

CORRESPONDENT E-MAIL ADDRESS:
rcoleman@goetzfitz.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 6/20/2012

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on May 29, 2012.

By way of background, an Office action was issued on January 6, 2012, refusing registration under Section 2(a) as disparaging. Applicant's response argued against the refusal. Applicant's arguments have been considered and are found unpersuasive.

Accordingly, the refusal under Trademark Act Section 2(a) is now made **FINAL** for the reasons set forth below. *See* 15 U.S.C. § 1052(a); 37 C.F.R. § 2.64(a).

SECTION 2(A)—MARK IS DISPARAGING

The refusal of registration because the applied-for mark consists of or includes matter which may disparage or bring into contempt or disrepute persons, institutions, beliefs or national symbols is maintained and made FINAL. Trademark Act Section 2(a), 15 U.S.C. § 1052(a); *see In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1267-79 (TTAB 2006); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1740-48 (TTAB 1999), *rev'd*, 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003) (finding "no error in the TTAB's articulation of [the Section 2(a)] test for disparagement"), *remanded on other grounds*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), *and aff'd*, 565 F.3d 880,

90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009); TMEP §§ 1203.03, 1203.03(c).

The thrust of applicant's argument is that the application on its face and four-corners, fails to provide a basis for the conclusion that the likely meaning of the mark is disparaging.[1] *See* Applicant's response brief. Applicant's framing of the question and permissible evidence is misplaced. As is plainly stated in *In re Squaw Valley*, the test looks not only at dictionary definitions, any other elements in the mark, and the nature of the goods/services, but also at **the manner in which the mark is used in the marketplace in connection with the goods and/or services.** *In re Squaw Valley Dev.*, 80 USPQ2d at 1267 (citing *Harjo*, 50 USPQ2d at 1740-41); TMEP § 1203.03(c). Thus, a proper consideration of the application is to determine how the mark would be perceived based upon how it is used in the marketplace. To hold otherwise would be to allow the clever construction of an application to avoid a disparaging finding, resulting in expensive

---

[1] Notably, this is not applicant's first time before the United States Patent and Trademark Office seeking registration of the mark THE SLANTS for live musical performances. *See* application under Serial No. 77952263 and selected documents from that file, attached hereto and incorporated by reference. It is worth mentioning that applicant appears to have reversed course on its arguments for registrability, arguing in the prior application that ***because*** the applied-for mark was being used by Asian-Americans as a self-descriptor; it could not be disparaging, while in this case arguing that there is no indication in the application that the mark is in any way associated with Asians or Asian-Americans.

opposition and cancellation proceedings by affected third-parties.[2]

Here, the evidence is uncontested that applicant is a founding member of a band (The Slants) that is self-described as being composed of members of Asian descent. See attachments to first Office action on bands name and makeup (for instance, thelsants.com/about_f.html; www.asianreproter.com/arts/2009/30-slants.htm). Thus, the association of the term SLANTS with those of Asian descent is evidenced by how the applicant uses the mark—as the name of an all Asian-American band. Further, applicant (and his fellow band members) have repeatedly indicated that the name THE SLANTS is in fact a direct reference to the derogatory meaning of the term and in fact, they are embracing the derogatory meaning of the term. One of the members of the band is quoted as stating: "I was trying to think of things that people **associate with Asians**. Obviously, one of the first things people say is that we have slanted eyes. I thought, what a great way to reclaim that stereotype. . . . " *See* Rock Band to Trademark Office: Our Name is Not Disparaging to Asians, NW Asian Weekly (attached to the first Office action). In fact, the evidence shows applicant chose the name THE SLANTS for the band specifically **because** of the Asian connection. *See e.g.*,

---

[2] Applicant's argument that the Office is limited to the four-corners of the application in determining the disparaging nature of the mark is too clever by half. Were applicant's theory correct, any smart applicant (or smart attorney) could easily draft an identification of goods and services that skates around any mention of a group or persons associated with a particular term, while at the same time, using the mark in such a way as to associate the mark with the disparaged group.

A Common Ground for a Controversial Band, THE ASIAN REPORT, attached to first Office action ("**For the band, the name was a way to reclaim a racial slur and to assert Asian pride.**") Thus, the evidence is overwhelming that applicant chose the mark fully aware of the connection to the racial slur. There is no evidence of record to indicate that any meaning other than the offensive meaning is applicable to the instant application.

Applicant's other arguments are equally misplaced. Applicant argues that the dictionaries referenced are not "actual" dictionaries. This statement is incredulous on its face. Specialized dictionaries are no less "actual" dictionaries than generalized dictionaries. In fact, many of the dictionaries and reference materials are published by large scale publishing houses, such as Harper Collins. Further, that applicant cleverly chose specimens that avoided associations with Asians or Asian culture is not evidence that the mark is not used in a way to conjure up the derogatory meaning and to be disparaging to Asians. The evidence attached to the first Office action is overwhelming that the applied-for mark is used in connection with an Asian-American band, performing Chinatown Dance music, and that the name was chosen in clear recognition of the offensive meaning of the term in connection with Asians. *See* attachments to First Office action. Further, the evidence shows that the applied-for mark was chosen expressly because of its association with Asians, perhaps in an attempt to reclaim the term. *See e.g.*, Despite Name, Band Aims for Diverse Dance Rock, THE OREGONIAN ("For our band, we're not just Chinese, we're not just Vietnamese, we're kind of a pan Asian band that celebrates

all the different Asian cultures out there. . . . Everyone in the band really loves the fact that we can try and empower Asian Americans and say, 'you know what? We are slant. Who cares? We're proud of that.'").

The evidence of record shows that the likely meaning of the mark, in light not only of the application, but also the "manner in which the mark is used in the marketplace," is the disparaging term regarding the shape of the eyes of certain persons of Asian descent, and that the term remains disparaging to the Asian and Asian-American communities.

Accordingly, the refusal of registration under Section 2(a) is maintained and made FINAL.

RESPONSE OPTIONS TO FINAL OFFICE ACTION

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. § 1062(b); 37 C.F.R. § 2.65(a). Applicant may respond to this final Office action by:

(1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or

(2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of $100 per class.

37 C.F.R. §§ 2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP § 714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. § 2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. § 2.64(a); TMEP § 714.04; *see* 37 C.F.R. § 2.146(b); TBMP § 1201.05; TMEP § 1704

(explaining petitionable matters). The petition fee is $100. 37 C.F.R. § 2.6(a)(15).

GENERAL INFORMATION

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. § 2.191; TMEP §§ 304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§ 705.02, 709.06.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. § 2.23(a)(1). For a complete list of these documents, see TMEP § 819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. § 2.23(a)(2); TMEP §§ 819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of $50 per international class of goods and/or services. 37 C.F.R. § 2.6(a)(1)(iv); TMEP § 819.04. In appropriate situations and where all issues can be

resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. § 2.23(a)(1). For a complete list of these documents, see TMEP § 819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. § 2.23(a)(2); TMEP §§ 819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of $50 per international class of goods and/or services. 37 C.F.R. § 2.6(a)(l)(iv); TMEP § 819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

/Mark Shiner/
Trademark Examining Attorney
Law Office 102
Phone: 571-272-1489
E-mail: mark.shiner@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about

the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at http://tarr.uspto.gov/. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/teas/eTEASpageE.htm.

RECORD AND BRIEF

Supreme Court, U.S.
FILED
NOV 9 - 2016

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

SIMON SHIAO TAM

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE PETITIONER

IAN HEATH GERSHENGORN
Acting Solicitor General
Counsel of Record
BENJAMIN C. MIZER
Principal Deputy Assistant Attorney General
MALCOLM L. STEWART
Deputy Solicitor General
NICOLE A. SAHARSKY
Assistant to the Solicitor General
DOUGLAS N. LETTER
MARK R. FREEMAN
DANIEL TENNY
JOSHUA M. SALZMAN
Attorneys

Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217

SARAH HARRIS
General Counsel
NATHAN K. KELLEY
Solicitor
THOMAS W. KRAUSE
Deputy Solicitor
CHRISTINA J. HIEBER
THOMAS L. CASAGRANDE
MOLLY R. SILFEN
MARY BETH WALKER
Associate Solicitors
U.S. Patent and Trademark Office
Alexandria, Va. 22313

QUESTION PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a), provides that no trademark shall be refused registration on account of its nature unless, *inter alia*, it "[c]onsists of * * * matter which may disparage * * * persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." The question presented is as follows:

Whether the disparagement provision in 15 U.S.C. 1052(a) is facially invalid under the Free Speech Clause of the First Amendment.

TABLE OF CONTENTS

Page

Opinions below 1
Jurisdiction 1
Constitutional and statutory provisions involved 2
Statement 2
Summary of argument 8
Argument:
The federal statutory prohibition on the registration of disparaging trademarks, 15 U.S.C. 1052(a), is facially constitutional under the First Amendment 13
A. There is a fundamental constitutional distinction between laws that regulate speech and laws that define eligibility for a government program 14
B. Section 1052(a)'s ban on registration of disparaging marks does not restrict speech 20
1. Section 1052(a) establishes criteria for government assistance in identifying the source of goods and services in commerce 20
2. Section 1052(a)'s disparagement provision does not restrict speech 25
3. Ineligibility for a government benefit is not itself a First Amendment burden 28
4. Section 1052(a)'s disparagement provision does not place an unconstitutional condition on mark owners 31
5. Section 1052(a)'s encouragement to use non-disparaging marks does not impermissibly chill speech 34
C. Section 1052 establishes permissible criteria for the federal trademark-registration program 35
1. The federal trademark-registration program, including Section 1052(a)'s ban on registration of disparaging marks, is similar to programs this Court has upheld 35

Table of Contents—Continued: Page

2. Section 1052(a)'s disparagement provision furthers government interests analogous to those implicated in *Walker* 37
3. The court of appeals erred in failing to recognize that this is a government-program case 41
4. Section 1052(a)'s disparagement provision is not a viewpoint-based restriction on speech 43
5. Limiting federal trademark registration to marks that are not disparaging furthers legitimate government interests 48
6. The court of appeals' concern about inconsistent enforcement does not justify facial invalidation of Section 1052(a)'s disparagement provision 50
Conclusion 54
Appendix — Constitutional and statutory provisions 1a

TABLE OF AUTHORITIES

Cases:

Agency for Int'l Dev. v. *Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321 (2013) 11, 31, 32, 33, 34
American Freedom Def. Initiative v. *Massachusetts Bay Transp. Auth.*, 781 F.3d 571 (1st Cir. 2015), cert. denied, 136 S. Ct. 793 (2016) 45, 46
B & B Hardware, Inc. v. *Hargis Indus., Inc.*, 135 S. Ct. 1293 (2015) 2, 3, 20, 35
Boulevard Entm't, Inc., In re, 334 F.3d 1336 (Fed. Cir. 2003) 25, 51
Broadrick v. *Oklahoma*, 413 U.S. 601 (1973) 51
Brunetti, In re, Serial No. 85310960, 2014 WL 3976439 (T.T.A.B. Aug. 1, 2014), appeal pending, No. 15-1109 (Fed. Cir. docketed Oct. 28, 2014) 23

Cases—Continued: Page

Canal Co. v. *Clark*, 80 U.S. (13 Wall.) 311 (1872) 47
Central Hudson Gas & Elec. Corp. v. *Public Serv. Comm'n*, 447 U.S. 557 (1980) 48
Davenport v. *Washington Educ. Ass'n*, 551 U.S. 177 (2007) 9, 17, 35, 41, 44
Eldred v. *Ashcroft*, 537 U.S. 186 (2003) 47
Geller, In re, 751 F.3d 1355 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 944 (2015) 53
Hanover Star Milling Co. v. *Metcalf*, 240 U.S. 403 (1916) 20
Harris v. *McRae*, 448 U.S. 297 (1980) 29
Heart of Atlanta Motel, Inc. v. *United States*, 379 U.S. 241 (1964) 49
Katzenbach v. *McClung*, 379 U.S. 294 (1964) 49
Lebanese Arak Corp., In re, 94 U.S.P.Q.2d 1215 (T.T.A.B. 2010) 25
Legal Servs. Corp. v. *Velazquez*, 531 U.S. 533 (2001) 33, 43
Maher v. *Roe*, 432 U.S. 464 (1977) 14
McGinley, In re, 660 F.2d 481 (C.C.P.A. 1981) 6, 25
Moseley v. *V Secret Catalogue, Inc.*, 537 U.S. 418 (2003) 47
National Endowment for the Arts v. *Finley*, 524 U.S. 569 (1998) ..... *passim*
Old Glory Condom Corp., In re, 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993) 50
Park 'N Fly, Inc. v. *Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985) 2, 28
Pleasant Grove City v. *Summum*, 555 U.S. 460 (2009) 19, 42

Cases—Continued: Page

Pro-Football Inc. v. *Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015), appeal pending, No. 15-1874 (4th Cir. docketed Aug. 6, 2015) 39, 50
Qualitex Co. v. *Jacobson Prods. Co.*, 514 U.S. 159 (1995) 47
R.A.V. v. *City of St. Paul*, 505 U.S. 377 (1992) 45
Regan v. *Taxation With Representation of Wash.*, 461 U.S. 540 (1983) ..... *passim*
Ridley v. *Massachusetts Bay Transp. Auth.*, 390 F.3d 65 (1st Cir. 2004) 45, 46
Rosenberger v. *Rector & Visitors of Univ. of Va.*, 515 U.S. 819 (1995) 46
Rust v. *Sullivan*, 500 U.S. 173 (1991) ..... *passim*
San Francisco Arts & Athletics, Inc. v. *United States Olympic Comm.*, 483 U.S. 522 (1987) 48
Shinnecock Smoke Shop, In re, 571 F.3d 1171 (Fed. Cir. 2009), cert. denied, 558 U.S. 1149 (2010) 51
Trade-Mark Cases, In re, 100 U.S. 82 (1879) 2, 20, 35
Two Pesos, Inc. v. *Taco Cabana, Inc.*, 505 U.S. 763 (1992) 20
United Drug Co. v. *Theodore Rectanus Co.*, 248 U.S. 90 (1918) 20
United States v. *American Library Ass'n*, 539 U.S. 194 (2003) 16, 17, 30, 49
Wal-Mart Stores, Inc. v. *Samara Bros., Inc.*, 529 U.S. 205 (2000) 47
Walker v. *Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015) ..... *passim*
Wooley v. *Maynard*, 430 U.S. 705 (1977) 19, 38, 40, 43

Case—Continued: Page

Ysursa v. *Pocatello Educ. Ass'n*, 555 U.S. 353 (2009) ..... *passim*

Constitution, treaties and statutes:

U.S. Const. Amend. I ..... *passim*, 1a
General Inter-American Convention for Trade Mark and Commercial Protection, Feb. 20, 1929, Art. 3(4), 46 Stat. 2916, T.S. No. 833 24
Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, Art. 6, 25 Stat. 1376 ..... 24, 50
Paris Convention for the Protection of Industrial Property, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305:
Art. 6quinquies, 21 U.S.T. 1643-1645, 828 U.N.T.S. 331, 333 22
Art. 6quinquies(A)(1), 21 U.S.T. 1643, 828 U.N.T.S. 331 50
Art. 6quinquies(B)(3), 21 U.S.T. 1644, 828 U.N.T.S. 331 50
Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 725 24
Act of July 5, 1946 (Lanham Act), ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*) 3
§ 2(a), 60 Stat. 428 23
15 U.S.C. 1051(a) 4, 1a
15 U.S.C. 1051(a)(1) 3, 10, 22, 1a
15 U.S.C. 1052 ..... *passim*, 7a
15 U.S.C. 1052(a) ..... *passim*, 7a
15 U.S.C. 1052(b) 4, 23, 7a
15 U.S.C. 1052(c) 4, 23, 8a
15 U.S.C. 1052(d) 4, 23, 44, 8a
15 U.S.C. 1052(e)(1) 4, 9a

Statutes—Continued: Page

15 U.S.C. 1052(e)(1)-(3) 23, 9a
15 U.S.C. 1052(e)(5) 4, 23, 9a
15 U.S.C. 1053 ..... 3, 4, 20, 10a
15 U.S.C. 1057(a) 3, 10, 22, 49
15 U.S.C. 1057(b) 3, 10, 22, 27
15 U.S.C. 1062 ..... 3, 10, 22
15 U.S.C. 1063 52
15 U.S.C. 1064 52
15 U.S.C. 1065 ..... 3, 22, 28, 10a
15 U.S.C. 1067 52
15 U.S.C. 1070 52
15 U.S.C. 1071 52
15 U.S.C. 1072 ..... 3, 10, 22, 27
15 U.S.C. 1091 ..... 3, 10, 22
15 U.S.C. 1111 ..... 22, 49
15 U.S.C. 1115 ..... 40, 14a
15 U.S.C. 1115(a) 3, 27, 14a
15 U.S.C. 1115(b) 3, 10, 22, 28, 14a
15 U.S.C. 1117(a) 21
15 U.S.C. 1124 27
15 U.S.C. 1125 ..... 3, 21, 16a
15 U.S.C. 1125(a) 2, 26, 16a
15 U.S.C. 1125(a)(1) 20, 16a
15 U.S.C. 1125(b) 2, 21, 18a
15 U.S.C. 1125(d) 2, 21, 22a
15 U.S.C. 1127 ..... 2, 3, 21, 28a
15 U.S.C. 1141b 22
18 U.S.C. 871 45
20 U.S.C. 954(d)(1) 16
22 U.S.C. 7631(f) 33

Statutes—Continued: Page

35 U.S.C. 42(c)(1) 42
35 U.S.C. 42(c)(2) 42
Tex. Transp. Code Ann. § 504.801(c) (West Supp. 2015) 18

Miscellaneous:

William Henry Browne, *A Treatise on the Law of Trade-Marks* (1873) 26
H.R. Rep. No. 219, 79th Cong., 1st Sess. (1945) 24
1 Anne Gilson LaLonde, *Gilson on Trademarks* (2016) 20
Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous Or Immoral*, 101 Trademark Rep. 1476 (2011) 24
3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th ed. 2016) 24
Thomas Sheridan, *A Complete Dictionary of the English Language* (6th ed. 1796) 29
U.S. Patent and Trademark Office:
Trademark Manual of Examining Procedure (TMEP) (Oct. 2016), https://mpep.uspto.gov/RDMS/TMEP/current 53
Trademark Official Gazette, https://www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog (last visited Nov. 9, 2016) 22

In the Supreme Court of the United States

No. 15-1293

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

SIMON SHIAO TAM

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF FOR THE PETITIONER

OPINIONS BELOW

The opinion of the en banc court of appeals (Pet. App. 1a-122a) is reported at 808 F.3d 1321. The opinion of a panel of the court of appeals (Pet. App. 123a-161a) is reported at 785 F.3d 567. The opinion of the Trademark Trial and Appeal Board (Pet. App. 162a-182a) is reported at 108 U.S.P.Q.2d 1305.

JURISDICTION

The judgment of the court of appeals was entered on December 22, 2015. On March 10, 2016, the Chief Justice extended the time within which to file a petition for a writ of certiorari to and including April 20, 2016, and the petition was filed on that date. The petition for a writ of certiorari was granted on September 29, 2016. The jurisdiction of this Court rests on 28 U.S.C. 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Relevant constitutional and statutory provisions are reprinted in an appendix to this brief. App., *infra*, 1a-29a.

STATEMENT

1. A trademark is a "word, name, symbol, or device" used by a person "to identify and distinguish his or her goods" in commerce and "to indicate the source of the goods." 15 U.S.C. 1127. "[T]rademarks desirably promote competition and the maintenance of product quality." *Park 'N Fly, Inc.* v. *Dollar Park & Fly, Inc.*, 469 U.S. 189, 193 (1985). Trademark law also protects the public by preventing competing merchants from using similar marks to confuse or mislead consumers. See, *e.g.*, *B & B Hardware, Inc.* v. *Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015).

Trademark rights are not created by federal law, but rather arise through use of a mark in commerce in connection with particular goods and services. See, *e.g.*, *B & B Hardware, Inc.*, 135 S. Ct. at 1299; *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879). Those common-law rights include the right to prevent others from using the mark and the right to sue for infringement. See *ibid.*

Certain federal remedies for infringement, dilution, and unfair competition are available to owners of all marks used in interstate or foreign commerce, regardless of whether a mark is registered. See 15 U.S.C. 1125(a), (b), and (d); see also *B & B Hardware*, 135 S. Ct. at 1301 (federal cause of action for infringe-

ment applies to all mark owners).[1] Congress has also created a system of federal registration that confers additional benefits upon the owners of registered marks. See *B & B Hardware*, 135 S. Ct. at 1300; see generally Act of July 5, 1946 (Lanham Act), ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*). For example, registration provides prima facie evidence of the owner's exclusive right to use the mark in commerce in connection with the goods or services listed in the registration. 15 U.S.C. 1057(b), 1115(a). Registration also provides constructive notice of the registrant's claim of ownership of the mark. 15 U.S.C. 1072. After five years of registration, an owner's right to use a trademark can become "incontestable," so that it may be challenged only on limited grounds. 15 U.S.C. 1065, 1115(b). In order to facilitate the mark owner's ability to invoke these protections, the government issues to the owner a certificate of registration "in the name of the United States of America," 15 U.S.C. 1057(a); publishes the mark in the PTO's *Trademark Official Gazette*, 15 U.S.C. 1062; and records the mark in the PTO's Principal Register or Supplemental Register, 15 U.S.C. 1051(a)(1), 1057(a), 1091.[2]

To obtain federal registration, a mark owner submits an application to the United States Patent and

---

[1] Contrary to the court of appeals' suggestion (Pet. App. 4a-5a), a mark need not be federally registered for the mark owner to invoke these remedies. Section 1125 refers to a "mark," and the Lanham Act's definition of "mark" does not require registration. See 15 U.S.C. 1127; p. 21, *infra*.

[2] These federal registration and remedy provisions apply equally to trademarks, which identify goods in commerce, and service marks (such as respondent's mark), which identify services in commerce. See 15 U.S.C. 1053, 1127.

Trademark Office (PTO). 15 U.S.C. 1051(a). Only marks meeting the criteria set out by Congress can be registered. As relevant here, Congress has directed the PTO to "refuse[] registration" of marks consisting of or comprising "matter which may disparage * * * persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute," even if they are capable of distinguishing the owner's goods or services. 15 U.S.C. 1052(a).[3]

2. Respondent is the lead singer of a dance-rock band called "The Slants." Pet. App. 10a. In 2011, he sought to federally register the mark THE SLANTS in connection with live performances by his band. *Id.* at 162a & n.1, 166a; see J.A. 12-24.[4] Respondent had been using that mark in commerce to identify the band since 2006. Pet. App. 10a; J.A. 13.

A PTO examining attorney refused to register the mark on the ground that it is disparaging to persons of Asian ancestry. J.A. 25-31, 33-38; see 15 U.S.C. 1052(a), 1053. The examining attorney relied on evidence that "[s]lant" is a "negative term regarding the shape of the eyes of certain persons of Asian descent," which has a "long history of being used to deride and

---

[3] Congress also has directed the PTO to refuse registration of immoral, deceptive, and scandalous marks, 15 U.S.C. 1052(a); marks containing a flag, coat of arms, or insignia of the United States, a State, or a foreign nation, 15 U.S.C. 1052(b); marks including a name, portrait, or signature of a living person without his or her consent, 15 U.S.C. 1052(c); marks that so resemble other marks that they are likely to cause confusion, 15 U.S.C. 1052(d); marks that are merely descriptive, 15 U.S.C. 1052(e)(1); and marks that are functional, 15 U.S.C. 1052(e)(5).

[4] Respondent first filed a trademark-registration application for THE SLANTS in 2010, but he subsequently abandoned that application. Pet. App. 10a n.2.

mock a physical feature of those individuals." J.A. 28. The examining attorney noted that the refusal of registration "does not mean that [the band] must use a different name with its music performances" or "is otherwise prohibited from using the wording 'The Slants' in association with its music." J.A. 30.

The PTO's Trademark Trial and Appeal Board (Board) affirmed. Pet. App. 162a-182a. The Board concluded that respondent's mark is used to refer to an identifiable group of people—persons of Asian ancestry—and that the mark is disparaging to a substantial composite of that group. *Id.* at 173a-174a, 180a-181a. The Board explained that dictionary definitions and other record evidence "unanimously categorize[d] the word 'slant,' when meaning a person of Asian descent, as disparaging," *id.* at 180a, and that the band itself has characterized its name as "derived from an ethnic slur for Asians," *id.* at 166a (citation omitted). Respondent had argued that he sought to "take on * * * stereotypes" about Asians rather than to disparage persons of Asian ancestry, *ibid.*, but the Board determined that a mark's status as "disparaging" does not depend on the applicant's purpose in using the mark, *id.* at 181a. The Board further concluded that the PTO's refusal to register respondent's mark does not violate the First Amendment because the denial of registration does not suppress speech or proscribe conduct, but simply prevents respondent from calling upon the resources of the federal government to assist him in enforcing the mark. *Id.* at 181a-182a.

3. A panel of the court of appeals affirmed. Pet. App. 123a-161a. The court first rejected respondent's argument that the Board had erred in finding his

mark disparaging under Section 1052(a). The court concluded that substantial evidence supports the Board's findings that "the mark THE SLANTS refers to people of Asian descent" and that the mark "is likely offensive to a substantial composite of people of Asian descent." *Id.* at 127a-131a. The court noted that "the definitions in evidence universally characterize the word 'slant' as disparaging, offensive, or an ethnic slur when used to refer to a person of Asian descent." *Id.* at 130a.

The court of appeals panel rejected respondent's various constitutional challenges, including his facial First Amendment challenge to Section 1052(a)'s disparagement provision. Relying on circuit precedent, the court explained that "the PTO's refusal to register [the] mark does not affect [respondent's] right to use it"; that "[n]o conduct is proscribed, and no tangible form of expression is suppressed"; and that respondent's First Amendment rights therefore are not "abridged by the refusal to register his mark." Pet. App. 131a (quoting *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981), overruled by Pet. App. 1a-122a); see *id.* at 131a-132a (citing other Federal Circuit decisions reaching the same conclusion). The court also rejected respondent's vagueness, due process, and equal protection challenges. *Id.* at 132a-134a.

4. The en banc court of appeals vacated the Board's decision and remanded. Pet. App. 1a-122a. The court first reviewed the record evidence and upheld the panel's determination that respondent's mark is "disparag[ing]" within the meaning of 15 U.S.C. 1052(a). Pet. App. 12a-13a & n.3. The court further held, however, that Section 1052(a)'s ban on the registration of

disparaging trademarks is facially unconstitutional. *Id.* at 3a, 19a n.5.

The en banc court of appeals rejected the government's argument that Congress may, consistent with the First Amendment, create an optional program of federal trademark registration without opening that program to racial slurs and other disparaging marks. Pet. App. 27a-28a. Instead, the court viewed Section 1052(a)'s ban on registration of disparaging trademarks as a law that "penalize[s] private speech merely because [the government] disapproves of the message it conveys." *Id.* at 2a. Because the court interpreted Section 1052(a)'s disparagement provision as a viewpoint-based restriction on speech, it subjected the provision to strict scrutiny and found it facially invalid under the First Amendment. *Id.* at 17a-19a, 67a. The court also stated that it would find the provision unconstitutional even under the more forgiving First Amendment standard governing restrictions on commercial speech because there is no "substantial government interest justifying" Congress's decision to forbid federal registration of disparaging marks. *Id.* at 61a-67a.

Judge O'Malley (joined by Judge Wallach) filed a concurring opinion, Pet. App. 68a-80a, agreeing with the majority's First Amendment analysis and stating the view that Section 1052(a)'s disparagement provision also is unconstitutionally vague (an issue the majority did not reach), *id.* at 68a. Judge Dyk (joined in part by Judges Lourie and Reyna) concurred in part and dissented in part. *Id.* at 80a-104a. He would have held that the ban on registration of disparaging marks is facially constitutional because registration is a government benefit for commercial speech that rea-

sonably may be denied to disparaging marks. *Id.* at 90a-97a. He would have further held, however, that the statute is unconstitutional as applied here because respondent's mark involves "political" speech. *Id.* at 103a-104a.

Judge Lourie dissented, concluding that the disparagement provision is constitutional because it does not prohibit any speech but instead permissibly defines the boundaries of a federal program. Pet. App. 104a-108a. Judge Reyna also dissented, *id.* at 108a-122a, expressing the view that Section 1052(a)'s disparagement provision is a permissible regulation of commercial speech because it "directly advances the government's substantial interest in the orderly flow of commerce," *id.* at 108a.

SUMMARY OF ARGUMENT

The prohibition on registration of disparaging marks in 15 U.S.C. 1052(a) is facially constitutional under the First Amendment. Section 1052(a) defines the marks eligible for federal registration and publication and for the federal benefits associated with that government program. It does not in any way restrict respondent's freedom of speech. Nothing in the First Amendment requires Congress to encourage the use of racial slurs in interstate commerce.

A. This Court has recognized a fundamental distinction between laws that regulate speech and laws that selectively fund a government program. "[W]hen the Government appropriates public funds to establish a program it is entitled to define the limits of that program." *Rust* v. *Sullivan*, 500 U.S. 173, 194 (1991).

Applying that principle, the Court has upheld the denial of federal tax-exempt status for non-profit organizations' lobbying activities, see *Regan* v. *Taxa-*

tion With Representation of Wash., 461 U.S. 540, 546 (1983), and has sustained federal regulations that prohibited use of family-planning funds for abortion-related services, *Rust*, 500 U.S. at 194. In so holding, the Court has "reject[ed] the notion that First Amendment rights are somehow not fully realized unless they are subsidized by the State." *Regan*, 461 U.S. at 546 (citation and internal quotation marks omitted); see *Rust*, 500 U.S. at 192-193. The Court has also applied the "general rule that the Government may choose not to subsidize speech" (*id.* at 200) in upholding conditions on other forms of government assistance, such as the provision of a payroll-deduction mechanism for use by a union in collecting agency-shop fees. See *Davenport* v. *Washington Educ. Ass'n*, 551 U.S. 177, 187-188 (2007); see also *Ysursa* v. *Pocatello Educ. Ass'n*, 555 U.S. 353, 359 (2009). And the Court has upheld the State of Texas's decision not to provide a "mobile billboard" for offensive messages on state specialty license plates. *Walker* v. *Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2253 (2015) (citation omitted).

The common thread running through these decisions is that the government has significant discretion to decide which activities to fund and what criteria to use for inclusion in government programs. Because the government is not restricting speech, but merely declining to provide government assistance, the strict scrutiny normally applicable to content- and viewpoint-based distinctions is inappropriate.

B. Section 1052(a) establishes criteria for participation in the government's trademark-registration program; it does not restrict speech.

Trademark rights arise though use of the mark in commerce, not by operation of federal law, and a mark holder may enforce its mark without registering it. But voluntary federal registration provides important benefits. Among other things, registration provides notice of the registrant's claim of ownership of the mark and prima facie evidence of validity. 15 U.S.C. 1057(b), 1072, 1115(b). The registrant is issued a certificate "in the name of the United States of America" and under the seal of the PTO, and the registered mark is published in the PTO's *Trademark Official Gazette* and on its official register. 15 U.S.C. 1051(a)(1), 1057(a), 1062, 1091.

A mark is not eligible for federal registration if, *inter alia*, it contains "matter which may disparage * * * persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." 15 U.S.C. 1052(a). Refusal of registration does not affect respondent's ability to use THE SLANTS as a trademark or to engage in any other speech, but simply renders unavailable the various benefits and protections that federal registration provides. Those benefits are directly traceable to the resources devoted by the federal government to examining, publishing, and issuing certificates of registration for those marks. Under the court of appeals' decision, the federal government would be required to register, publish, and transmit to foreign countries marks containing crude references to women based on parts of their anatomy; the most repellent racial slurs and white-supremacist slogans; and demeaning illustrations of the prophet Mohammed and other religious figures. In addition to the government's interest in declining to create incentives for the use of such

marks in commerce, the government has a substantial interest in avoiding the incorporation of objectionable marks into official government communications, and the consequent association of the marks with the government itself.

The court of appeals believed that denial of the benefits that trademark registration provides imposed a First Amendment burden on respondent. But this Court has rejected that view, explaining that the "decision not to subsidize the exercise of a fundamental right does not infringe that right." *Regan*, 461 U.S. at 549. The court of appeals erred in characterizing Section 1052(a)'s disparagement provision as imposing an "unconstitutional condition." That provision does not trigger "unconstitutional conditions" analysis because it does not go beyond "defin[ing] the limits of the government spending program" and "seek to leverage funding to regulate speech outside the contours of the program itself." *Agency for Int'l Dev.* v. *Alliance for Open Soc'y, Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013). To the extent that Section 1052(a)'s eligibility criteria encourage people to adopt non-disparaging terms as trademarks, that encouragement is permissible because mark holders remain "free to engage in such speech as they see fit" (*Ysursa*, 555 U.S. at 359) outside of the trademark-registration program.

C. Section 1052(a)'s disparagement provision is facially constitutional. Like the government programs this Court has previously upheld, that provision defines eligibility for the government benefits associated with registration; premises registration only on the content of the mark itself and does not restrict the applicant's expression outside of the program; and reflects a policy choice to encourage activities that are in

the public interest. To the extent that the effect of registration is to incorporate registered marks into official government documents, Section 1052(a)'s disparagement provision is particularly analogous to the ban on offensive specialty-license-plate designs upheld in *Walker*. Just as any motorist who wished to display a Confederate battle flag on his vehicle could do so on a bumper sticker without the State's assistance, respondent can use the term "slants" in any way he wants even if his trademark cannot be registered. And just as the State of Texas could permissibly disassociate itself from a symbol it viewed as offensive to the public, the federal government can permissibly disassociate itself from disparaging trademarks.

The court of appeals concluded that Section 1052(a) is not a condition on a government program, but the court's reasoning is unpersuasive. Section 1052(a) establishes criteria for government assistance in enforcing marks that identify goods and services in commerce; it does not restrict speech. The court of appeals also erred in failing to see the applicability of the government-speech doctrine. That doctrine is implicated here because owners of registered marks are issued certificates in the name of the United States, and the government publishes the marks and transmits registration information to foreign countries. And the court of appeals was wrong to view Section 1052(a)'s disparagement provision as an impermissible viewpoint-based restriction on speech. The provision does not premise registration on the viewpoint of the mark holder and does not raise any realistic threat of driving certain viewpoints from the marketplace of ideas.

Section 1052(a) serves Congress's legitimate interests. Having created a federal trademark-registration program, Congress may legitimately decide that it is not in the public interest to encourage use of disparaging terms to identify goods and services in commerce. And because the effect of registration is to cause registered marks to be incorporated into various formal government communications, the government has an additional interest in disassociating itself from racial slurs and other offensive speech. The Constitution does not put Congress to the choice of either eliminating the federal trademark-registration program altogether or promoting the use of racial slurs in interstate commerce. The judgment of the court of appeals should be reversed.

ARGUMENT

THE FEDERAL STATUTORY PROHIBITION ON THE REGISTRATION OF DISPARAGING TRADEMARKS, 15 U.S.C. 1052(a), IS FACIALLY CONSTITUTIONAL UNDER THE FIRST AMENDMENT

Congress has established a voluntary program of federal trademark registration that affords certain protections to eligible marks. A mark is not eligible for registration if, *inter alia*, it consists of words or symbols that disparage persons, institutions, beliefs, or national symbols. 15 U.S.C. 1052(a). Respondent contends that Section 1052(a)'s disparagement provision is facially unconstitutional because it impermissibly burdens his speech based on its content. The court of appeals accepted that characterization of the provision and found the law invalid on its face.

That holding was erroneous. Section 1052(a) does not prohibit any speech but simply defines the criteria for participation in the government's voluntary

trademark-registration program. Just as the government may decline to provide funding for certain types of art or may exclude certain slogans or symbols from state-issued vehicle license plates, Congress may decline to provide the benefits of trademark registration to disparaging marks. The First Amendment does not require the federal government to assist those who wish to sell products or services using racial slurs, religious insults, or other disparaging marks.

A. There Is A Fundamental Constitutional Distinction Between Laws That Regulate Speech And Laws That Define Eligibility For A Government Program

1. For a variety of constitutional purposes, "[t]here is a basic difference between direct state interference with a protected activity and state encouragement of an alternative activity consonant with legislative policy." *Maher* v. *Roe*, 432 U.S. 464, 475 (1977). "Constitutional concerns are greatest when the State attempts to impose its will by force of law"; the State has "far broader" authority when it adopts programs to "encourage actions deemed to be in the public interest." *Id.* at 476.

In the First Amendment context in particular, the Court has squarely and repeatedly "reject[ed] the notion that First Amendment rights are somehow not fully realized unless they are subsidized by the State." *Regan* v. *Taxation With Representation of Wash.*, 461 U.S. 540, 546 (1983) (citation and internal quotation marks omitted). Although the particular doctrinal labels have varied, the Court's message has been clear: "The First Amendment prohibits government from 'abridging the freedom of speech' "; it "does not confer an affirmative right" to use government resources to facilitate private speech. *Ysursa* v. *Pocatello Educ.*

Ass'n, 555 U.S. 353, 355 (2009) (quoting U.S. Const. Amend. I). Accordingly, the Court has applied significantly more relaxed First Amendment scrutiny when evaluating a law that does not restrict expression but establishes eligibility criteria for a government program.

2. In several decisions, the Court has recognized the government's broad latitude in funding, or declining to fund, protected expression. In *Regan* v. *Taxation With Representation of Washington*, *supra*, the Court rejected a First Amendment challenge to a federal statute that denied tax-exempt status to organizations that engage in lobbying. 461 U.S. at 546-551. The Court recognized the fundamental difference between regulating speech and declining to support speech and noted that, in the challenged statute, "Congress has not infringed any First Amendment right or regulated any First Amendment activity" but instead "has simply chosen not to pay for * * * lobbying." *Id.* at 546.

The Court explained that "a legislature's decision not to subsidize the exercise of a fundamental right does not infringe the right." *Regan*, 461 U.S. at 549. The Court determined that, because the challenged statute did not prevent any organization from collecting funds for lobbying or from engaging in lobbying, the law was "not subject to strict scrutiny." *Id.* at 549-550. The Court then upheld the statute on rational-basis review. *Id.* at 550-551.

In *Rust* v. *Sullivan*, 500 U.S. 173 (1991), the Court rejected a First Amendment challenge to regulations that prohibited the use of federal family-planning funds to provide abortion-related services. *Id.* at 192-200. The Court invoked the principle that the "deci-

sion not to subsidize the exercise of a fundamental right does not infringe that right," *id.* at 193 (quoting *Regan*, 461 U.S. at 549), and explained that "when the Government appropriates public funds to establish a program it is entitled to define the limits of that program," *id.* at 194. The Court concluded that, in setting the condition on the use of family-planning funds, "the Government ha[d] not discriminated on the basis of viewpoint" but "ha[d] merely chosen to fund one activity to the exclusion of the other." *Id.* at 193.

The Court again distinguished between denial of government funding and suppression of speech when it rejected a facial First Amendment challenge to a statute directing a panel awarding federal arts grants to consider "decency and respect for the diverse beliefs and values of the American public." *National Endowment for the Arts* v. *Finley*, 524 U.S. 569, 572-573 (1998) (quoting 20 U.S.C. 954(d)(1)). The Court observed that "Congress may 'selectively fund a program to encourage certain activities it believes to be in the public interest without at the same time funding an alternative program which seeks to deal with the problem another way.'" *Id.* at 588 (quoting *Rust*, 500 U.S. at 193). The Court upheld Congress's decision to take "content-based considerations * * * into account in the grant-making process," explaining that this was a permissible "consequence of the nature of arts funding" rather than an impermissible burden on speech. *Id.* at 585.

In *United States* v. *American Library Ass'n*, 539 U.S. 194 (2003), the Court upheld a federal statute that required public libraries to use internet filters as a condition of federal funding. *Id.* at 212-214 (plurality opinion); *id.* at 214-215 (Kennedy, J., concurring in

the judgment); *id.* at 215-216 (Breyer, J., concurring in the judgment). The plurality reaffirmed Congress's "wide latitude to attach conditions to the receipt of federal assistance in order to further its policy objectives." *Id.* at 203.

3. The "general rule that the Government may choose not to subsidize speech" (*Rust*, 500 U.S. at 200) has not been limited to programs involving the distribution of government funds, but has been applied to other types of government assistance as well. In *Davenport* v. *Washington Education Ass'n*, 551 U.S. 177 (2007), the Court upheld a state law that allowed unions to use agency-shop fees for political activities only when the public employees who paid the fees had affirmatively consented. *Id.* at 187-190. The Court explained that the State was providing a benefit—the ability to collect agency-shop fees from public-sector employees through payroll deductions—and that the State therefore had wide latitude to define the conditions on which that benefit would be available. *Id.* at 181-182, 187-188. The Court found that the statute imposed no impermissible burden on protected activity, explaining that even if a union could not take advantage of the payroll deductions, the union "remain[ed] as free as any other entity to participate in the electoral process" with funds raised from other sources. *Id.* at 190.

Similarly in *Ysursa* v. *Pocatello Education Association*, *supra*, the Court upheld a state law that prohibited public-employee payroll deductions for political activities. 555 U.S. at 358-361. The Court observed that the challenged law "d[id] not restrict political speech, but rather decline[d] to promote that speech" by allowing unions to collect funds for political speech

through payroll deductions. *Id.* at 355. The Court explained that the decision not to provide government assistance (in the form of payroll deductions) to raise funds for political speech "is not an abridgment of the unions' speech," and so the State "need only demonstrate a rational basis" to justify its decision. *Id.* at 359.[5]

4. Most recently, in *Walker* v. *Texas Division, Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015), the Court upheld Texas's decision not to permit a Confederate-flag design on motor-vehicle specialty license plates because the design "might be offensive to * * * the public." *Id.* at 2245 (quoting Tex. Transp. Code Ann. § 504.801(c)). Relying on *Rust*, the Court noted that the government may "choose[] to fund a program dedicated to advanc[ing] certain permissible goals," even if the program "necessarily discourages alternative goals." *Id.* at 2246 (quoting *Rust*, 500 U.S. at 194). "[B]ased on the historical context, observers' reasonable interpretation of the messages conveyed by Texas specialty plates, and the effective control that the State exerts over the design selection process," the Court concluded that "Texas's specialty license plate designs 'are meant to convey and have the effect of conveying a government message'" and therefore "'constitute government speech.'" *Id.* at

---

[5] Respondent has suggested that *Ysursa* and *Davenport* involved the "equivalent" of a disbursement of federal funds because those cases involved payroll deductions. Resp. Cert. Br. 26. But the funds at issue belonged to the employees from whose paychecks the deductions were taken, not to the government. Those cases therefore are properly viewed as involving government assistance through means other than the disbursement of public funds.

2251 (quoting *Pleasant Grove City* v. *Summum*, 555 U.S. 460, 472 (2009)).

The Court recognized that license plates implicate private speech as well as government speech, because a motorist whose vehicle carries the license plate "convey[s] the messages communicated through those designs." *Walker*, 135 S. Ct. at 2252. The Court determined, however, that the government interest in not being associated with certain messages justified Texas's ban on license-plate designs that the State deemed offensive to the public. The Court concluded that, "just as Texas cannot require SCV [Sons of Confederate Veterans] to convey 'the State's ideological message,' SCV cannot force Texas to include a Confederate battle flag on its specialty license plates." *Id.* at 2253 (quoting *Wooley* v. *Maynard*, 430 U.S. 705, 715 (1977)).

5. The common thread uniting these decisions is that the government has significant discretion to decide which activities to fund or what criteria to use for inclusion in government programs. Because the government is not restricting speech, but instead declining to provide government assistance, the strict scrutiny normally applicable to content- and viewpoint-based regulations of speech is inapplicable. These general principles apply not only when the government distributes public funds to private program participants, but also when the government furnishes other forms of assistance, as by providing a payroll-deduction mechanism or by emblazoning a private entity's preferred message on a state-issued license plate.

B. Section 1052(a)'s Ban On Registration Of Disparaging Marks Does Not Restrict Speech

1. Section 1052(a) establishes criteria for government assistance in identifying the source of goods and services in commerce

Trademarks are distinctive words or symbols used to identify the source of the owner's goods and to distinguish them from goods provided by others. 1 Anne Gilson LaLonde, *Gilson on Trademarks* § 1.03[1] (2016); see 15 U.S.C. 1127; see also 15 U.S.C. 1053 (service marks). Trademark rights arise as a result of the owner's use of the mark in commerce, not by operation of federal law. *B & B Hardware, Inc.* v. *Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015); *United Drug Co.* v. *Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918); see *Gilson on Trademarks* § 3.02[2][a]. Ownership of any trademark (registered or unregistered) confers significant rights on the mark holder, both under the common law and under the Lanham Act. Congress has also established a federal trademark-registration program under which registered marks receive additional protection. This case is a facial challenge to one of the criteria for participation in the federal trademark-registration program.

a. Even when a particular trademark is unregistered, the mark's owner may use the mark and may assert its common-law right to prevent others from using the mark. See, *e.g.*, *Hanover Star Milling Co.* v. *Metcalf*, 240 U.S. 403, 411-419 (1916); *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879). Holders of unregistered marks can also invoke the Lanham Act's federal cause of action to protect their marks against misappropriation and consumer confusion. 15 U.S.C. 1125(a)(1); see *Two Pesos, Inc.* v. *Taco Cabana, Inc.*,

505 U.S. 763, 768 (1992) (explaining that Section 1125(a) "protects qualifying unregistered trademarks"). Congress has also prohibited the importation of goods bearing confusing markings without regard to federal registration. 15 U.S.C. 1125(b). It has provided federal protections against cybersquatting on unregistered marks. See 15 U.S.C. 1125(d) (creating civil action for "the owner of a mark" to counteract cyberpiracy, without regard to federal registration). And it has permitted awards of treble damages for the infringement of unregistered trademarks. 15 U.S.C. 1117(a) (authorizing a district court to remedy "a violation under section 1125(a)" by awarding "any sum above the amount found as actual damages, not exceeding three times such amount").

Contrary to the court of appeals' suggestion (Pet. App. 4a-5a), federal registration is not a prerequisite to invocation of these remedies. To the extent they refer to marks at all, the provisions of 15 U.S.C. 1125 refer to a "mark," not to a registered mark. The Lanham Act defines the term "mark" to include any trademark, and defines the term "trademark" to include "any word, name, symbol, or device, or any combination thereof" that is used by a person "to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of goods." 15 U.S.C. 1127. The owner of any mark—registered or not—therefore may invoke the remedies that Congress made available under 15 U.S.C. 1125.

b. The federal trademark-registration program provides additional protections and benefits for federally registered marks. Registration provides constructive notice of the registrant's claim of ownership of the

mark, 15 U.S.C. 1072; is prima facie evidence of the mark's validity and the registrant's ownership of the mark, 15 U.S.C. 1057(b); and can cause the mark to become incontestable (except on limited grounds) after five years, 15 U.S.C. 1065, 1115(b). The owner of a mark receives a certificate of registration "issued in the name of the United States of America, under the seal of the United States Patent and Trademark Office" and signed by the Director of the PTO. 15 U.S.C. 1057(a); see Blackhorse et al. C.A. Amicus Br. Exs. 1-10 (providing examples of registration certificates). Those certificates are submitted to other countries when the mark holder seeks recognition of its mark abroad under the Paris Convention for the Protection of Industrial Property (Paris Convention), see Art. 6^{quinquies}, July 14, 1967, 21 U.S.T. 1643-1645, 828 U.N.T.S. 331, 333, and the PTO certifies and transmits the registration information to the International Bureau of the World Intellectual Property Organization through the international registration system of the Madrid Protocol, see 15 U.S.C. 1141b. Registered marks also are published in the PTO's *Trademark Official Gazette*, 15 U.S.C. 1062; see PTO, *Trademark Official Gazette*, https://www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog (last visited Nov. 9, 2016), and are recorded in the PTO's Principal Register or Supplemental Register, 15 U.S.C. 1051(a)(1), 1057(a), 1091. And the owner of a registered mark may use the symbol ® to indicate government registration of the mark. 15 U.S.C. 1111.

Not all marks are eligible for federal registration. In Section 1052, Congress directed the PTO to "refuse[] registration" of certain marks "on account of their nature." 15 U.S.C. 1052. Under this provision, a

mark is ineligible for registration if it is merely descriptive, 15 U.S.C. 1052(e)(1)-(3); functional, 15 U.S.C. 1052(e)(5); deceptive, 15 U.S.C. 1052(a); or likely to cause confusion because of similarity to another mark, 15 U.S.C. 1052(d). Marks also are ineligible for registration if they contain certain symbols of the United States, a State, or a foreign nation, 15 U.S.C. 1052(b); the name, portrait, or signature of a living person (or of a deceased U.S. president during the life of the surviving spouse) without consent, 15 U.S.C. 1052(c); or immoral or scandalous matter, 15 U.S.C. 1052(a). And, as relevant here, a mark is ineligible for registration if it contains "matter which may disparage * * * persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." *Ibid.*

Only Section 1052(a)'s prohibition on the registration of disparaging marks is at issue in this case.[6] Federal law has prohibited registration of disparaging marks since 1946. See Lanham Act § 2(a), 60 Stat.

---

[6] The validity of Section 1052(a)'s prohibition against registering "scandalous" marks is at issue in *In re Brunetti*, No. 15-1109, a case currently pending before the Federal Circuit. The applicant in that case seeks federal registration of the mark FUCT for a line of clothing. The PTO rejected the application on the ground that the mark is "scandalous" within the meaning of Section 1052(a), explaining that the mark is a homonym for a crude obscenity. See *In re Brunetti*, Serial No. 85310960, 2014 WL 3976439, at *4-*6 (T.T.A.B. Aug. 1, 2014) (non-precedential opinion), appeal pending, No. 15-1109 (Fed. Cir. docketed Oct. 28, 2014). After the court of appeals' decision in this case, the government acknowledged that, under the en banc majority's reasoning, Section 1052(a)'s ban on registration of "scandalous" marks is invalid as well. See Letter of Appellee Lee at 2, *In re Brunetti*, No. 15-1109 (Fed. Cir. Jan. 21, 2016) (Docket entry No. 52).

428; see also Act of Feb. 20, 1905, ch. 592, § 5, 33 Stat. 725 (prohibition on registration of marks containing scandalous or immoral matter). The Lanham Act was enacted in part to "carry out by statute our international commitments," H.R. Rep. No. 219, 79th Cong., 1st Sess. 4 (1945); by 1946, the United States had acceded to treaties that allowed parties thereto to refuse recognition of trademarks because they were disparaging or on similar grounds.[7] Nearly every State now includes a provision in its trademark laws that prohibits state registration of disparaging marks.[8] The PTO determines whether a mark is disparaging by ascertaining the likely meaning of the mark in the context in which it is used, and then, if the mark refers to persons, institutions, beliefs, or national sym-

---

[7] See General Inter-American Convention for Trade Mark and Commercial Protection, Feb. 20, 1929, Art. 3(4), 46 Stat. 2916, T.S. No. 833 (authorizing refusal of registration or deposit for marks "[w]hich tend to expose persons, institutions, beliefs, national symbols or those of associations of public interest to ridicule or contempt"); Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, Art. 6, 25 Stat. 1376 (U.S. accession effective May 30, 1887) (authorizing refusal of registration and invalidation of marks "contrary to morals and to public order").

[8] The International Trademark Association's model law prohibits registration of marks that consist of or comprise "immoral, deceptive or scandalous matter" or matter that "may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 22:9.25, at 22-46 (4th ed. 2016) (quoting Model State Trademark Bill § 2 (2007)). Almost all States have adopted that provision. See *id.* § 22:5, at 22-20.4; see also Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous Or Immoral*, 101 Trademark Rep. 1476, 1477 n.3 (2011) (listing state statutes).

bols, assessing whether that meaning is disparaging to a substantial composite of the referenced group. See Pet. App. 172a (quoting *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010)).[9]

2. Section 1052(a)'s disparagement provision does not restrict speech

Section 1052(a)'s ban on registration of disparaging trademarks establishes a criterion for participation in a federal program, not a restriction on speech. Section 1052 of Title 15 is entitled "[t]rademarks registrable on [the] principal register." 15 U.S.C. 1052. Section 1052(a) limits the marks that may be federally registered, but it does not restrict the mark holder's ability to use its mark or to engage in any other speech. See *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) ("[T]he refusal to register a mark does not proscribe any conduct or suppress any form of expression because it does not affect the applicant's right to use the mark in question."); *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (Under Section 1052(a), "[n]o conduct is proscribed, and no tangible form of expression is suppressed."), overruled by Pet. App.

---

[9] A panel of the court of appeals applied that test and concluded that respondent's mark is disparaging, Pet. App. 127a-131a, and the en banc court upheld that conclusion, *id.* at 12a n.3. Respondent did not dispute the test below. See Resp. C.A. Br. 16-42; Resp. C.A. Reply Br. 5-19. In his certiorari-stage brief, respondent argued that his mark is not disparaging. See Resp. Cert. Br. i. When it granted certiorari, this Court did not ask the parties to brief any additional question concerning the applicability of the statutory bar to respondent's mark, nor did the Court ask the parties to address whether the statute is unconstitutionally vague. See 2016 WL 1587871 (Sept. 29, 2016); Cert. Reply Br. 10; see also note 14, *infra* (addressing respondent's vagueness argument).

1a-122a. The only consequence of failing to satisfy the statutory criterion is that the mark is "refused registration." 15 U.S.C. 1052.

Section 1052(a)'s disparagement provision does not abridge respondent's freedom of speech. It does not limit what respondent may name his band, what songs he may sing, how he may advertise, or what messages he may convey, through his band or in his own private speech. If respondent wishes to start a public debate about reappropriating racial slurs and using them as "badges of pride" rather than as insults, Resp. Cert. Br. 2, he is free to do so. See *id.* at 3-4 (respondent's examples of how he has attempted to "reclaim" racial slurs by using them in his band's album titles and song lyrics). If respondent wishes to use disparaging terms to refer to African-Americans, women, and gay people (see *id.* at 2, 14, 19, 31-33) in his music, in his legal briefs, or in everyday conversation, he may do that as well. See Pet. App. 120a (Reyna, J., dissenting) ("Mr. Tam remains free to spread his chosen message to all who would listen without fear of government intervention or reprisal."). Respondent likewise may continue to use THE SLANTS to identify his band's services in commerce, see *id.* at 105a (Lourie, J., dissenting) (respondent "may use his trademark as he likes" without federal registration), and may invoke the federal cause of action (15 U.S.C. 1125(a)) to sue for redress.[10] Indeed, although respondent first

---

[10] It is unclear whether a racially disparaging mark such as respondent's would have been enforceable at common law. See William Henry Browne, *A Treatise on the Law of Trade-Marks* § 602, at 464-465 (1873) (noting "a rule of universal application" that trademarks "must not transgress the rules of morality or public policy," and thus that trademarks that blaspheme religious objects

used the mark THE SLANTS in commerce in 2006, he did not apply for registration until 2010. Pet. App. 10a. Respondent's freedom of speech was not impaired or unrealized before he sought federal trademark registration, nor has his freedom of speech been impaired by the denial of such registration.

The PTO's refusal of registration for THE SLANTS did not impair respondent's ability to speak freely but only denied him and his band the various benefits provided by the federal trademark-registration program. The benefits that registration confers on the trademark owner are directly traceable to the resources devoted by the federal government to examining, publishing, and issuing certificates of registration for those marks. For example, because registered marks have withstood PTO examination, registration provides prima facie evidence of the owner's exclusive right to use the mark in connection with particular goods or services in commerce. 15 U.S.C. 1057(b), 1115(a). The official register of marks provides U.S. Customs and Border Protection officers with a list to use in excluding counterfeit goods from importation. 15 U.S.C. 1124. And publication of registered marks provides nationwide constructive notice of the registrant's claim of ownership of the mark, 15 U.S.C. 1072, which in turn justifies the rule that the registrant's exclusive rights in the mark and the mark's validity become incontestable to certain challenges after a period of time, see 15 U.S.C. 1065, 1115(b), thereby allowing mark holders to use the

---

would not be recognized). Section 1052(a)'s disparagement provision does not speak to that question: It renders respondent's mark ineligible for federal registration, but it does not alter whatever common-law rights in the mark respondent may have.

registration process to "quiet title" in their marks, see *Park 'N Fly, Inc.* v. *Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985). The advantages that federal registration provides to the mark holder reinforce the conclusion that Section 1052 generally, and Section 1052(a)'s disparagement provision in particular, limit access to government-conferred benefits rather than restrict private speech.

Those consequences of registration also underscore the scope and strength of the government's interests in enforcement of Section 1052(a)'s disparagement provision. The implication of respondent's position is that the federal government would be required to register, publish, and transmit to foreign countries marks containing crude references to women based on parts of their anatomy; the most repellent racial slurs and white-supremacist slogans; and demeaning illustrations of the prophet Mohammed and other religious figures. See, *e.g.*, Blackhorse et al. C.A. Amicus Br. 17 (providing examples); Pet. App. 101a (Dyk, J., concurring in part and dissenting in part) (providing additional examples). In addition to the government's interest in declining to create incentives for the use of such marks *in commerce*, the government has a substantial interest in avoiding the incorporation of objectionable marks into official government communications, and the consequent association of the marks with the government itself.

3. Ineligibility for a government benefit is not itself a First Amendment burden

The court of appeals viewed Section 1052(a)'s disparagement provision as a limitation on speech rather than as a criterion for participation in a federal program. Pet. App. 16a, 18a, 28a-31a. The court believed

that, if a mark owner cannot obtain the benefits of federal registration, his speech necessarily is burdened. See, *e.g.*, *id.* at 30a (Section 1052(a) "burdens some speakers and benefits others"); see also, *e.g.*, Resp. Cert. Br. 7, 25. That analysis is flawed. This Court has repeatedly distinguished, for constitutional purposes, between laws that restrict the exercise of constitutional rights and laws that simply withhold government subsidies or other benefits for constitutionally protected conduct.

"A refusal to fund protected activity, without more, cannot be equated with the imposition of a 'penalty' on that activity." *Harris* v. *McRae*, 448 U.S. 297, 317 n.19 (1980). "The Government has no constitutional duty to subsidize an activity merely because the activity is constitutionally protected," *Rust*, 500 U.S. at 201, and the "decision not to subsidize the exercise of a fundamental right does not infringe the right," *Regan*, 461 U.S. at 549. As the Court has repeatedly explained (*e.g.*, *Ysursa*, 555 U.S. at 355), the decision not to provide government assistance to expression generally does not "abridg[e] the freedom of speech" (U.S. Const. Amend. I). "To abridge is 'to contract, to diminish; to deprive of.'" *Finley*, 524 U.S. at 595 (Scalia, J., concurring in the judgment) (quoting Thomas Sheridan, *A Complete Dictionary of the English Language* (6th ed. 1796)). The government's denial of federal arts grants thus does not "abridge" the speech rights of unsuccessful applicants because those applicants "are as unconstrained now as they were before the enactment of th[e] statute." *Ibid.*

The Court's holdings in cases concerning First Amendment challenges to government subsidies and programs illustrate that eligibility requirements do

not ordinarily impose First Amendment burdens. Congress's decision not to provide a federal tax exemption to lobbying organizations did not burden them because the organizations could continue to lobby and raise money for lobbying. *Regan*, 461 U.S. at 545. A State's decision not to assist unions by providing automatic payroll deductions for political activities did not burden the unions because they remained free to raise money from other sources and through other collection mechanisms, and to use that money to "engage in such speech as they see fit." *Ysursa*, 555 U.S. at 359. An internet-filter condition "d[id] not 'penalize' libraries that choose not to install such software" because the libraries remained free to "offer unfiltered access * * * without federal assistance." *American Library Ass'n*, 539 U.S. at 212 (plurality opinion). And Congress's decision not to provide government funding for abortion-related services did not impermissibly burden the speech rights of grantees or their staff. *Rust*, 500 U.S. at 193.

Similarly here, Congress's refusal to afford disparaging marks the benefits of federal registration does not burden the mark owner's speech. The mark owner has all the rights to use the mark that he would have in the absence of the registration program. Section 1052(a) does not restrict what he may say or do but simply denies him a particular form of government assistance.

When one person receives a government subsidy and another does not, the first person may be comparatively better off than the second, but the second has not been burdened by the government. If the court of appeals' approach were correct, then every government decision to selectively fund exercise of a consti-

tutional right could be reconceptualized as a burden on that right. The court below suggested that ineligibility for a benefit becomes a burden when the benefit is especially valuable. See Pet. App. 18a, 28a, 30a. But this Court's decisions in such cases as *Regan*, *Rust*, and *Ysursa* has not turned on the value of the assistance offered by the government. Rather, the Court has found it decisive that the government has "the authority to impose limits on the use of [its] funds to ensure they are used in the manner [the government] intends." *Agency for Int'l Dev.* v. *Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013).

4. Section 1052(a)'s disparagement provision does not place an unconstitutional condition on mark owners

This Court has sometimes concluded that particular requirements for participation in a government program imposed "unconstitutional conditions" that impermissibly burdened expression. The court of appeals viewed those decisions as supporting its conclusion that Section 1052(a)'s ban on registration of disparaging trademarks violates the First Amendment. See Pet. App. 28a-31a. The court's reliance on those decisions was misplaced.

In *Agency for Int'l Development* v. *Alliance for Open Society Int'l., Inc.*, *supra*, the Court set forth the analysis that should be used to determine whether a condition on participation in a government program crosses the line between a permissible eligibility criterion and impermissible coercion. The "relevant distinction," the Court explained, "is between conditions that define the limits of the government spending program" and "conditions that seek to leverage funding to regulate speech outside the contours of the

program itself." 133 S. Ct. at 2328. Under that approach, the law at issue in *Regan*, which denied tax-exempt status to lobbying organizations, was a permissible condition because it allowed a non-profit entity to segregate its lobbying from its other activities and continue to lobby while maintaining tax-exempt status for the other activities. *Id.* at 2328-2329; see *Regan*, 461 U.S. at 545. In *Rust*, Congress's decision to "define[] the federal program to encourage only particular family planning methods" was permissible because clinic staff could advocate other methods outside the federal program. *Agency for Int'l Dev.*, 133 S. Ct. at 2329; see *Rust*, 500 U.S. at 196 ("The Title X grantee can continue to * * * engage in abortion advocacy.") (emphasis omitted).

By contrast, the Court viewed the federal funding criterion at issue in *Agency for Int'l Development* as an impermissible condition because it "reach[ed] outside" the relevant federal program to restrict expression in non-federally-funded activities. 133 S. Ct. at 2330. The program allocated funds to combat the spread of HIV and AIDS. *Id.* at 2324. The Court found it acceptable for Congress to specify that federal funds could not be used to advocate prostitution or sex trafficking, because Congress's power to appropriate funds "includes the authority to impose limits * * * to ensure they are used in the manner Congress intends." *Id.* at 2327-2328.

The Court held, however, that Congress had gone too far in requiring funding recipients to "have a policy explicitly opposing prostitution and sex trafficking." *Agency for Int'l Dev.*, 133 S. Ct. at 2324-2325 (quoting 22 U.S.C. 7631(f)). The Court explained that, by "demanding that funding recipients adopt—as their

own—the Government's view on an issue of public concern, the condition by its very nature affect[ed] 'protected conduct outside the scope of the federally funded program.'" *Id.* at 2330 (quoting *Rust*, 500 U.S. at 197). The recipient could not "avow the belief dictated by the [statute] when spending [program] funds" but then "turn around and assert a contrary belief, or claim neutrality, when participating in activities on its own time and dime." *Ibid.*; see *Legal Servs. Corp.* v. *Velazquez*, 531 U.S. 533, 542-547 (2001) (condition on use of funds for legal services was unconstitutional because, *inter alia*, it placed a "substantial restriction" on private speech and left "no alternative channel for expression").

The "unconstitutional conditions" doctrine thus limits Congress's wide latitude to define the terms of government programs only where "the Government has placed a condition on the *recipient* of the subsidy rather than on a particular program or service, thus effectively prohibiting the recipient from engaging in the protected conduct outside the scope of the federally funded program." *Rust*, 500 U.S. at 197. Under Section 1052(a), by contrast, an applicant is not required, as a condition of registering a mark, to promise never to use disparaging terms, or to endorse the view that racial slurs are unacceptable. Cf. *Agency for Int'l Dev.*, 133 S. Ct. at 2330 (condition impermissible because it "compell[ed] a grant recipient to adopt a particular belief as a condition of funding"). Respondent could register a non-disparaging mark while continuing to assert that his own use of a racial slur is a suitable means of "reappropriat[ing]" (Resp. Cert. Br. 2) the slur. Section 1052(a)'s disparagement provision thus imposes no "ongoing condition on recipients'

speech and activities," but instead leaves respondent unrestrained when he is "on [his] own time and dime." *Agency for Int'l Dev.*, 133 S. Ct. at 2330. Because Section 1052(a) speaks solely to the *registration* of disparaging marks, it permissibly "define[s] the federal program" but does not "reach outside it." *Ibid.*

5. Section 1052(a)'s encouragement to use non-disparaging marks does not impermissibly chill speech

The court of appeals viewed Section 1052(a)'s disparagement provision as a restriction on speech because that provision "creates a serious disincentive to adopt a mark which the government may deem offensive or disparaging." Pet. App. 31a. But when the government makes only some speech eligible for federal assistance, the prospect that a person will choose to engage in speech that meets the eligibility criteria, rather than speech that does not, is not an impermissible chilling effect. In *Finley*, for example, the Court recognized that artists, "as a practical matter," "may conform their speech to what they believe to be the decisionmaking criteria in order to acquire funding." 524 U.S. at 589. The Court held, however, that this incentive effect did not make the federal funding criteria coercive or impermissibly discriminatory. *Id.* at 588-589.

Indeed, under the court of appeals' approach, any government subsidy of speech could be viewed as improperly chilling speech that does not qualify for the subsidy. The tax-exemption provision at issue in *Regan* could have been said to chill investment in lobbying, and the spending restriction in *Rust* was plainly intended to discourage abortion-related activities. The Court found no impermissible chill, however, because

the affected organizations were "free to engage in such speech as they see fit" without federal funds. *Ysursa*, 555 U.S. at 359; see, *e.g.*, *Rust*, 500 U.S. at 196 (critical fact was that program "leave[s] the grantee unfettered in its other activities"); Pet. App. 95a (Dyk, J., concurring in part and dissenting in part) (explaining that a marginal shift in incentives "is commonly the effect of the denial of subsidies," but that "does not turn a subsidy provision into a regulatory provision, so long as the subsidy is not designed to limit speech outside of the subsidized program"). A government program, "in advancing [its] goals," "necessarily discourages alternative goals." *Rust*, 500 U.S. at 194. But a person's voluntary choice to engage in speech that qualifies for federal assistance is not a government abridgement of speech.

C. Section 1052 Establishes Permissible Criteria For The Federal Trademark-Registration Program

1. The federal trademark-registration program, including Section 1052(a)'s ban on registration of disparaging marks, is similar to programs this Court has upheld

Section 1052 includes all of the features this Court has identified as important to upholding similar government programs. Like the challenged provisions in *Regan*, *Rust*, *Ysursa*, and similar cases, Section 1052(a) defines eligibility for a discretionary government benefit. Trademarks were used and enforced for hundreds of years without government registration, *B & B Hardware*, 135 S. Ct. at 1299; *In re Trademark Cases*, 100 U.S. 82, 92 (1879), and Congress is not obligated to provide a registration system. Cf. *Davenport*, 551 U.S. at 184 (noting that the State

could "eliminate agency fees entirely"). But Congress concluded that federal registration would improve the flow of commerce, and it has provided various forms of assistance to registered marks. "These benefits all 'enlist' the government in support of the mark holder's commercial identification, much like the collection of nonmember fees in *Davenport* and the payroll deductions in *Ysursa* enlisted the states in support of the unions' political speech." Pet. App. 94a (Dyk, J., concurring in part and dissenting in part). "Just as the states were not obligated to enable labor unions to collect nonmember fees or take payroll deductions in the first place, the federal government is not obligated to provide these benefits of a trademark enforcement mechanism." *Ibid.*

Under Section 1052(a)'s disparagement provision, registrability depends on the content of the mark for which registration is sought; the statute places no "condition on the *recipient* of the subsidy" that prevents him from engaging in speech "outside the scope of the federally funded program." *Rust*, 500 U.S. at 197. Just as an artist denied federal arts funding could create as much excrement-smeared art as he wished without federal assistance, *Finley*, 524 U.S. at 574, 588, a person who is unable to register an offensive racial slur with the PTO may continue to use that term, as an unregistered trademark or otherwise. In Section 1052(a), Congress is "simply insisting that public funds be spent for the purposes for which they were authorized." *Rust*, 500 U.S. at 196.

Finally, Section 1052 generally, and Section 1052(a)'s disparagement provision in particular, reflect congressional policy choices about which marks the government wishes to assist. Just as Texas allowed specialty-

license-plate designs only if they were not "offensive" to the public, *Walker*, 135 S. Ct. at 2245 (citation omitted), and Congress funded only art that met standards of decency and respect for diversity, *Finley*, 524 U.S. at 576, Congress has chosen to provide particular forms of federal assistance only to marks that identify the sources of goods and services in commerce without using disparaging terms. As in *Walker*, *Rust*, and similar cases, Congress has "selectively fund[ed]" the trademark-registration program to "encourage certain activities it believes to be in the public interest,'" without placing any constraints on speech outside the registration program. *Id.* at 588 (quoting *Rust*, 500 U.S. at 193).

2. Section 1052(a)'s disparagement provision furthers government interests analogous to those implicated in **Walker**

This Court has not considered a government program precisely like the one at issue here. As explained above, however, the federal government, in administering the trademark-registration program, issues certificates of registration, publishes registered marks, and transmits registration information to foreign countries. With respect to those official communications, Section 1052(a)'s disparagement provision serves government interests analogous to those that underlay the license-plate condition upheld in *Walker*.

In *Walker*, the Court held that Texas could permissibly issue specialty state license plates without opening the program to a specialty-plate design that incorporated the Confederate battle flag. 135 S. Ct. at 2246-2253. The Court concluded that, although the State allowed private parties to propose specialty-plate designs, any designs that the State accepted

should be viewed as government speech. See *id.* at 2246, 2249-2250. The Court explained, *inter alia*, that "Texas license plates are, essentially, government IDs"; that because a bumper sticker could be used to communicate purely private sentiments, "a person who displays a message on a Texas license plate likely intends to convey to the public that the State has endorsed that message"; and that "Texas maintains direct control over the messages conveyed on its specialty plates." *Id.* at 2249.

Recognizing that there are some messages with which the State "d[id] not wish to be associated," such as "expressions of hate" toward particular racial groups, 135 S. Ct. at 2245, 2247 (citations omitted), the Court in *Walker* held that Texas could permissibly decline to "convey[]" those messages "on behalf of the government" through specialty license plates, *id.* at 2250. The Court observed that "[t]he fact that private parties take part in the design or propagation of a message does not extinguish the governmental nature of the message or transform the government's role into that of a mere forum-provider." *Id.* at 2251. The Court noted its prior holding in *Wooley* v. *Maynard*, *supra*, "that drivers who display a State's selected license plate designs convey the messages communicated through those designs." *Walker*, 135 S. Ct. at 2252. The Court concluded that, "just as Texas cannot require SCV [Sons of Confederate Veterans] to convey 'the State's ideological message,' SCV cannot force Texas to include a Confederate battle flag on its specialty license plates." *Id.* at 2253 (quoting *Wooley*, 430 U.S. at 715).

Respondent's First Amendment challenge to Section 1052(a)'s disparagement provision implicates

similar concerns. Respondent contends that, once Congress established the trademark-registration program, it was required to extend the benefits of registration to disparaging marks. Like the Sons of Confederate Veterans in *Walker*, respondent does not simply assert a right to engage in his chosen form of communication free from government interference. Rather, respondent asserts that he is constitutionally entitled to a form of government assistance that will closely associate the government with offensive terminology. Registration of THE SLANTS would cause the mark to be published on the Principal Register; would cause a certificate for the mark to be issued "in the name of the United States" (which may be transmitted to foreign countries); and would entitle respondent to use the ® symbol to convey to the public that the mark has an official status. See *Pro-Football, Inc.* v. *Blackhorse*, 112 F. Supp. 3d 439, 461 (E.D. Va. 2015) ("[T]he purpose of the federal trademark registration program is to provide federal protection to trademarks," which is "in part achieved by providing notice to the public of what trademarks are registered through the Principal Register."), appeal pending, No. 15-1874 (4th Cir. docketed Aug. 6, 2015). Thus, "while a trademark alone, as a word placed on private property, is not government speech, once it claims that federally registered status, it becomes more than the private owner's speech. It is not simply private speech as is the holding of a placard in a parade." Pet. App. 108a (Lourie, J., dissenting).

Here, as in *Walker*, the government's effort to disassociate itself from offensive communications leaves ample room for private speech outside the government program. 135 S. Ct. at 2249. Just as a vehicle

owner in Texas may display the Confederate flag on a bumper sticker (see *ibid.*), respondent may use any racial slurs he wishes in marketing his band or in his private speech. In *Wooley*, the Court recognized "an individual's First Amendment right to avoid becoming the courier for" a message that he finds objectionable. 430 U.S. at 717. The government has an analogous interest in declining to incorporate racially offensive epithets into various official communications. See *Walker*, 135 S. Ct. at 2253.

In other respects, moreover, it is even clearer here than in *Walker* that the challenged program condition does not unconstitutionally restrict private speech. In the program at issue in *Walker*, the only consequence of the State's ruling on a specialty-plate application was speech-related: particular content either would or would not appear on State-issued license plates. Here, by contrast, many consequences of registration relate to the mark owner's ability to prevent others from using the mark in commerce, rather than to the mark owner's communication of his own message. See, *e.g.*, 15 U.S.C. 1115; see also pp. 47-48, *infra* (explaining that trademarks are not inherently expressive). That difference underscores that the trademark-registration system is less closely tied to the applicant's expression than was the specialty-license-plate program in *Walker*.

Relatedly, this case, unlike *Walker*, does not raise any public-forum issues. The legal theory embraced by the dissenting Justices in *Walker* was that "by selling space on its license plates," Texas has "create[d] what [the Court] ha[s] called a limited public forum." 135 S. Ct. at 2262 (Alito, J., dissenting). But neither the formal government communications used to implement the federal trademark-registration pro-

gram, nor the program as a whole, can plausibly be viewed as a public forum. The Principal Register was not created as a mechanism for private individuals to communicate expression; its purpose is to list registered trademarks to facilitate their enforcement.

3. The court of appeals erred in failing to recognize that this is a government-program case

The court of appeals gave various reasons for finding this Court's government-program decisions inapposite. Each of those rationales is unpersuasive.

First, the court said that Section 1052(a) does not concern a government program because it does not involve a direct financial subsidy or the use of government property. Pet. App. 52a-53a. But the principle that the First Amendment does not confer an affirmative right to government assistance does not depend on the form of assistance offered. *Davenport* and *Ysursa* concerned the provision to unions of government assistance in collecting fees from public employees, which entailed a financial benefit to the unions but no outlay of government funds. See *Ysursa*, 555 U.S. at 355-356; *Davenport*, 551 U.S. at 182-183; note 5, *supra*. In *Walker*, the plaintiffs sought to have a message of their own devising communicated on government-issued license plates. 135 S. Ct at 2249. In each of those cases, the crucial point was that the plaintiff had sought government support or assistance for its communicative efforts, rather than simply the right to speak free from government interference. Similarly here, respondent seeks to have his trademark published on the government's Principal Register, and to invoke various presumptions and legal advantages that registration of a mark entails.

Second, the court of appeals concluded that the Lanham Act does not confer a government benefit because the trademark-registration program is funded by user fees. See Pet. App. 57a. But the same was true in *Walker*, where the Court viewed the specialty-plate program as a form of government assistance despite "the fact that Texas vehicle owners pay annual fees in order to display specialty license plates." 135 S. Ct. at 2252. The *Walker* Court further explained, with reference to a prior case involving monuments in government parks, that "if the city in [*Pleasant Grove City* v. *Summum*, *supra*,] had established a rule that organizations wishing to donate monuments must also pay fees to assist in park maintenance, we do not believe that the result in that case would have been any different." 135 S. Ct. at 2252.[11]

Finally, the court of appeals erred in concluding that trademark registration does not implicate the constitutional rules pertaining to government speech. Pet. App. 40a-47a. To be sure, the mark THE SLANTS was devised by, and presumably is understood by the public to have been devised by, respondent and/or his fellow band members rather than by the government. The Court in *Walker* held, however, that when communication takes place over a government platform, "[t]he fact that private parties take part in the design and propagation of a message does not

---

[11] Although applicants for trademark registration must pay a fee, the registration program is funded through appropriations. User fees collected by the PTO are deposited in the treasury and become funds of the United States, and the PTO may spend those funds in connection with the registration process only "[t]o the extent and in the amounts provided in advance in appropriations Acts." 35 U.S.C. 42(c)(1) and (2).

extinguish the governmental nature of the message." 135 S. Ct. at 2251. Just as the Court in *Wooley* viewed the facts before it as involving compelled private speech, even though the relevant message ("Live Free or Die") had self-evidently been drafted by the New Hampshire government, a requirement that the PTO register respondent's trademark would compel government speech in a manner that this Court's decisions discountenance. See *id.* at 2252-2253; *Wooley*, 430 U.S. at 707, 714-715.

The court of appeals dismissed each of this Court's decisions in turn as involving government programs factually different from the trademark-registration program. But decisions like (for example) *Regan*, *Rust*, and *Walker* are properly viewed, not as residing within wholly discrete analytic categories, but as exemplars of the overarching principle that "a legislature's decision not to subsidize the exercise of a fundamental right does not infringe the right, and thus is not subject to strict scrutiny." *Regan*, 461 U.S. at 549; cf. *Velazquez*, 531 U.S. at 541 (describing the restriction on abortion counseling at issue in *Rust* as "amount[ing] to governmental speech" even though *Rust* itself did not describe the restriction in that way). Any uncertainty as to which doctrinal label best describes this case should not obscure the fact that, under that principle, Section 1052(a)'s disparagement provision is a permissible restriction on eligibility for the government benefits that the federal trademark-registration program provides.

4. Section 1052(a)'s disparagement provision is not a viewpoint-based restriction on speech

The court of appeals applied strict scrutiny because it characterized Section 1052(a)'s disparagement pro-

vision as a viewpoint-based restriction on speech. See Pet. App. 17a-24a, 53a-54a. As explained above, however, Section 1052 does not restrict speech, but simply denies particular forms of government assistance for trademarks falling within defined categories. Because "a legislature's decision not to subsidize the exercise of a fundamental right does not infringe the right," *Regan*, 461 U.S. at 549, this Court has squarely rejected the view that "strict scrutiny applies whenever Congress subsidizes some speech, but not all speech," *id.* at 548. Because selective government assistance does not restrict speech, the government may allocate that assistance using "criteria that would be impermissible were direct regulation of speech * * * at stake." *Finley*, 524 U.S. 587-588; see *Davenport*, 551 U.S. at 188-189 ("It is well established that the government can make content-based distinctions when it subsidizes speech."). When the government "selectively fund[s] a program to encourage certain activities it believes to be in the public interest," the government "has not discriminated on the basis of viewpoint" but "has merely chosen to fund one activity to the exclusion of the other." *Rust*, 500 U.S. at 193.

In any event, Section 1052(a)'s disparagement provision does not discriminate based on the viewpoint of the would-be registrant. The court of appeals concluded that Section 1052(a)'s prohibition on registration of disparaging marks is viewpoint-based because it precludes registration "when [the PTO] finds the marks refer to a group in a negative way, but * * * permits the registration of marks that refer to a group in a positive, non-disparaging manner." Pet. App. 21a. But laws against (for example) libel, threats, or "fighting words" likewise distinguish in a general way be-

tween speech that is critical or hostile and speech that is complimentary or conciliatory. For purposes of First Amendment analysis, such laws have not been treated as viewpoint-based restrictions unless they draw additional distinctions between favored and disfavored messages.

In *R.A.V.* v. *City of St. Paul*, 505 U.S. 377 (1992), the Court explained that, although Congress had validly prohibited all threats of violence against the President (see 18 U.S.C. 871), "the Federal Government may not criminalize only those threats against the President that mention his policy on aid to inner cities." 505 U.S. at 388. The Court further observed that, while a statute prohibiting the use of "odious racial epithets" by "proponents of all views" does not discriminate based on viewpoint, the government may not "license one side of a debate to fight freestyle, while requiring the other to follow Marquis of Queensberry rules." *Id.* at 391-392.

The First Circuit has subsequently applied those principles in analyzing a municipal transit authority's "restriction on the display of advertisements that 'demean or disparage' individuals or groups." *American Freedom Def. Initiative* v. *Massachusetts Bay Transp. Auth.*, 781 F.3d 571, 574 (1st Cir. 2015), cert. denied, 136 S. Ct. 793 (2016); see *Ridley* v. *Massachusetts Bay Transp. Auth.*, 390 F.3d 65, 90-93 (1st Cir. 2004). The court concluded that the "demeaning or disparaging guideline" does not discriminate based on viewpoint because it "is merely a 'reasonable ground rule' under which 'all advertisers on all sides of all questions are allowed to positively promote their own perspective and even to criticize other positions so long as they do not use demeaning or disparaging speech in their

attacks.'" *American Freedom Def. Initiative*, 781 F.3d at 581-582 (brackets omitted) (quoting *Ridley*, 390 F.3d at 91). The court further observed, however, that "a demeaning or disparaging guideline that would protect certain groups or individuals but not others" would create a "potential *R.A.V.* problem." *Id.* at 583 (citing *Ridley*, 390 F.3d at 90 n.11).

Section 1052(a)'s disparagement provision does not depend on the "ideology," "opinion," or "perspective" of the trademark owner. *Rosenberger* v. *Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995). Nor does it depend on the identity of the person or group that the mark disparages. It therefore creates no significant danger that "favored" private viewpoints will be furthered or that "disfavored" messages will be suppressed. Cf. *American Freedom Def. Initiative*, 781 F.3d at 582 (explaining that the First Circuit has "rejected the contention that the demeaning or disparaging guideline is an attempt by the government 'to give one group an advantage over another in the marketplace of ideas'") (quoting *Ridley*, 390 F.3d at 91). The congressional judgment that disparaging marks should not be registered stands on solid constitutional footing in part because it prohibits registration of all such marks, regardless of the motivation for their use.[12]

---

[12] In his separate concurring and dissenting opinion below, Judge Dyk concluded that Section 1052(a) is facially constitutional because trademark registration is a benefit for commercial speech that reasonably may be denied for disparaging marks. Pet. App. 90a-97a. He would have held, however, that Section 1052(a) is unconstitutional as applied to this case because respondent's own "choice of mark reflects a clear desire to editorialize on cultural and political subjects. [Respondent] chose THE SLANTS at least in part to reclaim the negative racial stereotype it embodies." *Id.*

The danger of viewpoint discrimination is especially remote in the present context because trademarks are source identifiers in commerce that are not inherently expressive. While some trademarks have incidental expressive meaning, the essential function of a trademark is to identify and distinguish the source of goods or services in commerce. See, *e.g.*, *Wal-Mart Stores, Inc.* v. *Samara Bros., Inc.*, 529 U.S. 205, 212-213 (2000) (Good trademarks "'almost automatically tell a customer that they refer to a brand,' and 'immediately signal a brand or a product 'source.'") (quoting *Qualitex Co.* v. *Jacobson Prods. Co.*, 514 U.S. 159, 162-163 (1995)) (emphasis omitted); *Canal Co.* v. *Clark*, 180 U.S. (13 Wall.) 311, 322 (1872) ("The office of a trade-mark is to point out distinctively the origin, or ownership of the article to which it is affixed; or, in other words, to give notice who was the producer."). A word or symbol can serve that function without having any expressive meaning at all. Indeed, many of the most valuable trademarks—such as Exxon or Google—are arbitrary or fanciful terms with no preexisting meaning to consumers. See *Moseley* v. *V Secret Catalogue, Inc.*, 537 U.S. 418, 429 (2003).

In that respect, trademark law is unlike copyright law, which serves as "the engine of free expression." *Eldred* v. *Ashcroft*, 537 U.S. 186, 219 (2003) (citation omitted). The court of appeals therefore erred in

---

at 102a-103a. But if Congress or the PTO had drawn the distinction that Judge Dyk suggested—*i.e.*, approving respondent's application based on the "cultural and political" message that respondent sought to convey, even though THE SLANTS could not have been registered by an applicant that intended to disparage Asians—it would have introduced into the statute the very viewpoint discrimination that the First Amendment generally discountenances.

equating the two (Pet. App. 60a). Because the essential function of trademarks is to identify goods and services as emanating from a particular commercial source, trademarks are "commercial speech" and receive "a limited form of First Amendment protection." *San Francisco Arts & Athletics, Inc.* v. *United States Olympic Comm.*, 483 U.S. 522, 535 (1987) (citation omitted); see generally *Central Hudson Gas & Elec. Corp.* v. *Public Serv. Comm'n*, 447 U.S. 557 (1980). Here, where there is no affirmative restriction on speech and little risk of driving ideas from the marketplace, Congress has broad discretion to determine when to make federal resources available to support private speech—and by the same token, when to disassociate the government from such speech.

5. Limiting federal trademark registration to marks that are not disparaging furthers legitimate government interests

Because Section 1052(a)'s disparagement provision does not limit respondent's ability to speak, it is reviewed for a rational basis. *Ysursa*, 555 U.S. at 359; *Regan*, 461 U.S. at 549. There is no dispute that the government has a legitimate interest in creating a federal trademark-registration program. Having created that program, the government also has a legitimate interest in encouraging the use of non-disparaging marks in interstate commerce, rather than allowing that program to be used to increase the likelihood that "underrepresented groups in our society" will be "bombarded with demeaning messages in commercial advertising." Pet. App. 81a (Dyk, J., concurring in part and dissenting in part). Just as Congress may act to stop discrimination in restaurants and hotels because of its detrimental effects on interstate com-

merce, see *Katzenbach* v. *McClung*, 379 U.S. 294, 304-305 (1964); *Heart of Atlanta Motel, Inc.* v. *United States*, 379 U.S. 241, 251 (1964), Congress may decide that it is not in the public interest to encourage use of racial epithets to identify goods and services in commerce. See Pet. App. 115a, 117a-118a (Reyna, J., dissenting) ("Commercial speech that insults groups of people, particularly based on their race, gender, religion, or other demographic identity, tends to disrupt commercial activity and to undermine the stability of the marketplace in much the same manner as discriminatory conduct.").

The federal government is not unique in making that judgment; nearly all States prohibit state registration of disparaging marks, and non-registration of marks contrary to public order has been a feature of international agreements for over a century. See pp. 23-24, *supra*, and note 13, *infra*. The longstanding nature of the prohibition on registration of disparaging marks (and similar prohibitions) underscores that Section 1052(a) is not a law directed at restricting expression. See *American Library Ass'n*, 539 U.S. at 203-204 (plurality opinion) (treating libraries' historical practice of making content-based distinctions as a basis for upholding internet-filtering condition); see also *Walker*, 135 S. Ct. at 2248.

Congress also may legitimately decline to spend federal funds to provide a platform for disparaging marks or to give such marks indicia of government approval, such as certificates issued in the name of the United States under the seal of the PTO, recordation on the official register, and the federal registration ® symbol. See 15 U.S.C. 1057(a), 1111. Registration of a trademark does not reflect the government's en-

dorsement of any particular product, service, or registrant. See *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1220 n.3 (T.T.A.B. 1993). But "[w]hen the symbol for a federally registered trademark, ®, is affixed to a mark, it is a declaration by the federal government that it has approved that mark." *Blackhorse*, 112 F. Supp. 3d at 461.

Further, registration of racial slurs would result in the incorporation of such slurs into various official governmental communications. See pp. 22, 27-28, *supra*. The government has a substantial interest in disassociating itself from such messages. That is especially true because certificates of registration are used to obtain reciprocal recognition of U.S.-registered marks by foreign nations under the Paris Convention. See Art. 6^quinquies^(A)(1), 21 U.S.T. 1643, 828 U.N.T.S. 331.[13]

6. The court of appeals' concern about inconsistent enforcement does not justify facial invalidation of Section 1052(a)'s disparagement provision

The court of appeals based its decision in part on its concern that Section 1052(a)'s disparagement pro-

---

[13] Under the Paris Convention, "Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article." Art. 6^quinquies^(A)(1), 21 U.S.T. 1643, 828 U.N.T.S. 331. One of the reservations is that a party may deny recognition of marks that are "contrary to morality or public order." Art. 6^quinquies^(B)(3), 21 U.S.T. 1644, 828 U.N.T.S. 331. This language, which has been present in the treaty in this or a similar form since 1883, see Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, Art. 6, 25 Stat. 1376, signals the resistance of the international community to registration of trademarks of the sort contemplated here.

vision has not been enforced in a consistent manner. Pet. App. 32a-34a & nn.6-8. But concerns about outcomes in individual cases do not justify the "strong medicine" of facial invalidation. *Broadrick* v. *Oklahoma*, 413 U.S. 601, 613 (1973). Any inconsistencies reflected in prior PTO decisions provide no sound basis for holding that the agency must issue registration certificates to disparaging marks, no matter how offensive or egregious. See Pet. App. 81a n.2 (Dyk, concurring in part and dissenting in part) ("[T]he Board may have rendered inconsistent results in some cases, but this has no bearing on the facial validity of § 2(a).").

Respondent identifies (Cert. Br. 32-33) instances in which superficially similar marks were treated differently during registration. But analysis of whether a mark is disparaging requires consideration of the mark's meaning in relation to the particular goods and services for which registration is sought and the context in which the mark is used. See *Boulevard Entm't, Inc.*, 334 F.3d at 1341-1343. The fact that the marks shared superficial common features therefore does not establish that the marks were ultimately similar for purposes of registrability, or that the PTO erred by treating them differently.

In any event, the PTO examines more than 300,000 trademark applications each year. If an individual PTO examining attorney improperly allows a mark to be registered or improperly refuses registration, "such errors do not bind the USPTO to improperly register" or refuse to register similar marks in the future. *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174 (Fed. Cir. 2009), cert. denied, 558 U.S. 1149 (2010). An allegedly erroneous registration may be prevented be-

fore registration through an adversarial opposition proceeding, see 15 U.S.C. 1063, 1067, or corrected through the process of administrative cancellation, 15 U.S.C. 1064, 1067. The PTO's decisions in both types of administrative proceedings are subject to judicial review. See 15 U.S.C. 1071. A disappointed applicant who wishes to challenge the examining attorney's refusal of registration may likewise seek administrative and judicial review. See 15 U.S.C. 1070, 1071.

In providing these mechanisms, Congress recognized that registration errors may occasionally occur, while taking steps to facilitate their correction. Thus, even if respondent could identify clear inconsistencies between particular registration decisions, there would be no sound basis to conclude that Section 1052(a)'s disparagement provision is incapable of principled application. Indeed, individual examining attorneys could err in determining whether particular marks are ineligible for registration because they are generic or merely descriptive; yet no one has suggested that those content-based limitations pose First Amendment concerns.[14]

---

[14] Respondent is wrong to suggest (Cert. Br. 30) that Section 1052(a)'s disparagement provision is impermissibly vague. Because the only consequence of a PTO determination that a particular mark is disparaging is that registration of the mark is refused, an applicant's uncertainty as to the status of his own mark is unlikely to deter him from using the mark or from seeking registration. The vagueness standard that applies here therefore is significantly less stringent than when a challenged law prohibits speech or imposes civil or criminal penalties, where uncertainty as to the law's scope has a greater potential to chill speech. See *Finley*, 524 U.S. at 588-589. The term "disparage" in Section 1052(a) has been given a settled legal meaning, and the PTO directs trademark examining attorneys to apply this legal stand-

While Congress cannot prohibit the use of disparaging terms to express ideas, the government has no obligation to support such speech. The Constitution does not put Congress to the choice of either eliminating the federal trademark-registration program altogether or promoting the use of racial slurs in interstate commerce.

---

ard using an objective test for evaluating record evidence, not their own subjective views. See *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 944 (2015); PTO, *Trademark Manual of Examining Procedure (TMEP)* § 1203.03(b)(1) (Oct. 2016), https://mpep.uspto.gov/RDMS/TMEP/current. The public therefore has fair notice as to the standards for, and evidence relevant to, determining which marks are unregistrable. See also note 9, *supra* (noting that the Court did not grant certiorari on the vagueness issue).

CONCLUSION

The judgment of the court of appeals should be reversed.

Respectfully submitted.

IAN HEATH GERSHENGORN
Acting Solicitor General
BENJAMIN C. MIZER
Principal Deputy Assistant Attorney General
MALCOLM L. STEWART
Deputy Solicitor General
NICOLE A. SAHARSKY
Assistant to the Solicitor General
DOUGLAS N. LETTER
MARK R. FREEMAN
DANIEL TENNY
JOSHUA M. SALZMAN
Attorneys

SARAH HARRIS
General Counsel
NATHAN K. KELLEY
Solicitor
THOMAS W. KRAUSE
Deputy Solicitor
CHRISTINA J. HIEBER
THOMAS L. CASAGRANDE
MOLLY R. SILFEN
MARY BETH WALKER
Associate Solicitors
U.S. Patent and Trademark Office

NOVEMBER 2016

APPENDIX

1. U.S. Const. Amend. I provides:

Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.

2. 15 U.S.C. 1051 provides:

Application for registration; verification

(a) Application for use of trademark

(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify that—

(A) the person making the verification believes that he or she, or the juristic person in whose behalf

he or she makes the verification, to be the owner of the mark sought to be registered;

(B) to the best of the verifier's knowledge and belief, the facts recited in the application are accurate;

(C) the mark is in use in commerce; and

(D) to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, except that, in the case of every application claiming concurrent use, the applicant shall—

(i) state exceptions to the claim of exclusive use; and

(ii) shall[1] specify, to the extent of the verifier's knowledge—

(I) any concurrent use by others;

(II) the goods on or in connection with which and the areas in which each concurrent use exists;

(III) the periods of each use; and

(IV) the goods and area for which the applicant desires registration.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director.

---

[1] So in original. The word "shall" probably should not appear.

The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(b) Application for bona fide intention to use trademark

(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the goods in connection with which the applicant has a bona fide intention to use the mark, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify—

(A) that the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be entitled to use the mark in commerce;

(B) the applicant's bona fide intention to use the mark in commerce;

(C) that, to the best of the verifier's knowledge and belief, the facts recited in the application are accurate; and

(D) that, to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form

thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

Except for applications filed pursuant to section 1126 of this title, no mark shall be registered until the applicant has met the requirements of subsections (c) and (d) of this section.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(c) Amendment of application under subsection (b) to conform to requirements of subsection (a)

At any time during examination of an application filed under subsection (b) of this section, an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this chapter, by amending his or her application to bring it into conformity with the requirements of subsection (a) of this section.

(d) Verified statement that trademark is used in commerce

(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 1063(b)(2) of this title to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Director and payment of the prescribed fee, a verified statement

that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce. Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 1052 of this title. The notice of registration shall specify the goods or services for which the mark is registered.

(2) The Director shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Director may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the

mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Director shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

(3) The Director shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.

(4) The failure to timely file a verified statement of use under paragraph (1) or an extension request under paragraph (2) shall result in abandonment of the application, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, in which case the time for filing may be extended, but for a period not to exceed the period specified in paragraphs (1) and (2) for filing a statement of use.

(e) Designation of resident for service of process and notices

If the applicant is not domiciled in the United States the applicant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last desig-

nation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.

3. 15 U.S.C. 1052 provides:

Trademarks registrable on principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director

when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became

distinctive of the applicant's goods in commerce before December 8, 1993.

A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.

4. 15 U.S.C. 1053 provides:

Service marks registrable

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.

5. 15 U.S.C. 1065 provides:

Incontestability of right to use mark under certain conditions

Except on a ground for which application to cancel may be filed at any time under paragraphs (3) and (5) of section 1064 of this title, and except to the extent, if

any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark, the right of the owner to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: *Provided*, That—

(1) there has been no final decision adverse to the owner's claim of ownership of such mark for such goods or services, or to the owner's right to register the same or to keep the same on the register; and

(2) there is no proceeding involving said rights pending in the United States Patent and Trademark Office or in a court and not finally disposed of; and

(3) an affidavit is filed with the Director within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and other matters specified in paragraphs (1) and (2) of this section; and

(4) no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit with the Director within one year after the expiration of any period of five consecutive years after the date of publication of a mark under the provisions of subsection (c) of section 1062 of this title.

The Director shall notify any registrant who files the above-prescribed affidavit of the filing thereof.

6. 15 U.S.C. 1114 provides in pertinent part:

Remedies; infringement; innocent infringement by printers and publishers

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or ser-

vices on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

As used in this paragraph, the term "any person" includes the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the authorization and consent of the United States, and any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

* * * * *

7. 15 U.S.C. 1115 provides:

Registration on principal register as evidence of exclusive right to use mark; defenses

(a) Evidentiary value; defenses

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b) of this section, which might have been asserted if such mark had not been registered.

(b) Incontestability; defenses

To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 1065 of this title, or in the renewal application

filed under the provisions of section 1059 of this title if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 1114 of this title, and shall be subject to the following defenses or defects:

(1) That the registration or the incontestable right to use the mark was obtained fraudulently; or

(2) That the mark has been abandoned by the registrant; or

(3) That the registered mark is being used by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or

(5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of

the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1062 of this title: *Provided, however*, That this defense or defect shall apply only for the area in which such continuous prior use is proved; or

(6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under subsection (c) of section 1062 of this title of the registered mark of the registrant, and not abandoned: *Provided, however*, That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant's mark; or

(7) That the mark has been or is being used to violate the antitrust laws of the United States; or

(8) That the mark is functional; or

(9) That equitable principles, including laches, estoppel, and acquiescence, are applicable.

8. 15 U.S.C. 1125 provides:

False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or

any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(3) In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.

(b) Importation

Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.

(c) Dilution by blurring; dilution by tarnishment

(1) Injunctive relief

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

(2) Definitions

(A) For purposes of paragraph (1), a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(B) For purposes of paragraph (1), "dilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

(i) The degree of similarity between the mark or trade name and the famous mark.

(ii) The degree of inherent or acquired distinctiveness of the famous mark.

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

(iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), "dilution by tarnishment" is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

(3) Exclusions

The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with—

(i) advertising or promotion that permits consumers to compare goods or services; or

(ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any noncommercial use of a mark.

(4) Burden of proof

In a civil action for trade dress dilution under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that—

(A) the claimed trade dress, taken as a whole, is not functional and is famous; and

(B) if the claimed trade dress includes any mark or marks registered on the principal register, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such registered marks.

(5) Additional remedies

In an action brought under this subsection, the owner of the famous mark shall be entitled to injunctive relief as set forth in section 1116 of this title. The owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity if—

(A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after October 6, 2006; and

(B) in a claim arising under this subsection—

(i) by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or

(ii) by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.

(6) Ownership of valid registration a complete bar to action

The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this chapter shall be a complete bar to an action against that person, with respect to that mark, that—

(A) is brought by another person under the common law or a statute of a State; and

(B)(i) seeks to prevent dilution by blurring or dilution by tarnishment; or

(ii) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

(7) Savings clause

Nothing in this subsection shall be construed to impair, modify, or supersede the applicability of the patent laws of the United States.

(d) Cyberpiracy prevention

(1)(A) A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person—

(i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and

(ii) registers, traffics in, or uses a domain name that—

(I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;

(II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or

(III) is a trademark, word, or name protected by reason of section 706 of title 18 or section 220506 of title 36.

(B)(i) In determining whether a person has a bad faith intent described under subparagraph (A), a court may consider factors such as, but not limited to—

(I) the trademark or other intellectual property rights of the person, if any, in the domain name;

(II) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person;

(III) the person's prior use, if any, of the domain name in connection with the bona fide offering of any goods or services;

(IV) the person's bona fide noncommercial or fair use of the mark in a site accessible under the domain name;

(V) the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

(VI) the person's offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any goods or services, or the person's prior conduct indicating a pattern of such conduct;

(VII) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct;

(VIII) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and

(IX) the extent to which the mark incorporated in the person's domain name registration is or

is not distinctive and famous within the meaning of subsection (c).

(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful.

(C) In any civil action involving the registration, trafficking, or use of a domain name under this paragraph, a court may order the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark.

(D) A person shall be liable for using a domain name under subparagraph (A) only if that person is the domain name registrant or that registrant's authorized licensee.

(E) As used in this paragraph, the term "traffics in" refers to transactions that include, but are not limited to, sales, purchases, loans, pledges, licenses, exchanges of currency, and any other transfer for consideration or receipt in exchange for consideration.

(2)(A) The owner of a mark may file an in rem civil action against a domain name in the judicial district in which the domain name registrar, domain name registry, or other domain name authority that registered or assigned the domain name is located if—

(i) the domain name violates any right of the owner of a mark registered in the Patent and Trademark Office, or protected under subsection (a) or (c) of this section; and

(ii) the court finds that the owner—

(I) is not able to obtain in personam jurisdiction over a person who would have been a defendant in a civil action under paragraph (1); or

(II) through due diligence was not able to find a person who would have been a defendant in a civil action under paragraph (1) by—

(aa) sending a notice of the alleged violation and intent to proceed under this paragraph to the registrant of the domain name at the postal and e-mail address provided by the registrant to the registrar; and

(bb) publishing notice of the action as the court may direct promptly after filing the action.

(B) The actions under subparagraph (A)(ii) shall constitute service of process.

(C) In an in rem action under this paragraph, a domain name shall be deemed to have its situs in the judicial district in which—

(i) the domain name registrar, registry, or other domain name authority that registered or assigned the domain name is located; or

(ii) documents sufficient to establish control and authority regarding the disposition of the registration and use of the domain name are deposited with the court.

(D)(i) The remedies in an in rem action under this paragraph shall be limited to a court order for the forfeiture or cancellation of the domain name or the transfer of the domain name to the owner of the mark. Upon receipt of written notification of a filed, stamped

copy of a complaint filed by the owner of a mark in a United States district court under this paragraph, the domain name registrar, domain name registry, or other domain name authority shall—

(I) expeditiously deposit with the court documents sufficient to establish the court's control and authority regarding the disposition of the registration and use of the domain name to the court; and

(II) not transfer, suspend, or otherwise modify the domain name during the pendency of the action, except upon order of the court.

(ii) The domain name registrar or registry or other domain name authority shall not be liable for injunctive or monetary relief under this paragraph except in the case of bad faith or reckless disregard, which includes a willful failure to comply with any such court order.

(3) The civil action established under paragraph (1) and the in rem action established under paragraph (2), and any remedy available under either such action, shall be in addition to any other civil action or remedy otherwise applicable.

(4) The in rem jurisdiction established under paragraph (2) shall be in addition to any other jurisdiction that otherwise exists, whether in rem or in personam.

9. 15 U.S.C. 1127 provides in pertinent part:

Construction and definitions; intent of chapter

In the construction of this chapter, unless the contrary is plainly apparent from the context—

* * * * *

The term "trademark" includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The term "service mark" means any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

* * * * *

The term "mark" includes any trademark, service mark, collective mark, or certification mark.

* * * * *

The term "registered mark" means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase "marks registered in the Patent and Trademark Office" means registered marks.

* * * * *

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF FOR RESPONDENT

STUART BANNER
EUGENE VOLOKH
UCLA School of Law
Supreme Court Clinic
405 Hilgard Ave.
Los Angeles, CA 90095

JOHN C. CONNELL
Counsel of Record
RONALD D. COLEMAN
JOEL G. MACMULL
Archer & Greiner, P.C.
One Centennial Square
P.O. Box 3000
Haddonfield, NJ 08033
(856) 795-2121
jconnell@archerlaw.com

QUESTIONS PRESENTED

The disparagement clause in section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), prohibits the registration of a trademark that "may disparage ... persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."

The Questions Presented are:

1. Whether the disparagement clause bars the registration of respondent's trademark.

2. Whether the disparagement clause is contrary to the First Amendment.

3. Whether the disparagement clause is unconstitutionally vague under the First and Fifth Amendments.

TABLE OF CONTENTS

QUESTIONS PRESENTED i

TABLE OF AUTHORITIES iii

STATEMENT 1

ARGUMENT 10

I. Certiorari should be granted. 10

II. The judgment of the Court of Appeals should be affirmed. 13

A. The Lanham Act's disparagement clause does not bar the registration of respondent's trademark. 13

B. The Lanham Act's disparagement clause is contrary to the First Amendment. 21

C. The Lanham Act's disparagement clause is unconstitutionally vague. 30

CONCLUSION 34

TABLE OF AUTHORITIES

CASES

14 Penn Plaza LLC v. Pyett, 556 U.S. 247 (2009) 12
Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc., 133 S. Ct. 2321 (2013) 8, 26, 27
B & B Hardware, Inc. v. Hargis Indus., Inc., 135 S. Ct. 1293 (2015) 22
Bolger v. Youngs Drug Prods. Corp., 463 U.S. 60 (1983) 24
Bond v. United States, 134 S. Ct. 2077 (2014) 12
Brown v. Entertainment Merchants Ass'n, 564 U.S. 786 (2011) 24
Carey v. Population Servs., Int'l, 431 U.S. 678 (1977) 24
Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n, 447 U.S. 557 (1980) 30
Coates v. City of Cincinnati, 402 U.S. 611 (1971) 31
Davenport v. Washington Educ. Ass'n, 551 U.S. 177 (2007) 26
FCC v. Fox Television Stations, Inc., 132 S. Ct. 2307 (2012) 30
Forsyth Cty. v. Nationalist Movement, 505 U.S. 123 (1992) 24
Friedman v. Rogers, 440 U.S. 1 (1979) 28, 29
Grayned v. City of Rockford, 408 U.S. 104 (1972) 33
Hustler Magazine, Inc. v. Falwell, 485 U.S. 46 (1988) 24
In re McGinley, 660 F.2d 481 (C.C.P.A. 1981) 5

KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111 (2004) 22
Leathers v. Medlock, 499 U.S. 439 (1991) 25
Legal Servs. Corp. v. Velazquez, 531 U.S. 533 (2001) 26
NEA v. Finley, 524 U.S. 569 (1998) 26, 27
R.A.V. v. City of St. Paul, 505 U.S. 377 (1992) 30
Reed v. Town of Gilbert, 135 S. Ct. 2218 (2015) 23
Regan v. Taxation With Representation of Wash., 461 U.S. 540 (1983) 26
Reno v. ACLU, 521 U.S. 844 (1997) 33
Riley v. Nat'l Fed'n of the Blind, 487 U.S. 781 (1988) 29
Rosenberger v. Rector and Visitors of the Univ. of Va., 515 U.S. 819 (1995) 21
Rust v. Sullivan, 500 U.S. 173 (1991) 26
Simon & Schuster, Inc. v. Members of the N.Y. Crime Victims Bd., 502 U.S. 105 (1991) 25
Snyder v. Phelps, 562 U.S. 443 (2011) 24
Sorrell v. IMS Health Inc., 564 U.S. 552 (2011) 25, 29
Texas v. Johnson, 491 U.S. 397 (1989) 24
Thompson v. Western States Med. Ctr., 535 U.S. 357 (2002) 30
United States v. Playboy Entertainment Group, Inc., 529 U.S. 803 (2000) 25
Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc., 455 U.S. 489 (1982) 31
Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205 (2000) 22

Walker v. Texas Div., Sons of Confederate Veterans, Inc., 135 S. Ct. 2239 (2015) 27, 28
Ysursa v. Pocatello Educ. Ass'n, 555 U.S. 353 (2009) 26

ADMINISTRATIVE DECISIONS

Boswell v. Mavety Media Group Ltd., 52 U.S.P.Q.2d 1600, 1999 WL 1040108 (TTAB 1999) 17
In re Heeb Media, LLC, 89 U.S.P.Q.2d 1071, 2008 WL 5065114 (TTAB 2008) 2, 32

STATUTES

15 U.S.C. § 1052(a) ..... passim
15 U.S.C. § 1057(b) 22
15 U.S.C. § 1065 23
15 U.S.C. § 1072 22
15 U.S.C. § 1115(a) 22
15 U.S.C. § 1115(b) 23
15 U.S.C. § 1127 17

LEGISLATIVE MATERIAL

60 Stat. 427 (1946) 20
H.R. 4744, 76th Cong., 1st Sess. (1939), § 2(a) 19
H.R. Rep. No. 219, 79th Cong., 1st Sess. (1945) 20
Inter-American Convention for Trade Mark and Commercial Protection. 46 Stat. 2907 (1931) 20
S. Rep. No. 1333, 79th Cong., 2d Sess. 5 (1946) 20

Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents, 76th Cong., 1st Sess. (1939) 20

OTHER AUTHORITIES

Randall Kennedy, *Nigger: The Strange Career of a Troublesome Word* (2002) 2
McCarthy on Trademarks and Unfair Competition (4th ed. Westlaw) 27
Donald S. Passman, *All You Need to Know About the Music Business* (8th ed. 2012) 23
Pet. for Cert., *Pro-Football, Inc. v. Blackhorse*, No. 15-1311 (filed Apr. 25, 2016) 11
Richard Stim, *Music Law: How to Run Your Band's Business* (8th ed. 2015) 23

STATEMENT

In the decision below, the en banc Court of Appeals correctly held that the disparagement clause of the Lanham Act is contrary to the First Amendment. This provision bars the registration of a trademark that "may disparage ... persons, living or dead." 15 U.S.C. § 1052(a). As the Court of Appeals found, the disparagement clause discriminates on the basis of viewpoint and content, by imposing a substantial burden on speech with a particular message. The government offers no justification for this discriminatory burden on speech other than its interest in preventing offense to listeners, but that is not a valid basis for restricting expression.

Certiorari should nevertheless be granted. This issue is undeniably important. The Court is very likely to address it in the near future, in another case if not in this one. Meanwhile, respondent Simon Tam waits in limbo. His trademark rights will not be secure until the Court resolves this issue once and for all.

1. Simon Tam is an Asian-American musician, lecturer, and political activist. He is the founder and leader of The Slants, a rock band based in Portland, Oregon. When Tam formed the band in 2006, his purpose was not just to play music. He also intended the band to be a vehicle for expressing his views on discrimination against Asian-Americans. To that end, he recruited Asian-American band members, and he called the band The Slants.

In choosing that name, Tam was following in the long tradition of "reappropriation," in which members of minority groups have reclaimed terms that were once directed at them as insults and turned them outward as badges of pride. In recent times, the most conspicuous examples have been words such as "queer," "dyke," and so on—formerly derogatory terms that have been so successfully adopted by members of the gay and lesbian community that they have now lost most, if not all, of their pejorative connotations. Members of several other groups have pursued the same strategy. As Randall Kennedy observes:

> Many blacks also do with *nigger* what other members of marginalized groups have done with slurs aimed at shaming them. They have thrown the slur right back in their oppressors' faces. They have added a positive meaning to *nigger*, just as women, gays, lesbians, poor whites, and children born out of wedlock have defiantly appropriated and revalued such words as *bitch*, *cunt*, *queer*, *dyke*, *redneck*, *cracker*, and *bastard*.

Randall Kennedy, *Nigger: The Strange Career of a Troublesome Word* 48 (2002).[1]

---

[1] Before the PTO, Tam did not characterize his use of the name as reappropriation, because TTAB precedent foreclosed the argument that reappropriation of a term can render a mark non-disparaging. *See In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114 (TTAB 2008). The TTAB nevertheless recognized that Tam's use of the name was "an attempt ... to wrest 'ownership' of the term from those who might use it with the intent to disparage." Pet. App. 175a. The Court of Appeals

Tam aimed to do the same for Asian-Americans. "We want to take on these stereotypes that people have about us, like the slanted eyes, and own them," he explained. Fed. Cir. JA 4. He observed: "For our band, we're not just Chinese, we're not just Vietnamese, we're kind of a pan-Asian band that celebrates all the different Asian cultures out there .... Everyone in the band really loves the fact that we can try and empower Asian Americans and say, 'You know what? We are slanted. Who cares? We're proud of that.'" Fed. Cir. JA 45.

In their music, as the Court of Appeals found, "Mr. Tam and his band weigh in on cultural and political discussions about race and society." Pet. App. 10a. Sometimes that takes the form of wry commentary. The Slants' first album is called "Slanted Eyes, Slanted Hearts." Their fourth is "The Yellow Album," a title that combines references to the Beatles' 1968 "White Album" and Jay-Z's 2003 "Black Album" with a reference to the once-common use of the color yellow to refer pejoratively to Asians, as in the phrase "Yellow Peril."

At other times, The Slants come closer to straightforward advocacy. For example, the chorus of their song "Sakura, Sakura" is:

> We sing for the Japanese and the Chinese and
> all the dirty knees.

---

likewise recognized that Tam "seeks to shift the meaning of, and thereby reclaim, an emotionally charged word." Pet. App. 24a.

> Can you see me? We sing in harmony for the babies in the alleys.

The title of "Sakura, Sakura" refers to the well-known Japanese folk song of the same name ("sakura" is Japanese for "cherry blossom"). The Slants' song incorporates part of the melody of the folk song. The first line of the chorus recalls a schoolyard taunt familiar to many Asian-Americans—"Chinese, Japanese, dirty knees, look at these." As Tam has explained, The Slants "feel strongly that Asians should be proud of their cultural heritage, and not be offended by stereotypical descriptions." Pet. App. 10a (brackets omitted).

In 2011, Tam sought to register THE SLANTS as a trademark. Pet. App. 10a. The examiner refused to register the mark, on the ground that it is disparaging to "persons of Asian descent." Pet. App. 10a.

2. The Trademark Trial and Appeal Board affirmed. Pet. App. 162a-182a. The Board acknowledged that Tam's purpose in naming his band The Slants was "an attempt not to disparage, but rather to wrest 'ownership' of the term from those who might use it with the intent to disparage." Pet. App. 175a. The Board nevertheless determined that "[t]he evidence of public perception of the meaning of THE SLANTS, as used in connection with applicant's services, shows that meaning to be a derogatory reference to people of Asian descent." Pet. App. 174a. The Board concluded that "[t]he fact that applicant has good intentions underlying his use of the term does not obviate the fact that a substantial composite of

the referenced group find the term objectionable." Pet. App. 181a.

Tam appealed to the Court of Appeals for the Federal Circuit. He argued that the Board erred in finding his trademark unregistrable under section 2(a) of the Lanham Act, and that section 2(a)'s disparagement clause is contrary to the First Amendment and unconstitutionally vague.

3. A panel of the Court of Appeals affirmed. Pet. App. 123a-161a. The Court of Appeals found that "[t]he evidence here supports the Board's finding that the mark THE SLANTS likely refers to people of Asian descent." Pet. App. 128a. The court also found that "[s]ubstantial evidence supports the Board's finding that the mark THE SLANTS is likely offensive to a substantial composite of people of Asian descent." Pet. App. 130a. The Court of Appeals relied on the precedent of its predecessor court, the Court of Customs and Patent Appeals, to reject Tam's constitutional arguments. Pet. App. 131a-132a (citing *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981)).

Judge Moore wrote a separate opinion urging the Court of Appeals to reconsider the constitutionality of section 2(a)'s disparagement clause. Pet. App. 135a-161a (Moore, J., additional views).

4. The en banc Court of Appeals vacated the Board's decision and remanded the case to the Board for further proceedings. Pet. App. 1a-122a. The court began by observing that "Mr. Simon Shiao Tam named his band THE SLANTS to make a statement about racial and cultural issues in this country. With

his band name, Mr. Tam conveys more about our society than many volumes of undisputedly protected speech." Pet. App. 2a. The en banc court reinstated the panel's holding that the name is "disparaging" and is thus unregistrable under section 2(a). Pet. App. 12a n.3. But the en banc court held that section 2(a)'s disparagement clause is contrary to the First Amendment.

The Court of Appeals concluded that the disparagement clause discriminates on the basis of viewpoint and content. As the court observed, "[t]he PTO rejects marks under § 2(a) when it finds the marks refer to a group in a negative way, but it permits the registration of marks that refer to a group in a positive, non-disparaging manner." Pet. App. 21a. The court concluded: "Section 2(a) is a viewpoint-discriminatory regulation of speech, created and applied in order to stifle the use of certain disfavored messages. Strict scrutiny therefore governs its First Amendment assessment—and no argument has been made that the measure survives such scrutiny." Pet. App. 23a-24a.

The Court of Appeals further held that the disparagement clause could not be upheld as a regulation of commercial speech. The court noted that the disparagement clause regulates the expressive aspects of a trademark, not the mark's commercial function as the identifier of the source of a good or service. Pet. App. 24a. "Importantly," the court noted, "*every time* the PTO refuses to register a mark under § 2(a), it does so because it believes the mark conveys an expressive message—a message that is disparaging to certain groups." Pet. App. 25a. The

court observed that the First Amendment does not permit content-based regulation of commercial speech where the discrimination is based on the speech's expressive features. Pet. App. 25a-26a.

The Court of Appeals rejected the government's contention that section 2(a) restricts no speech and is thus immune from First Amendment scrutiny. Pet. App. 28a-40a. The court observed that the First Amendment prohibits content-based and viewpoint-based *burdens* on speech, just as it prohibits similarly discriminatory *bans* on speech. Pet. App. 28a-30a. The court recognized that the legal advantages of trademark registration are so significant that "the § 2(a) bar on registration creates a strong disincentive to choose a 'disparaging' mark." Pet. App. 32a.

The Court of Appeals also rejected the government's suggestion that trademarks should receive no First Amendment protection on the theory that trademark registrations are government speech. Pet. App. 40a-47a. The court held that registration does not change the fact that trademarks are private speech, not government speech. Pet. App. 40a-41a. The court further held that the accoutrements of registration, such as the registrant's right to use the ® symbol, the placement of the mark on the Principal Register, and the PTO's issuance of a registration certificate, "do not convert the underlying speech to government speech." Pet. App. 41a. As the court noted, "the PTO routinely registers marks that no one can say the government endorses," such as CAPITALISM SUCKS DONKEY BALLS and MURDER 4 HIRE. Pet. App. 43a. The court observed, moreover, that "[c]opyright registration has identical accoutre-

ments," so the government's theory would allow it to deny copyrights to works that disparaged others, an outcome that would clearly violate the First Amendment. Pet. App. 41a.

The Court of Appeals likewise rejected, on two grounds, the government's argument that section 2(a) is a government subsidy exempt from strict scrutiny. Pet. App. 47a-61a. First, the court noted that under the unconstitutional conditions doctrine, the government may not attach "'conditions that seek to leverage funding to regulate speech outside the contours of the program itself.'" Pet. App. 51a (quoting *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013)). Because trademark registration "is not a program through which the government is seeking to get its message out through recipients of funding," the court held, the government cannot condition trademark registration on the avoidance of a particular viewpoint. Pet. App. 52a.

Second, the Court of Appeals determined that trademark registration is not a subsidy. Pet. App. 52a-61a. As the court noted, "the subsidy cases have all involved government funding or government property." Pet. App. 53a. Trademark registration, by contrast, involves neither. "Unlike a subsidy consisting of, for example, HIV/AIDS funding, or tax exemptions, a trademark registration does not directly affect the public fisc," the court concluded. "Instead, a registered trademark redefines the nature of the markholder's rights as against the rights of other citizens." Pet. App. 57a. Thus "the system of trademark

registration is a regulatory regime, not a government subsidy program." Pet. App. 57a.

Finally, the Court of Appeals held that section 2(a)'s bar on disparaging trademarks would be contrary to the First Amendment even if it were classified as a regulation of commercial speech. Pet. App. 61a-67a. Under the intermediate scrutiny applicable to commercial speech, regulation must advance a substantial government interest, but the court found that "§ 2(a) immediately fails at this step," because "[t]he entire interest of the government in § 2(a) depends on disapproval of the message." Pet. App. 63a.

Judge O'Malley, joined by Judge Wallach, filed a concurring opinion. Pet. App. 68a-80a. She agreed that section 2(a)'s disparagement clause is contrary to the First Amendment. She also concluded that the disparagement clause is unconstitutionally vague.

Judge Dyk filed an opinion concurring in part and dissenting in part, which Judges Lourie and Reyna joined in part. Pet. App. 80a-104a. He concluded that section 2(a)'s disparagement clause is contrary to the First Amendment only as applied to marks, such as Simon Tam's, that are "both political and commercial." Pet. App. 102a. He would have upheld the clause as applied to "routine product identifiers," Pet. App. 89a, which he characterized as trademarks that "lack the kind of 'expressive character' that would merit First Amendment protection for offensive content." Pet. App. 90a.

Judge Lourie dissented. Pet. App. 104a-108a. In his view, the PTO's refusal to register a trademark "is not a denial of an applicant's right of free speech,"

because "Mr. Tam may use his trademark as he likes" even without federal registration. Pet. App. 105a.

Judge Reyna also dissented. Pet. App. 108a-122a. He concluded that trademarks are commercial speech and that section 2(a)'s disparagement clause satisfies the intermediate scrutiny applicable to commercial speech, in light of the "the government's substantial interest in the orderly flow of commerce." Pet. App. 119a.

ARGUMENT

The government's petition for certiorari should be granted, but the Questions Presented should be reformulated to reflect the issues in this case.

I. Certiorari should be granted.

The decision below is correct. The Court should nevertheless grant the petition for certiorari, for three reasons.

First, the issue is undeniably important. The Court of Appeals has invalidated a provision of the Lanham Act, a statute that plays a major role in regulating commerce. The constitutionality of section 2(a)'s disparagement clause is likely to return to the Court repeatedly in future cases until the Court puts the issue to rest.

Second, although Simon Tam prevailed in the Court of Appeals, his trademark rights will not be secure until this Court decides the issue once and for all. If the Court denies certiorari in this case, even if the PTO registers Tam's trademark, his registration

will be precarious, because of the possibility that the decision below will be overruled by this Court in a future case.

One such case has already reached the Court. The Washington Redskins have filed a petition for certiorari before judgment in a case that raises the same First Amendment and vagueness issues as does this case. Pet. for Cert., *Pro-Football, Inc. v. Blackhorse*, No. 15-1311 (filed Apr. 25, 2016). If the Court wishes to hear the two cases together, we urge the Court to do so now rather than waiting until the Fourth Circuit has decided the Redskins' case. It has already been five years since Simon Tam filed his trademark application. The PTO has halted the processing of all trademark applications raising disparagement issues, including Tam's, until the Court disposes of the government's certiorari petition in this case. Pet. 23. The Fourth Circuit has not yet held oral argument, so there may be no resolution of the Redskins' case for a year or more, particularly if the Fourth Circuit takes the case en banc. The Court should not hold this case for the Redskins' case.

Third, this case is an excellent vehicle. Simon Tam's trademark undisputedly has an expressive component along with a commercial component, so the Court will be able to evaluate the First Amendment's applicability to the full range of conceivable types of trademarks.

Moreover, this case involves two other important issues that are not captured by the government's unduly narrow Question Presented.

The first of these issues is one of statutory interpretation. Under section 2(a) of the Lanham Act, does THE SLANTS "disparage ... persons, living or dead"? At every stage of this litigation, Simon Tam has argued that section 2(a) does not bar the registration of his trademark. He is thus entitled to defend the judgment below on this ground. *14 Penn Plaza LLC v. Pyett*, 556 U.S. 247, 273 (2009). Even if that were not so, "it is a well-established principle governing the prudent exercise of this Court's jurisdiction that normally the Court will not decide a constitutional question if there is some other ground upon which to dispose of the case." *Bond v. United States*, 134 S. Ct. 2077, 2087 (2014) (citation and internal quotation marks omitted). A proper interpretation of section 2(a) is such a ground.

Section 2(a)'s disparagement clause has existed for 70 years, but the Court has never interpreted it. The PTO has been left to develop its own disparagement jurisprudence, which has wandered ever farther from the statute's text and from any reasonable understanding of what Congress intended. This case provides an opportunity for the Court to guide the PTO back to the text of the statute.

The second issue not captured by the government's Question Presented is whether section 2(a)'s disparagement clause is unconstitutionally vague. Simon Tam raised this issue below as well, so he is entitled to defend the Court of Appeals' judgment on this ground.

This is another issue the Court has never considered in the 70 years since the disparagement clause

was enacted. The PTO, left to its own devices, has produced a bewildering array of decisions granting or denying registration seemingly at random. As the Court of Appeals found, "[t]he PTO's record of trademark registrations and denials often appears arbitrary and is rife with inconsistency.... We see no rationale for the PTO's seemingly arbitrary registration decisions, let alone one that would give applicants much guidance." Pet. App. 33a n.7. As the two concurring judges found, the disparagement clause is "so vague that [it is] unconstitutional, whether or not it could survive Appellant's First Amendment challenge." Pet. App. 69a (O'Malley, J., concurring). It is time for this Court to intervene.

II. The judgment of the Court of Appeals should be affirmed.

The judgment below should be affirmed, on any of three grounds. First, as a matter of statutory construction, respondent's trademark does not "disparage ... persons, living or dead" under section 2(a). Second, the disparagement clause is contrary to the First Amendment. Third, the disparagement clause is unconstitutionally vague under the First and Fifth Amendments.

A. The Lanham Act's disparagement clause does not bar the registration of respondent's trademark.

Section 2(a)'s disparagement clause prohibits the registration of a trademark that "[c]onsists of or comprises ... matter which may disparage ... persons, living or dead, institutions, beliefs, or national

symbols, or bring them into contempt, or disrepute." 15 U.S.C. § 1052(a). This clause does not bar registration of THE SLANTS, for two reasons. First, the mark is simply not disparaging. Second, the statutory phrase "persons, living or dead" refers solely to natural and juristic persons, not to non-juristic collective entities like racial or ethnic groups.

1. THE SLANTS, as used by Simon Tam to refer to his band, is not disparaging. Whether a word is disparaging depends primarily on context. Even "nigger" and its variants are not disparaging when used with pride and understood that way. For example, one of the most well-known and influential musical groups of the 1980s and 1990s was N.W.A., which fans knew stood for "Niggaz Wit Attitudes." (Anyone who did not know would have figured it out when the group released their second album, *Niggaz4Life*.) "Niggers" or "niggaz" can certainly be used in a disparaging way, but the members of N.W.A. did not use the word that way, and the group's millions of fans did not interpret the name as disparaging.

The same is true of The Slants. Simon Tam and his band members are not disparaging Asian-Americans. They are doing precisely the opposite; they are appropriating a slur and using it as a badge of pride. Simon Tam is not a bigot; he is fighting bigotry with the time-honored technique of seizing the bigots' own language. "Slant" can certainly be used in a disparaging way, but Tam is not using it that way. Even the most cursory awareness of the Slants' music and the way it is packaged makes that clear.

Nor do the Slants' fans think the band's name is disparaging. The Slants' fans are not racists eager to denigrate Asian-Americans. They are people who understand and appreciate what the Slants are doing. They get it. Only an uninformed philistine could find the band's name disparaging.

If the PTO interpreted the statute literally, with a dose of common sense, that would be enough to find that THE SLANTS does not "disparage" anyone. But rather than interpreting the statute literally, the PTO uses a two-part test that departs markedly from the text of the statute. To determine whether matter in a proposed trademark is disparaging, the PTO considers:

> 1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
>
> 2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

Pet. App. 171a-172a. This test has been endorsed by the Federal Circuit. Pet. App. 126a.

Both parts of the PTO's test contort the word "disparage" far beyond what the statute will bear. The

first part of the test tells examiners to rely on dictionary definitions of a word used in a trademark, but not to consider any of the contextual considerations that make up the ordinary meaning of the word "disparage," such as whether the applicant intends any disparagement, whether the applicant's customers perceive any disparagement, or whether an objective observer knowing the full context would find any disparagement. But the statute does not say "disparage, with reference solely to dictionary definitions and not context." The statute just says "disparage."

The second part of the test tells examiners to determine whether the mark "may be disparaging to a substantial composite of the referenced group." The PTO interprets "substantial composite" to mean "not necessarily a majority," but with no limit on how small a percentage of the referenced group is offended. Pet. App. 172a. Examiners are thus instructed to determine whether a mark disparages a vocal *minority* of a group, not whether the mark disparages the affected group generally.

In this case the PTO duly applied its test. Rather than considering the full context surrounding Simon Tam's use of THE SLANTS, the PTO simply looked up the word "slant" in several dictionaries. Pet. App. 163a-165a. Rather than asking whether THE SLANTS disparages Asian-Americans generally, the PTO quoted the views of a blogger and a few self-styled spokespeople for Asian-Americans, Pet. App. 167a-168a, to conclude that "a substantial composite of the referenced group find the term objectionable." Pet. App. 181a. Had the PTO followed the statute

rather than its two-part test, the result would have been different.

2. The PTO also erred in construing section 2(a)'s bar on the registration of marks that may disparage "persons, living or dead" to include marks that disparage non-juristic collective entities like racial and ethnic groups. In fact, the quoted phrase includes only natural and juristic persons.

"Person" is a defined term in the Lanham Act. Under section 45, "[t]he term 'person' ... includes a juristic person as well as a natural person. The term 'juristic person' includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law." 15 U.S.C. § 1127. Non-juristic collective entities incapable of suing and being sued, such as racial and ethnic groups, are not "persons" under this definition. Yet the PTO treats such groups as "persons" under the disparagement clause. *See, e.g., Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d 1600, 1999 WL 1040108, *5 (TTAB 1999).

The PTO is misinterpreting the statute. Section 2(a)'s disparagement clause bars the registration of marks—such as JOHN SMITH IS EVIL—that disparage *natural* persons. It also bars the registration of marks—such as MICROSOFT IS EVIL—that disparage *juristic* persons. But the disparagement clause explicitly does *not* bar the registration of marks that disparage collective entities that are not juristic persons. Thus one can register LEFTHANDERS ARE EVIL or REDHEADS ARE EVIL or even ASIAN-AMERICANS ARE

EVIL without running afoul of section 2(a)'s disparagement clause.

To be sure, each individual Asian-American is a natural person. But the statute cannot be read to bar marks that disparage Asian-Americans for this reason, because *all* collective entities are made up of natural persons, including lefthanders, redheads, and all manner of associations and organizations that are not "juristic person[s]" because they are not capable of suing and being sued. To read section 2(a) to bar marks that disparage racial or ethnic groups would be to read the definition of "person" right out of the Lanham Act.

This conclusion is doubly reinforced by the text of the sentence in which the disparagement clause is located. First, this sentence bars the registration of marks consisting of "matter which may disparage *or falsely suggest a connection with* persons, living or dead." 15 U.S.C. § 1052(a) (emphasis added). The italicized phrase makes perfect sense as applied to natural persons. It prohibits the registration of BARACK OBAMA aftershave, along the lines of the right of publicity, which was still in embryonic form when the Lanham Act was enacted. The italicized phrase also makes perfect sense as applied to juristic persons. It prohibits the registration of ROLLS-ROYCE aftershave, along the lines of the anti-dilution provisions that would later be added to the Lanham Act. But the italicized phrase makes no sense at all as applied to collective entities such as racial or ethnic groups that are not juristic persons. What would it even mean to "falsely suggest a connection with" Asian-Americans?

Second, the clause refers to "persons, living or dead." *Id.* Natural persons can be dead, and juristic persons can be dead when they cease to be juristic persons, as when a corporation is dissolved. But non-juristic collective entities cannot die in the ordinary meaning of the word. What would it mean for the entity called Asian-Americans to be "dead"?

The addition of the disparagement clause to federal trademark law was not intended to be an early step in the civil rights movement. The clause was added in 1939 to one of the bills that eventually became the Lanham Act in 1946. H.R. 4744, 76th Cong., 1st Sess. (1939), § 2(a). It is very unlikely that members of Congress were concerned about trademarks that were disparaging to racial or ethnic groups, either in 1939 or in 1946. At the time, it was not unusual for registered trademarks to include pejorative racial epithets. Trademarks with registrations in effect during this period included NIGGER HEAD golf equipment (No. 221,097, registered in 1926 for a 20-year term), NIGGER PRIZE HEAD ice cream (No. 301,747, registered in 1933 for a 20-year term), NIGGER IN DE CANE PATCH syrup (No. 186,950, registered in 1924 for a 20-year term and renewed in 1944 for another 20-year term), and NIGGER BABY oranges and grapefruit (No. 217,067, registered in 1926 for a 20-year term and renewed in 1946 for another 20-year term).[2] There is no evidence that the disparagement clause was intended to halt the registration of such trademarks. Rather, when the clause

---

[2] These trademarks are exhibits 7 through 10 in the appendix to the brief filed below in the Federal Circuit by amici Amanda Blackhorse et al.

was discussed in Congress, the only examples of disparagement anyone mentioned concerned natural persons (such as Abraham Lincoln and George Washington) and juristic persons (including the New York Athletic Club and Harvard University). *Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents*, 76th Cong., 1st Sess. 19-21 (1939).

The purpose of the disparagement clause was not to protect the civil rights of racial and ethnic minorities. Rather, the purpose appears to have been to bring American trademark law into conformity with the language of a recent treaty. In 1931, the United States ratified the Inter-American Convention for Trade Mark and Commercial Protection. 46 Stat. 2907 (1931). Article 3.4 of the Convention provided for the denial of registration to trademarks "[w]hich tend to expose persons, institutions, beliefs, national symbols or those of associations of public interest, to ridicule or contempt." One of the primary purposes of the Lanham Act was, as the House and Senate reports both explained, "[t]o carry out by statute our international commitments." H.R. Rep. No. 219, 79th Cong., 1st Sess. 4 (1945); S. Rep. No. 1333, 79th Cong., 2d Sess. 5 (1946). Indeed, the full title of the Lanham Act was "An Act to provide for the registration and protection of trade-marks used in commerce, to carry out the provisions of certain international conventions, and for other purposes." 60 Stat. 427 (1946). Section 2(a) slightly reworded the Inter-American Convention provision without any loss in meaning. It barred the registration of marks that "disparage" or "bring ... into contempt, or disrepute"

(rather than "expose ... to ridicule or contempt") the same list of plural nouns as in the Convention—persons, institutions, beliefs, and national symbols.

Congress would not turn its attention to protecting the rights of racial and ethnic minorities for many years to come. When it did, beginning with the Civil Rights Act of 1957, Congress would refer to race and ethnicity explicitly, unlike in the Lanham Act. Section 2(a) thus protects natural and juristic persons against disparagement; it does not protect racial and ethnic groups.

B. The Lanham Act's disparagement clause is contrary to the First Amendment.

The Court of Appeals correctly held that section 2(a)'s disparagement clause is contrary to the First Amendment. The clause imposes a significant content-based and viewpoint-based burden on speech for which the government can offer no lawful justification. The government proposes a variety of defenses of the disparagement clause, but none has any validity.

1. The disparagement clause discriminates on the basis of content, by singling out disparaging marks for disfavored treatment. The clause also discriminates on the basis of viewpoint, which is an "all the more blatant" and "egregious form of content discrimination." *Rosenberger v. Rector and Visitors of the Univ. of Va.*, 515 U.S. 819, 829 (1995). The disparagement clause permits the registration of marks that express a positive or neutral view of a person or

group, but bars the registration of marks that express a negative view. Applying the disparagement clause, the PTO has registered THINK ISLAM, but it has denied registration to STOP THE ISLAMISATION OF AMERICA. Pet. App. 21a-22a. The PTO has registered NATIONAL REPUBLICAN SENATORIAL COMMITTEE, but it has denied registration to REPUBLICANS SHOULDN'T BREED. Pet. App. 8a. The PTO has registered CELEBRASIANS and ASIAN EFFICIENCY, Pet. App. 21a, but—because it erroneously concluded that the mark expresses a negative view of Asian-Americans—the PTO denied registration to THE SLANTS.

The denial of registration is a significant blow, because a registered trademark is much more valuable than an unregistered trademark. As the Court has repeatedly recognized, "[r]egistration is significant. The Lanham Act confers important legal rights and benefits on trademark owners who register their marks." *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1300 (2015) (citation and internal quotation marks omitted); *see also KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117 (2004); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209 (2000). For example, registration serves as nationwide constructive notice of the registrant's claim of ownership, which eliminates any possible defense of good faith adoption after the date of registration. 15 U.S.C. § 1072. Registration constitutes prima facie evidence of the mark's validity and the registrant's exclusive right to use the mark. *Id.* §§ 1057(b), 1115(a). After five

years, a registered mark can become "incontestable." *Id.* §§ 1065, 1115(b).

The advantages of registration are as great in the music industry as in any other business. If another band were also to call themselves The Slants, registration would equip Tam with powerful tools in the event of litigation. These tools would likely be enough to deter other bands from calling themselves The Slants in the first place. For this reason, bands from ABBA to ZZ TOP routinely register their names as trademarks, and guides for musicians advise up-and-coming bands to do the same. *See, e.g.*, Richard Stim, *Music Law: How to Run Your Band's Business* 249, 259 (8th ed. 2015); Donald S. Passman, *All You Need to Know About the Music Business* 359-60 (8th ed. 2012).

Section 2(a)'s disparagement clause imposes a significant burden on speech with a particular content and viewpoint. It is thus "presumptively unconstitutional and may be justified only if the government can prove that [it is] narrowly tailored to serve compelling state interests." *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015).

The only interest the government asserts, and the only interest the disparagement clause advances, is that of protecting people from being offended by disparaging trademarks. *See, e.g.*, Pet. 21 (quoting Judge Dyk's characterization of the government's interest as "protect[ing] underrepresented groups in our society from being bombarded with demeaning messages in commercial advertising"). But the First Amendment does not allow the government to im-

pose burdens on speech for the purpose of protecting listeners against offense. *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55 (1988). "[S]peech cannot be restricted simply because it is upsetting." *Snyder v. Phelps*, 562 U.S. 443, 458 (2011). "Speech cannot be financially burdened, any more than it can be punished or banned, simply because it might offend." *Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123, 134-35 (1992).

Nor does the First Amendment permit the government to burden speech to protect society as a whole from being offended. Disparaging trademarks understandably arouse disgust, "but disgust is not a valid basis for restricting expression." *Brown v. Entertainment Merchants Ass'n*, 564 U.S. 786, 798 (2011). "If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." *Texas v. Johnson*, 491 U.S. 397, 414 (1989). Commercial speech is no more restrictable based on its offensive message than is noncommercial speech, *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71-72 (1983); *Carey v. Population Servs., Int'l*, 431 U.S. 678, 701 (1977), so the government's asserted interest would be impermissible even if trademarks were purely commercial speech.

2. The government offers four theories in defense of the disparagement clause, but none has any validity.

First, the government insists that the disparagement clause does not restrict any speech, because

Simon Tam may still call his band The Slants without a registered trademark. Pet. 10-12. But the First Amendment does not prohibit merely content-based *bans* on speech. It also prohibits the imposition of "a financial burden on speakers because of the content of their speech." *Simon & Schuster, Inc. v. Members of the N.Y. Crime Victims Bd.*, 502 U.S. 105, 115 (1991). As the Court has explained on several occasions, "the government's ability to impose content-based burdens on speech raises the specter that the government may effectively drive certain ideas or viewpoints from the marketplace." *Id.* at 116 (citing *Leathers v. Medlock*, 499 U.S. 439, 448-49 (1991)). "The Court has recognized that the 'distinction between laws burdening and laws banning speech is but a matter of degree' and that the 'Government's content-based burdens must satisfy the same rigorous scrutiny as its content-based bans.'" *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 565-66 (2011) (quoting *United States v. Playboy Entertainment Group, Inc.*, 529 U.S. 803, 812 (2000)).

The disparagement clause is a significant content-based burden. The advantages of trademark registration are so important in the marketplace that no rational person would use a trademark that cannot be registered rather than one that can. The disparagement clause effectively discourages the adoption of certain trademarks, just as surely as would a tax levied on businesses with disparaging names.

Second, the government characterizes trademark registration as a subsidy to trademark owners which the government may spend as it sees fit. Pet. 14-17. But trademark registration is not a subsidy. Money

flows from applicants to the government, not the other way around. In contrast, the Court's subsidy cases all involve actual disbursements of funds from the government to speakers (or the equivalent in the form of tax exemptions or payroll deductions). *See, e.g.*, *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321 (2013); *Ysursa v. Pocatello Educ. Ass'n*, 555 U.S. 353 (2009); *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177 (2007); *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533 (2001); *NEA v. Finley*, 524 U.S. 569 (1998); *Rust v. Sullivan*, 500 U.S. 173 (1991); *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540 (1983). Where the government is paying others to speak, it may choose whom to pay. But trademark registration does not involve any government payments to speakers.

Rather, trademark registration is a recording system, analogous to the federal registration systems for copyrights and patents, and like the title recording systems state governments operate for real property. In each of these systems, applicants who meet certain requirements may register their property, and registration gives the registrant certain legal rights that are unavailable to non-registrants. The government is acting as a regulator, not as a subsidizer. Just as the federal government does not subsidize copyright or patent holders, and just as state governments do not subsidize landowners who register their titles, the PTO does not subsidize trademark registrants. Classifying these recording systems as subsidies for First Amendment purposes would yield the bizarre result of allowing the gov-

ernment to deny copyrights to works with messages the government does not like.

In any event, the disparagement clause would be unconstitutional even if trademark registration were a subsidy. The government may not "leverage its power to award subsidies ... into a penalty on disfavored viewpoints." *Finley*, 524 U.S. at 587. When the government places speech-related conditions on the recipients of government funds, those conditions must "define the limits of the government spending program"—i.e., the conditions must advance "the activities Congress wants to subsidize." *AID*, 133 S. Ct. at 2328. Were the government to begin subsidizing trademark registrants, the First Amendment would thus allow the government to deny subsidies to registrants whose marks do a poor job of identifying the sources of goods or services. But the government could not deny these subsidies to registrants whose marks express disfavored viewpoints.

Third, the government suggests that a registered trademark is government speech rather than private speech. Pet. 17-20. But registration of a trademark does not convert the trademark into government speech. Registration does not connote government approval of the mark or the product to which the mark refers. 3 *McCarthy on Trademarks and Unfair Competition* § 19:3.50 (4th ed. Westlaw). Unlike license plates, *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2248 (2015), trademarks do not communicate messages from the government. They communicate messages from providers of goods and services. Unlike license plates, *id.* at 2248-49, trademarks are not a form of govern-

ment ID the public thinks of as government speech. Unlike license plates, *id.* at 2249, the government does not control the design or the content of trademarks. Trademarks are private speech.

As the Court of Appeals correctly noted, "the PTO routinely registers marks that no one can say the government endorses," such as RADICALLY FOLLOWING CHRIST IN MISSION TOGETHER, THINK ISLAM, GANJA UNIVERSITY, CAPITALISM SUCKS DONKEY BALLS, TAKE YO PANTIES OFF, and MURDER 4 HIRE. Pet. App. 43a. Moreover, if the issuance of a trademark registration were enough to convert a trademark to government speech, the issuance of a copyright would do the same for copyrighted works, which would allow the government to deny copyrights to works with content it disfavors.

Fourth, the government contends that trademarks are purely commercial speech. Pet. 20-21. But trademarks are not purely commercial speech, and the disparagement clause would be unconstitutional even if they were.

Trademarks have both commercial and expressive functions. They identify the sources of goods and services and they also express points of view. In some trademarks, perhaps, the expressive component may be so minimal that it can be disregarded. *Friedman v. Rogers*, 440 U.S. 1 (1979), for instance, involved a bare-bones trade name ("Texas State Optical") that did not "editorialize on any subject, cultural, philosophical, or political," or "make generalized observations even about commercial matters." *Id.* at 11. The Court accordingly treated this trade

name as commercial speech. *Id.* In other trademarks, such as THE SLANTS, THINK ISLAM, or DYKES ON BIKES, the expressive component is the dominant feature of the mark. Such marks *do* editorialize on cultural and political subjects. They do more than merely facilitate commercial transactions. In such cases, where speech's commercial and expressive functions "are inextricably intertwined, we cannot parcel out the speech, applying one test to one phrase and another test to another phrase. ... Therefore, we apply our test for fully protected expression." *Riley v. Nat'l Fed'n of the Blind*, 487 U.S. 781, 796 (1988).

Equally important, the disparagement clause regulates only the expressive component of trademarks, never the commercial component. When the PTO refuses registration under the disparagement clause, the PTO's decision is based on the point of view that the mark expresses. As the Court of Appeals correctly concluded, "*every time* the PTO refuses to register a mark under § 2(a), it does so because it believes the mark conveys an expressive message—a message that is disparaging to certain groups." Pet. App. 25a. The Court has made clear that "[c]ommercial speech is no exception" to the rule that "[t]he First Amendment requires heightened scrutiny whenever the government creates a regulation of speech because of disagreement with the message it conveys." *Sorrell*, 564 U.S. at 566 (internal quotation marks omitted). While the government may limit commercial advertising to prevent fraud, the government "may not prohibit only that commercial advertising

that depicts men in a demeaning fashion." *R.A.V. v. City of St. Paul*, 505 U.S. 377, 389 (1992).

In any event, even if trademarks were pure commercial speech, and even if the disparagement clause regulated trademarks' commercial components rather than their expressive components, the disparagement clause would still be contrary to the First Amendment. Under the *Central Hudson* test, the government would have to show that the disparagement clause directly advances a substantial state interest. *Thompson v. Western States Med. Ctr.*, 535 U.S. 357, 367 (2002); *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557, 566 (1980). Again, however, the government can advance no interest other than that of preventing offense, an interest the First Amendment renders off-limits.

C. The Lanham Act's disparagement clause is unconstitutionally vague.

The Due Process Clause "requires the invalidation of laws that are impermissibly vague." *FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012). The prohibition of vague laws serves two purposes: "first, that regulated parties should know what is required of them so they may act accordingly; second, precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory way." *Id.* "When speech is involved, rigorous adherence to these requirements is necessary to ensure that ambiguity does not chill protected speech." *Id.* For this reason, where a law burdens speech, "a more stringent vagueness test

should apply." *Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 499 (1982).

The disparagement clause fails any vagueness test, stringent or not. The PTO's record speaks for itself. The Court of Appeals catalogued some of the highlights, in finding that "[t]he PTO's record of trademark registrations and denials often appears arbitrary and is rife with inconsistency." Pet. App. 33a n.7. The PTO denied registration to HAVE YOU HEARD SATAN IS A REPUBLICAN, because it disparaged the Republican Party, but did not find THE DEVIL IS A DEMOCRAT disparaging. The PTO has registered FAGDOG on some occasions, and on other occasions has found FAGDOG disparaging. After citing these examples and others, the Court of Appeals appropriately concluded: "We see no rationale for the PTO's seemingly arbitrary registration decisions, let alone one that would give applicants much guidance." Pet. App. 33a n.7.

Part of the problem is the subjectivity inherent in deciding whether a word is disparaging. Different examiners in the PTO come to different conclusions about indistinguishable marks, because each has his or her own idea of what is disparaging. Just as the term "annoying" is an unconstitutionally vague basis for legal consequences because different people find different things annoying, *Coates v. City of Cincinnati*, 402 U.S. 611, 614 (1971), and just as "indecent" and "patently offensive" are unconstitutionally vague grounds for limiting speech because of "uncertainty among speakers about ... just what they mean," *Reno v. ACLU*, 521 U.S. 844, 871 (1997), the term "disparage" is too vague a basis for burdening speech.

But the PTO has made the vagueness problem even worse by construing the statute non-literally to bar the registration of marks that disparage amorphous groups as well as natural and juristic persons. It can be hard enough to tell whether a mark disparages an individual or a company, but it is often far more ambiguous whether a mark disparages a race, or a gender, or any of the infinite number of groups to which we all belong. It is no accident that the PTO's sorry record of inconsistency is made up of decisions involving the disparagement of amorphous groups rather than natural and juristic persons.

The PTO has compounded the problem by refusing to say how many members of the referenced group must perceive disparagement. All the PTO will say is that it must be "a substantial composite," which is "not necessarily a majority," Pet. App. 172a, but is presumably more than a single person. If a quarter or a third of the members of a group find a mark disparaging, is that a substantial composite? No one knows, not even the PTO's own examiners.

The PTO might as well be tossing a coin. The PTO granted registration to HEEB in 2004 as the name of a magazine, but denied registration to the same applicant for HEEB in 2008 as the name of a clothing line on the ground that the word is "a highly disparaging reference to Jewish people." *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114, *1 (TTAB 2008). The PTO denied registration in 2008 to MARRIAGE IS FOR FAGS on the ground that "fag" is "an offensive term for a gay man" (serial no. 77477549, office action 11/19/2008), but granted registration in 2005 to F.A.G. FABULOUS AND GAY. Pet.

App. 33a n.7. Applicants have no way to predict what the PTO will do.

The vagueness of the disparagement clause is almost certainly causing business owners to shy away from names the PTO might conceivably find disparaging, because it can be extraordinarily disruptive and costly to change the name of a product that is already in the market. The vagueness of a content-based speech regulation "raises special First Amendment concerns because of its obvious chilling effect on free speech." *Reno v. ACLU*, 521 U.S. at 871-72. The disparagement clause is a perfect example.

Vague speech restrictions do not just chill speech; they also facilitate "discriminatory enforcement," because a "vague law impermissibly delegates basic policy matters" to low-level decision-makers "for resolution on an *ad hoc* and subjective basis, with the attendant dangers of arbitrary and discriminatory application." *Grayned v. City of Rockford*, 408 U.S. 104, 108-09 (1972). The PTO's consideration and rejection of MARRIAGE IS FOR FAGS took place right in the midst of the controversy over California's Proposition 8, which prohibited same-sex marriage. The applicant lived in California. We will never know whether the PTO's examiner was discriminating against the view expressed in the trademark, and that is precisely why vague speech restrictions like the disparagement clause are so pernicious.

CONCLUSION

The petition for a writ of certiorari, with the Questions Presented reformulated as in this response, should be granted.

Respectfully submitted,

STUART BANNER
EUGENE VOLOKH
UCLA School of Law
Supreme Court Clinic
405 Hilgard Ave.
Los Angeles, CA 90095

JOHN C. CONNELL
Counsel of Record
RONALD D. COLEMAN
JOEL G. MACMULL
Archer & Greiner, P.C.
One Centennial Square
P.O. Box 3000
Haddonfield, NJ 08033
(856) 795-2121
jconnell@archerlaw.com

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF FOR RESPONDENT

STUART BANNER
EUGENE VOLOKH
UCLA School of Law
Supreme Court Clinic
405 Hilgard Ave.
Los Angeles, CA 90095

JOHN C. CONNELL
Counsel of Record
RONALD D. COLEMAN
JOEL G. MACMULL
Archer & Greiner, P.C.
One Centennial Square
P.O. Box 3000
Haddonfield, NJ 08033
(856) 795-2121
jconnell@archerlaw.com

QUESTION PRESENTED

The disparagement clause in section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), prohibits the registration of a trademark that "may disparage ... persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."

The question presented is whether the disparagement clause is contrary to the First Amendment.

TABLE OF CONTENTS

QUESTION PRESENTED i
TABLE OF AUTHORITIES v
STATEMENT 1
SUMMARY OF ARGUMENT 9
ARGUMENT 15
I. The Lanham Act's disparagement clause is contrary to the First Amendment. 15
A. The disparagement clause imposes a significant viewpoint-based burden on speech. 15
1. The disparagement clause discriminates on the basis of viewpoint. 15
2. The disparagement clause imposes a significant burden on speech. 19
3. The disparagement clause is thus contrary to the First Amendment. 21
B. Trademark registration is not a government subsidy or government speech, and trademarks are not pure commercial speech. 25
1. Trademark registration is not a government subsidy, and the disparagement clause would be contrary to the First Amendment even it were. 26
2. Trademark registration is not government speech. 31

3. Trademarks are not pure commercial speech, and the disparagement clause would be contrary to the First Amendment even if they were. 35

4. The government's "common thread" theory should be rejected. 39

II. The Lanham Act's disparagement clause does not bar the registration of Simon Tam's trademark. 41

A. Simon Tam's trademark is not disparaging. 42

B. The disparagement clause bars the registration of marks that disparage natural and juristic persons, not marks that disparage non-juristic entities such as racial and ethnic groups. 46

1. The text of the disparagement clause indicates that it does not bar the registration of marks that disparage minority groups. 46

2. The history of the disparagement clause confirms that it does not bar the registration of marks that disparage minority groups. 48

3. For more than half a century, the PTO did not interpret the disparagement clause to bar the registration of marks that disparage minority groups. 51

III. The Lanham Act's disparagement clause is unconstitutionally vague. 54

CONCLUSION 60

TABLE OF AUTHORITIES

CASES

14 Penn Plaza LLC v. Pyett, 556 U.S. 247 (2009) 41
Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc., 133 S. Ct. 2321 (2013) 7, 26, 30
Arizona Free Enterprise Club's Freedom Club PAC v. Bennett, 564 U.S. 721 (2011) 29
B & B Hardware, Inc. v. Hargis Indus., Inc., 135 S. Ct. 1293 (2015) 19
Baggett v. Bullitt, 377 U.S. 360 (1964) 58
Bolger v. Youngs Drug Prods. Corp., 463 U.S. 60 (1983) 38
Bond v. United States, 134 S. Ct. 2077 (2014) 41
Brown v. Entertainment Merchants Ass'n, 564 U.S. 786 (2011) 24, 39, 58
Carey v. Population Servs., Int'l, 431 U.S. 678 (1977) 38
Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n, 447 U.S. 557 (1980) 38
Chevron, U.S.A., Inc. v. NRDC, 467 U.S. 837 (1984) 45, 53
Coates v. City of Cincinnati, 402 U.S. 611 (1971) 55
Cornelius v. NAACP Legal Def. & Educ. Fund, Inc., 473 U.S. 788 (1985) 22, 23, 34
Davenport v. Washington Educ. Ass'n, 551 U.S. 177 (2007) 26, 27
Eldred v. Ashcroft, 537 U.S. 186 (2003) 35
FCC v. Fox Television Stations, Inc., 132 S. Ct. 2307 (2012) 24, 54

FCC v. Fox Television Stations, Inc., 556 U.S. 502 (2009) 24
FCC v. Pacifica Foundation, 438 U.S. 726 (1978) 24, 25
Forsyth Cty. v. Nationalist Movement, 505 U.S. 123 (1992) 24
Friedman v. Rogers, 440 U.S. 1 (1979) 35, 36
Golan v. Holder, 132 S. Ct. 873 (2012) 35
Grayned v. City of Rockford, 408 U.S. 104 (1972) 58
Harper & Row, Publishers, Inc. v. Nation Enters., Inc., 471 U.S. 539 (1985) 35
Hustler Magazine, Inc. v. Falwell, 485 U.S. 46 (1988) 23
In re McGinley, 660 F.2d 481 (C.C.P.A. 1981) 5
Johanns v. Livestock Marketing Ass'n, 544 U.S. 550 (2005) 31, 32, 33
Knox v. Service Employees Int'l Union, 132 S. Ct. 2277 (2012) 27
KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111 (2004) 19
Leathers v. Medlock, 499 U.S. 439 (1991) 22, 29
Lebron v. National R.R. Passenger Corp., 513 U.S. 374 (1995) 41
Legal Servs. Corp. v. Velazquez, 531 U.S. 533 (2001) 26
NEA v. Finley, 524 U.S. 569 (1998) 26, 29
Pleasant Grove City v. Summum, 555 U.S. 460 (2009) 31, 32, 33, 40
R.A.V. v. City of St. Paul, 505 U.S. 377 (1992) 17, 18, 23, 37

Reed v. Town of Gilbert, 135 S. Ct. 2218 (2015) 15, 23
Regan v. Taxation With Representation of Wash., 461 U.S. 540 (1983) 22, 26
Reno v. ACLU, 521 U.S. 844 (1997) 58
Riley v. Nat'l Fed'n of the Blind, 487 U.S. 781 (1988) 36
Rosenberger v. Rector and Visitors of the Univ. of Va., 515 U.S. 819 (1995) .. 16, 17, 21, 22, 29
Rust v. Sullivan, 500 U.S. 173 (1991) 26
San Francisco Arts & Athletics, Inc. v. United States Olympic Comm., 483 U.S. 522 (1987) 35
Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd., 502 U.S. 105 (1991) 21
Snyder v. Phelps, 562 U.S. 443 (2011) 24
Sorrell v. IMS Health Inc., 564 U.S. 552 (2011) 21, 37, 38
Speiser v. Randall, 357 U.S. 513 (1958) 58
Texas v. Johnson, 491 U.S. 397 (1989) 24
Thompson v. Western States Med. Ctr., 535 U.S. 357 (2002) 36, 38
United States v. Stevens, 559 U.S. 460 (2010) 13, 18, 39, 40
Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc., 455 U.S. 489 (1982) 54
Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205 (2000) 19
Walker v. Texas Div., Sons of Confederate Veterans, Inc., 135 S. Ct. 2239 (2015) 31, 32, 33
Yee v. City of Escondido, 503 U.S. 519 (1992) 41

Ysursa v. Pocatello Educ. Ass'n, 555 U.S. 353 (2009) 26, 27

ADMINISTRATIVE DECISIONS

Boswell v. Mavety Media Group Ltd., 52 U.S.P.Q.2d 1600, 1999 WL 1040108 (TTAB 1999) 47
Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1999 WL 375907 (TTAB 1999), *rev'd on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003) 44, 52, 56
In re Beck, 114 U.S.P.Q.2d 1048, 2015 WL 1458229 (TTAB 2015) 52
In re Geller, 2013 WL 2365001 (TTAB 2013) 52
In re Heeb Media, LLC, 89 U.S.P.Q.2d 1071, 2008 WL 5065114 (TTAB 2008) 52, 57
In re Lebanese Arak Corp., 94 U.S.P.Q.2d 1215, 2010 WL 766488 (TTAB 2010) 52, 53
In re Old Glory Condom Corp., 26 U.S.P.Q.2d 1216, 1993 WL 114384 (TTAB 1993) 31
In re Over Our Heads, Inc., 16 U.S.P.Q.2d 1653, 1990 WL 354546 (TTAB 1990) 55
In re Reemtsma Cigarettenfabriken G.M.B.H., 122 U.S.P.Q. 339, 1959 WL 6173 (TTAB 1959) 52, 53
In re Squaw Valley Dev. Co., 80 U.S.P.Q.2d 1264, 2006 WL 1546500 (TTAB 2006) 52

STATUTES

15 U.S.C. § 1052(a) ..... passim
15 U.S.C. § 1057(b) 19
15 U.S.C. § 1065 19
15 U.S.C. § 1072 19

15 U.S.C. § 1114(1) 19
15 U.S.C. § 1115(a) 19
15 U.S.C. § 1115(b) 19
15 U.S.C. § 1117(b) 20
15 U.S.C. § 1124 19
15 U.S.C. § 1127 46

LEGISLATIVE MATERIAL

An Act to provide for the registration and protection of trade-marks used in commerce, to carry out the provisions of certain international conventions, and for other purposes, 60 Stat. 427 (1946) 50
H.R. 4744, 76th Cong., 1st Sess. (1939), § 2(a) 48
H.R. Rep. No. 219, 79th Cong., 1st Sess. (1945) 49
Inter-American Convention for Trade Mark and Commercial Protection, 46 Stat. 2907 (1931) 50
S. Rep. No. 1333, 79th Cong., 2d Sess. (1946) 49
Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents, 76th Cong., 1st Sess. (1939) 49, 55
Trade-Marks: Hearings on H.R. 9041 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents, 75th Cong., 3d Sess. (1938) 50, 51

OTHER AUTHORITIES

Martyn Atkins, *Discipleship and the People Called Methodists* 2
Friends General Conference, *FAQs About Quakers* 2
Adam D. Galinsky et al., *The Reappropriation of Stigmatizing Labels: The Reciprocal Relationship Between Power and Self-Labeling*, 24 Psychological Science 2020 (2013) 2
Green's Dictionary of Slang (digital ed. 2016) 42
Stephen P. Ladas, *The Lanham Act and International Trade*, 14 Law & Contemp. Probs. 269 (1949) 50
McCarthy on Trademarks and Unfair Competition (4th ed. Westlaw) 20, 31
Donald S. Passman, *All You Need to Know About the Music Business* (8th ed. 2012) 21
William D. Piersen, *The Origin of the Word "Hoosier": A New Interpretation*, 91 Indiana Magazine of History 189 (1995) 2
Richard Stim, *Music Law: How to Run Your Band's Business* (8th ed. 2015) 20
Jack Tatum, *They Call Me Assassin* (1980) 42
Harry Aubrey Toulmin, Jr., *The Trade-Mark Act of 1946* (1946) 50

STATEMENT

In the decision below, the en banc Court of Appeals correctly held that the disparagement clause of the Lanham Act is contrary to the First Amendment. This provision bars the registration of a trademark that "may disparage ... persons, living or dead." 15 U.S.C. § 1052(a). As the Court of Appeals found, the disparagement clause discriminates on the basis of viewpoint, by imposing a substantial burden on speech with a particular message. The government offers no justification for this viewpoint discrimination other than preventing offense to listeners, but that is not a valid basis for restricting expression.

The judgment of the Court of Appeals can also be affirmed on two other grounds that respondent Simon Tam raised below. First, as a matter of statutory interpretation, the disparagement clause simply does not bar the registration of his trademark. Second, the disparagement clause is unconstitutionally vague.

1. Simon Tam is an Asian-American musician, lecturer, and political activist. He is the founder and leader of The Slants, a rock band based in Portland, Oregon. When Tam formed the band in 2006, his purpose was not just to play music. He also intended the band to be a vehicle for expressing his views on discrimination against Asian-Americans. To that end, he recruited Asian-American band members, and he called his band The Slants.

In choosing that name, Tam was following in the long tradition of *reappropriation*, in which members

of minority groups have reclaimed terms that were once directed at them as insults and redirected the terms outward as badges of pride. *See* Adam D. Galinsky et al., *The Reappropriation of Stigmatizing Labels: The Reciprocal Relationship Between Power and Self-Labeling*, 24 Psychological Science 2020 (2013). In recent times, the most conspicuous examples of reappropriation have involved words such as "queer," "dyke," and so on—formerly derogatory terms that have been so successfully adopted by members of the gay and lesbian community that they have now lost most, if not all, of their pejorative connotations. In earlier periods, regional nicknames such as "hoosier" and "badger" were originally derogatory, but were adopted with pride by Indianans and Wisconsinites respectively. *See* William D. Piersen, *The Origin of the Word "Hoosier": A New Interpretation*, 91 Indiana Magazine of History 189 (1995). Even "Methodist" and "Quaker" began as pejorative epithets, but were adopted by Methodists and Quakers themselves and lost their negative connotations. Martyn Atkins, *Discipleship and the People Called Methodists* 9, http://www.methodist.org.uk/static/deepeningdiscipleship/discipleshipandmethodistsmatkins.pdf; Friends General Conference, *FAQs About Quakers*, http://www.fgcquaker.org/explore/faqs-about-quakers#name.

Tam aimed to do the same for "slant," a derogatory reference to Asian-Americans. "We want to take on these stereotypes that people have about us, like the slanted eyes, and own them," he explained. Pet. App. 166a. He observed: "For our band, we're not just Chinese, we're not just Vietnamese, we're kind

of a pan-Asian band that celebrates all the different Asian cultures out there .... Everyone in the band really loves the fact that we can try and empower Asian Americans and say, 'You know what? We are slant[ed]. Who cares? We're proud of that.'" JA 37-38.

In their music, as the Court of Appeals found, "Mr. Tam and his band weigh in on cultural and political discussions about race and society." Pet. App. 10a. Sometimes The Slants offer wry commentary on racial stereotypes. Their first album is called "Slanted Eyes, Slanted Hearts." Their fourth is "The Yellow Album," a title that combines references to the Beatles' 1968 "White Album" and Jay-Z's 2003 "Black Album" with a reference to the once-common use of the color yellow to refer pejoratively to Asians, as in the phrase "Yellow Peril."

At other times, The Slants come closer to straightforward advocacy. For example, the chorus of their song "Sakura, Sakura" is:

> We sing for the Japanese and the Chinese and all the dirty knees.
>
> Can you see me? We sing in harmony for the babies in the alleys.

The title of "Sakura, Sakura" refers to the well-known Japanese folk song of the same name ("sakura" is Japanese for "cherry blossom"). The Slants' song echoes the melody of the folk song. The first line of the chorus recalls a schoolyard taunt painfully familiar to many Asian-Americans: "Chinese, Japanese, dirty knees, look at these." As Tam has ex-

plained, The Slants "feel strongly that Asians should be proud of their cultural heritage, and not be offended by stereotypical descriptions." Pet. App. 10a (brackets omitted).

In 2011, Tam sought to register THE SLANTS as a trademark. Pet. App. 10a. The examiner refused to register the mark, on the ground that it is disparaging to "persons of Asian descent." Pet. App. 10a.

2. The Trademark Trial and Appeal Board affirmed. Pet. App. 162a-182a. The Board acknowledged that Tam's purpose in naming his band The Slants was "an attempt not to disparage, but rather to wrest 'ownership' of the term from those who might use it with the intent to disparage." Pet. App. 175a. The Board nevertheless determined that "[t]he evidence of public perception of the meaning of THE SLANTS, as used in connection with applicant's services, shows that meaning to be a derogatory reference to people of Asian descent." Pet. App. 174a. The Board concluded that "[t]he fact that applicant has good intentions underlying his use of the term does not obviate the fact that a substantial composite of the referenced group find the term objectionable." Pet. App. 181a.

Tam appealed to the Court of Appeals for the Federal Circuit. He argued that the Board erred in finding his trademark unregistrable under section 2(a) of the Lanham Act, and that section 2(a)'s disparagement clause is contrary to the First Amendment and unconstitutionally vague.

3. A panel of the Court of Appeals affirmed. Pet. App. 123a-161a. The Court of Appeals found that "[t]he evidence here supports the Board's finding that the mark THE SLANTS likely refers to people of Asian descent." Pet. App. 128a. The court also found that "[s]ubstantial evidence supports the Board's finding that the mark THE SLANTS is likely offensive to a substantial composite of people of Asian descent." Pet. App. 130a. The Court of Appeals relied on the precedent of its predecessor court, the Court of Customs and Patent Appeals, to reject Tam's constitutional arguments. Pet. App. 131a-132a (citing *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981)).

Judge Moore wrote a separate opinion urging the Court of Appeals to reconsider the constitutionality of section 2(a)'s disparagement clause. Pet. App. 135a-161a (Moore, J., additional views).

4. The en banc Court of Appeals vacated the Board's decision and remanded the case to the Board for further proceedings. Pet. App. 1a-122a. The court began by observing that "Mr. Simon Shiao Tam named his band THE SLANTS to make a statement about racial and cultural issues in this country. With his band name, Mr. Tam conveys more about our society than many volumes of undisputedly protected speech." Pet. App. 2a. The en banc court reinstated the panel's holding that THE SLANTS is disparaging. Pet. App. 12a n.3. But the en banc court went on to hold that section 2(a)'s disparagement clause is contrary to the First Amendment.

The Court of Appeals concluded that the disparagement clause discriminates on the basis of view-

point. Pet. App. 19a, 21a. As the court observed, "[t]he PTO rejects marks under § 2(a) when it finds the marks refer to a group in a negative way, but it permits the registration of marks that refer to a group in a positive, non-disparaging manner." Pet. App. 21a. The court concluded: "Section 2(a) is a viewpoint-discriminatory regulation of speech, created and applied in order to stifle the use of certain disfavored messages. Strict scrutiny therefore governs its First Amendment assessment—and no argument has been made that the measure survives such scrutiny." Pet. App. 23a-24a.

The Court of Appeals further held that the disparagement clause could not be upheld as a permissible regulation of commercial speech. The court noted that the disparagement clause regulates the expressive aspects of a trademark, not the mark's commercial function as the identifier of the source of a good or service. Pet. App. 24a. "Importantly," the court noted, "*every time* the PTO refuses to register a mark under § 2(a), it does so because it believes the mark conveys an expressive message." Pet. App. 25a. The court thus concluded that the First Amendment requires strict scrutiny. Pet. App. 25a-26a.

The Court of Appeals rejected the government's contention that section 2(a) restricts no speech and is thus immune from First Amendment scrutiny. Pet. App. 28a-40a. The court concluded that the First Amendment presumptively prohibits content-based and viewpoint-based *burdens* on speech, just as it prohibits similarly discriminatory *bans* on speech. Pet. App. 28a-30a. The court recognized that the advantages of trademark registration are so sig-

nificant that "the § 2(a) bar on registration creates a strong disincentive to choose a 'disparaging' mark." Pet. App. 32a.

The Court of Appeals also rejected the government's suggestion that trademark registrations are government speech. Pet. App. 40a-47a. The court held that registration does not change the fact that trademarks are private speech, not government speech. Pet. App. 40a-41a. The court further held that the accoutrements of registration, such as the placement of a mark on the Principal Register and the PTO's issuance of a registration certificate, "do not convert the underlying speech to government speech." Pet. App. 41a. As the court noted, "the PTO routinely registers marks that no one can say the government endorses," such as CAPITALISM SUCKS DONKEY BALLS and MURDER 4 HIRE. Pet. App. 43a. The court observed, moreover, that "[c]opyright registration has identical accoutrements," so the government's theory would allow it to deny copyright registrations to works that disparaged others, an outcome that would clearly violate the First Amendment. Pet. App. 41a.

The Court of Appeals likewise rejected, on two grounds, the government's argument that section 2(a) is a government subsidy exempt from strict scrutiny. Pet. App. 47a-61a. First, the court noted that under the unconstitutional conditions doctrine, the government may not attach "'conditions that seek to leverage funding to regulate speech outside the contours of the program itself.'" Pet. App. 51a (quoting *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013)). Be-

cause trademark registration "is not a program through which the government is seeking to get its message out through recipients of funding," the court held, the government cannot condition trademark registration on the avoidance of a particular viewpoint. Pet. App. 52a.

Second, the Court of Appeals determined that trademark registration is not a subsidy. Pet. App. 52a-61a. As the court noted, "the subsidy cases have all involved government funding or government property." Pet. App. 53a. Trademark registration, by contrast, involves neither. "Unlike a subsidy consisting of, for example, HIV/AIDS funding, or tax exemptions, a trademark registration does not directly affect the public fisc," the court concluded. "Instead, a registered trademark redefines the nature of the markholder's rights as against the rights of other citizens." Pet. App. 57a. Thus "the system of trademark registration is a regulatory regime, not a government subsidy program." Pet. App. 57a.

Finally, the Court of Appeals held that section 2(a)'s bar on disparaging trademarks would be contrary to the First Amendment even if it were classified as a regulation of commercial speech. Pet. App. 61a-67a. Under the intermediate scrutiny applicable to commercial speech, regulation must advance a substantial government interest, but the court found that "§ 2(a) immediately fails at this step," because "[t]he entire interest of the government in § 2(a) depends on disapproval of the message." Pet. App. 63a.

Judge O'Malley, joined by Judge Wallach, filed a concurring opinion. Pet. App. 68a-80a. She agreed

that section 2(a)'s disparagement clause is contrary to the First Amendment. She also concluded that the disparagement clause is unconstitutionally vague.

Judge Dyk filed an opinion concurring in part and dissenting in part, which Judges Lourie and Reyna joined in part. Pet. App. 80a-104a. He concluded that section 2(a)'s disparagement clause is contrary to the First Amendment only as applied to marks, such as Simon Tam's, that are "both political and commercial." Pet. App. 102a. He would have upheld the clause as applied to "routine product identifiers," Pet. App. 89a, which he characterized as trademarks that "lack the kind of 'expressive character' that would merit First Amendment protection for offensive content." Pet. App. 90a.

Judge Lourie dissented, Pet. App. 104a-108a, on the ground that the PTO's refusal to register a trademark "is not a denial of an applicant's right of free speech," because "Mr. Tam may use his trademark as he likes" even without federal registration. Pet. App. 105a. Judge Reyna dissented, Pet. App. 108a-122a, on the ground that trademarks are commercial speech and that the disparagement clause satisfies the intermediate scrutiny applicable to commercial speech.

SUMMARY OF ARGUMENT

The Lanham Act's disparagement clause is contrary to the First Amendment. The judgment of the Court of Appeals can also be affirmed on two other grounds Simon Tam raised below. First, as a matter of statutory construction, the disparagement clause

does not bar the registration of his trademark. Second, the disparagement clause is unconstitutionally vague.

I. The disparagement clause is contrary to the First Amendment.

A. The disparagement clause imposes a significant viewpoint-based burden on speech. It permits the registration of marks that express a positive or neutral view of a person, but bars the registration of marks that express a negative view. The denial of registration is a serious burden, because registration confers important legal rights on trademark owners. The First Amendment does not permit the government to impose such a burden on speakers based on their viewpoint.

Even if viewpoint discrimination could be justified by a compelling interest, the government is unable to make that showing here. The only interest the government asserts, and the only interest the disparagement clause conceivably advances, is that of protecting people from being offended by the viewpoints expressed in disparaging trademarks, but the First Amendment does not allow the government to impose burdens on speech to protect listeners against offense.

B. In an attempt to avoid the application of settled First Amendment principles, the government tries to wedge the disparagement clause into three different doctrinal boxes, but the clause does not fit into any of them.

1. Trademark registration is not a government subsidy. Trademark registrants receive no money from the government. In contrast, the Court's subsidy cases all involve actual disbursements of funds to speakers, or the equivalent in the form of tax exemptions or the use of government payroll mechanisms for the purpose of obtaining funds for expression. If trademark registration were a subsidy, copyright registration would be a subsidy too, which would allow the government to deny copyright registrations to works with content the government disfavors.

In any event, the disparagement clause would be unconstitutional even if trademark registration were a subsidy. Viewpoint discrimination in subsidies for private speech is just as impermissible as viewpoint discrimination in any other context. Moreover, where the government places speech-related conditions on the recipients of public funds, those conditions must advance the purpose of the particular program the government is funding. A ban on disparaging marks does not advance the purpose of the Lanham Act, because disparaging marks can identify the source of a product just as accurately as non-disparaging marks.

2. Trademark registration is not government speech. Registration of a trademark does not connote government approval of the mark or the product to which it refers. A trademark, whether registered or unregistered, is speech by the trademark owner, not by the government. Unlike government speech such as license plates and public monuments, trademarks do not communicate messages from the government. They are not understood by the public as statements

by the government. And the government does not control their design or content. The issuance of a trademark registration no more transforms a mark into government speech than the issuance of a copyright registration converts a copyrighted work into government speech.

3. Trademarks are not pure commercial speech. Trademarks have both commercial and expressive purposes; they identify the sources of products and they express points of view. The disparagement clause regulates only the expressive component of trademarks, never the commercial component. The appropriate First Amendment standard is the one for fully protected expression, not commercial speech.

In any event, the disparagement clause would be contrary to the First Amendment even under the doctrine applied to commercial speech. Viewpoint discrimination is impermissible for commercial speech, just like for noncommercial speech. Moreover, the government can advance no interest other than that of preventing offense to listeners, but that is an interest the First Amendment renders off-limits, for commercial speech just like for noncommercial speech.

4. For the second time in recent years, the government advances a theory under which speech gets reduced protection or no protection at all when it shares a "common thread" with categories of speech that get reduced or no protection, even when the speech does not fall within one of these categories. The Court rejected the government's theory in *Unit-*

ed States v. Stevens, 559 U.S. 460 (2010), and it should do so again.

II. The disparagement clause does not bar the registration of Simon Tam's trademark, for two reasons.

A. Simon Tam's trademark is not disparaging. By calling his band The Slants, Tam is not disparaging Asian-Americans. He is doing precisely the opposite: He is appropriating a slur and using it as a badge of pride. The PTO found the name disparaging only because the PTO uses a two-part test of its own invention to determine whether a mark is disparaging, a test that departs in important ways from the text of the statute the PTO is ostensibly interpreting.

B. Simon Tam's trademark does not "disparage ... persons," 15 U.S.C. § 1502(a), because "person" is defined in the Lanham Act to include only natural and juristic persons. Non-juristic entities such as racial and ethnic groups are excluded from this definition. To be sure, each individual Asian-American is a natural person, but the statute cannot be read to bar marks that disparage Asian-Americans on this ground, because *all* collective entities, juristic and non-juristic alike, are made up of natural persons. If the disparagement of a non-juristic group were deemed to constitute the disparagement of the individuals who make up that group, the Lanham Act's distinction between juristic and non-juristic entities would be a nullity.

The history of the disparagement clause confirms that the clause does not protect racial and ethnic groups. The clause was added to the Lanham Act to bring American law into compliance with our treaty

obligations, not to protect minority groups. For decades before and decades after the enactment of the Lanham Act, the PTO routinely registered trademarks derogatory to minority groups. Only in recent years has the PTO applied the disparagement clause to such non-juristic groups. But of course the PTO may not rewrite a statute.

III. The disparagement clause is unconstitutionally vague. The PTO has a sorry record of utterly arbitrary disparagement decisions. Part of the problem is the subjectivity inherent in deciding whether a mark is disparaging. The PTO has made the vagueness problem even worse by construing the statute non-literally to bar the registration of marks that disparage non-juristic groups, and has compounded it again by refusing to say how many members of the referenced group must perceive disparagement. Applicants have no way to predict what the PTO will do.

Vague speech restrictions chill speech. The disparagement clause is a strong incentive to stay away from any name the PTO might conceivably find disparaging, because it can be extraordinarily costly and disruptive to change the name of a product that is already in the market. Vague speech restrictions also facilitate discriminatory enforcement. The disparagement clause provides PTO examiners with broad power to grant or refuse registration based on the examiners' own subjective preferences. The PTO has been aware of this problem ever since the Lanham Act was enacted, but it is no closer to a solution today than at any time in the past.

ARGUMENT

The disparagement clause violates the First Amendment, because it imposes a significant viewpoint-based burden on speech. The judgment of the Court of Appeals can also be affirmed on two other grounds Simon Tam raised below. First, the disparagement clause does not bar the registration of Simon Tam's trademark. Second, the disparagement clause is unconstitutionally vague.

I. The Lanham Act's disparagement clause is contrary to the First Amendment.

The Court of Appeals correctly held that the disparagement clause is contrary to the First Amendment. The clause imposes a significant viewpoint-based burden on speech. The government errs in characterizing registered trademarks as government subsidies, government speech, and pure commercial speech.

A. The disparagement clause imposes a significant viewpoint-based burden on speech.

1. The disparagement clause discriminates on the basis of viewpoint.

The disparagement clause discriminates on the basis of viewpoint, by singling out disparaging marks for disfavored treatment. Viewpoint discrimination is "the regulation of speech based on the ... opinion or perspective of the speaker." *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2230 (2015) (citation and

internal quotation marks omitted). "When the government targets not subject matter, but particular views taken by speakers on a subject, the violation of the First Amendment is all the more blatant." *Rosenberger v. Rector and Visitors of the Univ. of Va.*, 515 U.S. 819, 829 (1995).

The disparagement clause permits the registration of marks that express a positive or neutral view of a person, but bars the registration of marks that express a negative view. Applying the disparagement clause, the PTO has registered THINK ISLAM, but it has refused registration to STOP THE ISLAMISATION OF AMERICA. Pet. App. 21a-22a. The PTO has registered NATIONAL REPUBLICAN SENATORIAL COMMITTEE, but it has refused registration to REPUBLICANS SHOULDN'T BREED. Pet. App. 8a. The PTO has registered CELEBRASIANS and ASIAN EFFICIENCY, Pet. App. 21a, but—because it erroneously concluded that the mark expresses a negative view of Asian-Americans—the PTO refused registration to THE SLANTS.

The disparagement clause explicitly discriminates on the basis of the viewpoint expressed by the trademark owner. The clause forbids the registration of DEMOCRATS ARE TERRIBLE, but allows the registration of DEMOCRATS ARE WONDERFUL. It forbids the registration of STOP THE ISLAMISATION OF AMERICA, but allows the registration of ENCOURAGE THE ISLAMISATION OF AMERICA. This is the very definition of viewpoint discrimination—the disfavoring of one side of a debate.

The government suggests (U.S. Br. 46) that the disparagement clause is not viewpoint-based, on the theory that it prohibits the registration of marks that disparage anyone, regardless of the identity of the disparaged person. But the disfavoring of *all* negative viewpoints is still viewpoint discrimination. A law that burdened any speech critical of anyone would be a frightening prospect, precisely because it would amount to viewpoint discrimination on a massive scale.

Nor could the government defend the disparagement clause on the theory that it prohibits the registration of marks that disparage anyone, regardless of the *viewpoint* of the disparaged person. The relevant viewpoint in First Amendment cases is the viewpoint of the speaker, not the viewpoint of the person he is speaking about. *Rosenberger*, 515 U.S. at 829 ("The government must abstain from regulating speech when the specific motivating ideology or the opinion or perspective *of the speaker* is the rationale for the restriction.") (emphasis added). A law that burdened the disparagement, but not praise, of public officials would still be viewpoint-based, even if it burdened the disparagement of Republicans and Democrats alike.

The government likewise errs in defending (U.S. Br. 45) the disparagement clause by analogy to a hypothetical statute (mentioned in *R.A.V. v. City of St. Paul*, 505 U.S. 377, 391 (1992)) prohibiting the use of "odious racial epithets." First, the disparagement clause burdens much more speech than merely racial epithets. Many of the trademarks the PTO has rejected on disparagement grounds—such as STOP THE

ISLAMISATION OF AMERICA, HAVE YOU HEARD THAT SATAN IS A REPUBLICAN?, and DEMOCRATS SHOULDN'T BREED—involve no racial epithets, or indeed any epithets at all.

Moreover, *R.A.V.* did not hold (and had no occasion to hold) that a law targeting "odious racial epithets" would be viewpoint-neutral; indeed, what makes something an "odious racial epithet" is precisely the viewpoint it expresses. In any event, the disparagement clause is exactly the sort of law that *R.A.V.* described as viewpoint-based. Because the disparagement clause explicitly discriminates based on the viewpoints expressed by speakers, it unconstitutionally "license[s] one side of a debate," *id.* at 392, to register trademarks expressing its views, while denying such license to the other side.

The government also errs in characterizing (U.S. Br. 44-45) the disparagement clause as viewpoint-neutral, based on an analogy to laws against libel, threats, and fighting words. The reason such laws are constitutionally permissible is not that they are viewpoint-neutral, but rather that libel, threats, and fighting words are "well-defined and narrowly limited classes of speech" that are completely outside of First Amendment protection. *United States v. Stevens*, 559 U.S. 460, 468-69 (2010). Disparaging speech, by contrast, is at the heart of the First Amendment. Political debates, and indeed debates over many other matters of public concern, often involve sharp criticism of opposing views, criticism that sometimes disparages the holders of those views. Libel, threats, and fighting words can be

banned by the government. Disparaging speech cannot.[1]

2. The disparagement clause imposes a significant burden on speech.

The disparagement clause imposes a significant viewpoint-based burden on speech. As the Court has repeatedly recognized, "[r]egistration is significant. The Lanham Act confers important legal rights and benefits on trademark owners who register their marks." *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1300 (2015) (citation and internal quotation marks omitted); *see also KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117 (2004); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209 (2000). For example, registration serves as nationwide constructive notice of the registrant's claim of ownership, which eliminates any possible defense of good faith adoption after the date of registration. 15 U.S.C. § 1072. Registration constitutes prima facie evidence of the mark's validity and the registrant's exclusive right to use the mark. *Id.* §§ 1057(b), 1115(a). After five years, the right to use a registered mark can become "incontestable." *Id.* §§ 1065, 1115(b). Registered marks receive greater protection against counterfeiting, *id.* § 1114(1), and the importation of foreign goods bearing an infringing mark, *id.* § 1124. The owner of a registered mark is entitled to enhanced

---

[1] Even if the disparagement clause were viewpoint-neutral, it would clearly be content-based, and it would fail strict scrutiny for the reasons given below. The government does not even argue that the disparagement clause could satisfy strict scrutiny.

remedies against infringers, including treble damages and attorneys' fees in certain circumstances. *Id.* § 1117(b).

Virtually all the states have adopted the Model State Trademark Act, which includes many of the same provisions as the Lanham Act, including the disparagement clause, so this disparity in legal rights between registered and unregistered marks is replicated at the state level. *McCarthy on Trademarks and Unfair Competition* § 22.5 (4th ed. Westlaw). In short, "registration of a mark on the federal Principal Register confers a number of procedural and substantive legal advantages over reliance on common law rights." *Id.* § 19.9.[2]

The advantages of registration are as great in the music industry as in any other business. If another band, anywhere in the United States, were also to call themselves The Slants, registration would equip Tam with powerful tools to enforce his trademark rights. These tools would likely be enough to deter other bands from calling themselves The Slants in the first place. For this reason, bands from ABBA to ZZ TOP routinely register their names as trademarks, and published guides for musicians advise up-and-coming bands to do the same. *See, e.g.*, Richard Stim, *Music Law: How to Run Your Band's*

---

[2] Indeed, the Federal Circuit and other courts have suggested that a mark refused registration under section 2(a) can receive no protection at all under the Lanham Act. *See* Pet. App. 39a n.11. The Court need not resolve this question in our case. The critical point is that under any view of the law, it is clear that the owner of a registered trademark has many more legal rights than the owner of a trademark that cannot be registered.

Business 249, 259 (8th ed. 2015); Donald S. Passman, *All You Need to Know About the Music Business* 359-60 (8th ed. 2012).

Because the disparagement clause deprives trademark owners of important legal rights available only to trademark registrants, it is a significant viewpoint-based burden. It discourages the adoption of trademarks that take a certain point of view just as surely as would a tax levied on those trademarks.[3]

3. The disparagement clause is thus contrary to the First Amendment.

The disparagement clause is thus contrary to the First Amendment, which prohibits the imposition of viewpoint-based burdens on speakers. *Rosenberger*, 515 U.S. at 828-29. "Lawmakers may no more silence unwanted speech by burdening its utterance than by censoring its content." *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011). Viewpoint-based burdens on speech raise "the specter that the government may effectively drive certain ideas or viewpoints from the marketplace." *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*,

---

[3] Amici AAJC et al. err in suggesting (AAJC Br. 8-12) that registering Simon Tam's trademark would hinder the efforts of minority communities to reappropriate derogatory words. Registration would help Tam prevent other bands from calling themselves The Slants, but registration would not hinder anyone from using the word "slant" in a reappropriative way, as long as they are not using it as the name of a band. Indeed, Tam chose that name precisely to *encourage* other people to join him in reappropriating the word.

502 U.S. 105, 116 (1991) (citing *Leathers v. Medlock*, 499 U.S. 439, 448-49 (1991)).

The government makes much (U.S. Br. 26) of the fact that Simon Tam may still call his band The Slants despite the burden of not being able to register the name as a trademark. But that could hardly excuse a viewpoint-based burden on speech. The student group in *Rosenberger* could still have published its newspaper without the funding provided to other groups, but the Court found the disparity contrary to the First Amendment, because it was based on viewpoint. *Rosenberger*, 515 U.S. at 828. In *Cornelius v. NAACP Legal Def. & Educ. Fund, Inc.*, 473 U.S. 788, 811-13 (1985), the Legal Defense Fund could still have raised funds outside the Combined Federal Campaign, but the Court concluded that any viewpoint-based exclusion from that program would be unconstitutional. Nonprofits that engage in speech on ideological issues could still speak without a tax exemption, but viewpoint-based denial of tax exemptions would violate the First Amendment. *Rosenberger*, 515 U.S. at 834 (discussing *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540, 548 (1983)).

The Court has often indicated that viewpoint discrimination is unjustifiable regardless of whether the government has offered a compelling interest. *See, e.g., Rosenberger*, 515 U.S. at 829 ("The government must abstain from regulating speech when the specific motivating ideology or the opinion or perspective of the speaker is the rationale for the restriction. ... These principles provide the framework forbidding the State to exercise viewpoint discrimi-

nation."); *R.A.V.*, 505 U.S. at 386 ("The government may not regulate use based on hostility—or favoritism—towards the underlying message expressed."); *Cornelius*, 473 U.S. at 812-13 (remanding for a determination of whether government action "was impermissibly motivated by a desire to suppress a particular point of view").

But even if viewpoint discrimination could be justified by the same showing that justifies content discrimination—that the regulation is "narrowly tailored to serve compelling state interests," *Reed*, 135 S. Ct. at 2226—the government is unable to make that showing here.

The government has not even claimed that the disparagement clause serves a compelling interest. The only interest the government asserts, and the only interest the disparagement clause conceivably advances, is that of protecting people from being offended by the viewpoints expressed in disparaging trademarks. U.S. Br. 48 (quoting Judge Dyk's observation that "the purpose of the statute is to protect underrepresented groups in our society from being bombarded with demeaning messages in commercial advertising," Pet. App. 81a). This claimed government interest demonstrates all too clearly that the disparagement clause is intended to hinder the expression of certain viewpoints.

In any event, the First Amendment does not allow the government to impose burdens on speech to protect listeners against offensive views. *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55 (1988). "[S]peech cannot be restricted simply because it is upsetting."

Snyder v. Phelps, 562 U.S. 443, 458 (2011). "Speech cannot be financially burdened, any more than it can be punished or banned, simply because it might offend." *Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123, 134-35 (1992). The government's analogy (U.S. Br. 48) to antidiscrimination laws is wide of the mark, because while the government has ample authority to penalize offensive *acts*, it has no comparable authority to penalize offensive *speech*.

Nor does the First Amendment permit the government to burden speech to protect society as a whole from being offended. Disparaging trademarks may arouse disgust, "but disgust is not a valid basis for restricting expression." *Brown v. Entertainment Merchants Ass'n*, 564 U.S. 786, 798 (2011). "If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." *Texas v. Johnson*, 491 U.S. 397, 414 (1989).

In certain narrow contexts the Court has permitted *content*-based restrictions on certain offensive words. *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978).[4] But the lead opinion in *Pacifica* was careful to stress that *viewpoint* discrimination would be forbidden even there: "[I]f it is the speaker's opinion that gives offense, that consequence is a reason for according it constitutional protection. For it is a cen-

---

[4] This view has recently been questioned. *FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2321 (2012) (Ginsburg, J., concurring in the judgment) (stating that *Pacifica* was mistaken); *FCC v. Fox Television Stations, Inc.*, 556 U.S. 502, 530-34 (2009) (Thomas, J., concurring) (making a similar suggestion).

tral tenet of the First Amendment that the government must remain neutral in the marketplace of ideas." *Pacifica*, 438 U.S. at 745-46. As on the government-licensed airwaves, so on the government-administered trademark register, excluding speech because it expresses a "disparaging" opinion—excluding STOP THE ISLAMISATION OF AMERICA but not ENCOURAGE THE ISLAMISATION OF AMERICA, or allowing CELEBRASIANS but not THE SLANTS—violates this central tenet.

B. Trademark registration is not a government subsidy or government speech, and trademarks are not pure commercial speech.

In an attempt to avoid the application of settled First Amendment principles, the government tries to wedge the disparagement clause into three different doctrinal boxes. But the disparagement clause does not fit into any of them. Registered trademarks are not government subsidies, government speech, or pure commercial speech. The government also advances, for the second time in recent years, a theory under which speech gets reduced protection or no protection at all when it shares a "common thread" with categories of speech that get reduced or no protection, even when the speech does not fall within one of these categories. The government's theory should once again be rejected.

1. Trademark registration is not a government subsidy, and the disparagement clause would be contrary to the First Amendment even if it were.

The government characterizes (U.S. Br. 14-19) trademark registration as a subsidy to trademark owners which the government may spend as it sees fit. But trademark registration is not a subsidy. Trademark registrants receive no money from the government. In contrast, the Court's subsidy cases all involve actual disbursements of funds from the government to speakers, or the equivalent in the form of tax exemptions or the use of government payroll mechanisms for the purpose of obtaining funds for expression. *See, e.g.*, *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321 (2013); *Ysursa v. Pocatello Educ. Ass'n*, 555 U.S. 353 (2009); *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177 (2007); *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533 (2001); *NEA v. Finley*, 524 U.S. 569 (1998); *Rust v. Sullivan*, 500 U.S. 173 (1991); *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540 (1983).

Rather than being a subsidy, trademark registration is a recording system, analogous to the federal registration systems for copyrights and patents, and like the title recording systems state governments operate for real property. In each of these systems, applicants who meet certain requirements may register their property, and registration gives the registrant certain legal rights that are unavailable to non-registrants. The government is acting as a regu-

lator, not as a subsidizer. Just as the federal government does not subsidize copyright or patent holders, and just as state governments do not subsidize landowners who register their titles, the PTO does not subsidize trademark registrants. Trademark registrants certainly obtain legal rights from registration, which they are then responsible to enforce, but in this respect trademark registrants are in the same position as any other private parties resorting to the courts and other agencies to enforce rights conferred by other government regulatory systems. If such legal rights were deemed subsidies for First Amendment purposes, the government would gain a frightening power to regulate the content of private speech.

Ysursa and *Davenport*, the cases on which the government relies (U.S. Br. 17-18) in its effort to characterize trademark registration as a subsidy, are easily distinguishable. In both cases, labor unions claimed a First Amendment right to an indirect government subsidy for the unions' speech, in the form of government-provided deductions from employees' paychecks. The Court rejected the unions' claim. *Ysursa*, 555 U.S. at 355 (First Amendment "does not confer an affirmative right to use government payroll mechanisms for the purpose of obtaining funds for expression"); *Davenport*, 551 U.S. at 189-90. As the Court has explained, the "general rule" of these cases and others like them is that "individuals should not be compelled to subsidize private groups or private speech." *Knox v. Service Employees Int'l Union*, 132 S. Ct. 2277, 2295 (2012). *Ysursa* and *Davenport* involved government-provided

subsidies for speech. They do not stand for the astonishingly broad rule advanced by the government—that for First Amendment purposes, a subsidy is created by any regulatory scheme in which registrants receive legal rights unavailable to non-registrants.

Classifying the trademark and copyright registration systems as subsidies for First Amendment purposes, moreover, would let the government deny copyright registration to works based on their content—a dangerous and unprecedented result. If the Copyright Act included a clause prohibiting copyright registration of works that disparage any person, the First Amendment violation would be obvious. The government registers copyrights just as it registers trademarks. The First Amendment applies in the same way to both.[5]

---

[5] The government tries (U.S. Br. 47-48) to distinguish copyrights from trademarks on the ground that some trademarks, such as GOOGLE, are invented words with no expressive meaning. But this argument misses the point, which is that if trademark registration is a subsidy for First Amendment purposes, copyright registration would be a subsidy too, which would allow the government to deny copyright registration to works with content the government disfavors.

The proposed distinction also fails on its own terms. Even if some trademarks lack expressive meaning, many others are packed with expressive meaning, such as THE SLANTS, DYKES ON BIKES, and THINK ISLAM. Moreover, trademarks that are invented words *do* have expressive meaning. GOOGLE, for example, is a play on the word "googol," the numeral 1 followed by 100 zeroes, to indicate the enormous amount of information organized by Google's search engine.

In any event, the disparagement clause would be unconstitutional even if trademark registration were a subsidy. Viewpoint discrimination in subsidies for private speech is just as impermissible as viewpoint discrimination in any other context. *Rosenberger*, 515 U.S. at 834 (reaffirming "the requirement of viewpoint neutrality in the Government's provision of financial benefits"). The government may not "leverage its power to award subsidies ... into a penalty on disfavored viewpoints." *Finley*, 524 U.S. at 587. Thus Congress may lawfully direct the NEA, when making a funding decision, to consider "general standards of decency and respect for the diverse beliefs and values of the American public," *id.* at 572, because the Court interpreted that command in a way that rendered it viewpoint-neutral. *Id.* at 581-84. But Congress could not lawfully direct the NEA to fund only artists whose work praises the current administration, because such a command would be viewpoint discrimination.

The government suggests (U.S. Br. 8-9, 19) that the First Amendment allows the government to discriminate on the basis of viewpoint when it assists speakers through the provision of subsidies or tax exemptions. This suggestion is erroneous. The Court has made clear that the First Amendment forbids subsidies and tax exemptions for private speech that discriminate on the basis of viewpoint. *Rosenberger*, 515 U.S. at 834; *Finley*, 524 U.S. at 587; *see also Leathers*, 499 U.S. at 450 ("a tax scheme that discriminates among speakers does not implicate the First Amendment unless it discriminates on the basis of ideas"); *Arizona Free Enterprise Club's Free-*

dom Club PAC v. Bennett, 564 U.S. 721, 764 (2011) (Kagan, J., dissenting) ("Government subsidies of speech, designed to stimulate expression, are consistent with the First Amendment so long as they do not discriminate on the basis of viewpoint.") (brackets, ellipses, and internal quotation marks omitted). The government's contrary view would let the government use a vast range of programs as levers to control private speech. The IRS, for example, would become constitutionally entitled to refuse § 501(c)(3) exemptions to groups that oppose a war, or criticize the President, or display "demeaning illustrations" of religious figures (U.S. Br. 28), to use the government's own example. The government has no such power to pressure speakers into adopting government-approved viewpoints.

There is a second reason the disparagement clause would violate the First Amendment even if trademark registration were a subsidy: It would be a condition of funding unrelated to the purpose the funding was intended to accomplish. When the government places speech-related conditions on the recipients of government funds, those conditions must "define the limits of the government spending program"—*i.e.*, the conditions must advance "the activities Congress wants to subsidize." *AID*, 133 S. Ct. at 2328. The purpose of the Lanham Act is to enable the public to identify the sources of products. Content-based and viewpoint-based distinctions that do not advance this purpose are contrary to the First Amendment. Thus the government can refuse registration on the ground that a mark is deceptive, or that it is too similar to another mark, because these

distinctions serve the Lanham Act's purpose. But whether a mark is disparaging has no relationship to whether it accurately identifies the source of a product. Disparaging marks can serve this purpose just as well as non-disparaging marks.

2. Trademark registration is not government speech.

The government suggests (U.S. Br. 37-41) that a registered trademark is government speech rather than private speech. But registration of a trademark does not convert the trademark into government speech. Registration does not connote government approval of the mark or the product to which the mark refers. *McCarthy on Trademarks* § 19:3.50. As the PTO itself has explained, "the issuance of a trademark registration by this Office does not amount to a government endorsement of the quality of the goods to which the mark is applied," and "the act of registration is not a government imprimatur or pronouncement that the mark is a 'good' one in an aesthetic, or any analogous, sense." *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1993 WL 114384, *5 n.3 (TTAB 1993). A trademark, whether registered or unregistered, is speech by the trademark owner, not speech by the government.

Trademarks thus differ in every relevant respect from government speech such as license plates, *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015), public monuments, *Pleasant Grove City v. Summum*, 555 U.S. 460 (2009), and government advertising programs, *Jo-*

hanns v. Livestock Marketing Ass'n, 544 U.S. 550 (2005).

First, trademarks do not communicate messages from the government or express the government's policy, position, or preference on any issue. *Cf. Walker*, 135 S. Ct. at 2248 ("license plates ... long have communicated messages from the States"); *Summum*, 555 U.S. at 470 ("Governments have long used monuments to speak to the public."); *id.* at 473 ("The city has selected those monuments that it wants to display for the purpose of presenting the image of the City that it wishes to project."); *Johanns*, 544 U.S. at 560-61 ("The message set out in the beef promotions is from beginning to end the message established by the Federal Government."). Trademarks communicate messages from their owners and express their owners' viewpoints, not the viewpoint of the government. As the Court of Appeals correctly noted, "the PTO routinely registers marks that no one can say the government endorses," such as RADICALLY FOLLOWING CHRIST IN MISSION TOGETHER, THINK ISLAM, GANJA UNIVERSITY, CAPITALISM SUCKS DONKEY BALLS, TAKE YO PANTIES OFF, and MURDER 4 HIRE. Pet. App. 43a.

Second, trademarks are not understood by the public as statements made by the government. *Cf. Walker*, 135 S. Ct. at 2248 ("license plate designs are often closely identified in the public mind with the State") (citation, brackets, and internal quotation marks omitted); *Summum*, 555 U.S. at 471 (noting that when donated monuments are placed on land owned by the government, "persons who observe donated monuments routinely—and reasonably—

interpret them as conveying some message on the property owner's behalf. In this context, there is little chance that observers will fail to appreciate the identity of the speaker."); *Johanns*, 544 U.S. at 564-66 (rejecting the argument that the advertisements at issue would be attributed to parties other than the government). Trademarks are understood, correctly, as statements from their owners, not statements from the government. No reasonable person would think of FORD, TOYOTA, and MERCEDES-BENZ—not to mention CAPITALISM SUCKS DONKEY BALLS—as statements made by the government of the United States.

Finally, the government does not control the design or the content of trademarks. *Cf. Walker*, 135 S. Ct. at 2249 ("Texas maintains direct control over the messages conveyed on its specialty plates."); *Summum*, 555 U.S. at 473 ("The City has effectively controlled the messages sent by the monuments in the Park.") (citation and internal quotation marks omitted); *Johanns*, 544 U.S. at 562 ("the government sets the overall message to be communicated and approves every word that is disseminated"). The textual and graphic elements of trademarks are entirely within the control of trademark owners. All the government does is register the marks that satisfy the statutory criteria.

Trademark registration no more transforms a mark into government speech than copyright registration converts a copyrighted work into government speech. The publication of a trademark on the Principal Register is a statement by the government that the mark satisfies the statutory criteria for registra-

tion, but the government says no more than that. When it registers TOYOTA, the government does not say "Toyota"; when it registers CAPITALISM SUCKS DONKEY BALLS, the government does not say "capitalism sucks donkey balls." The government merely says that TOYOTA and CAPITALISM SUCKS DONKEY BALLS satisfy the Lanham Act's requirements for registration.

The government mistakenly finds significance (U.S. Br. 39) in the fact that the Principal Register is published by the PTO. But material published by the government often includes private speech. Congressional hearings include the testimony of private parties; no one thinks this testimony is government speech. The *United States Reports* formerly included the arguments of counsel; no one thought that counsel for private parties were speaking on the government's behalf. The speech at issue in *Cornelius* was published in government-printed literature and was distributed by government employees, to other government employees, in government workplaces, during government working hours. Yet the Court treated the speech as private speech, not government speech. *Cornelius*, 473 U.S. at 797-99.

Indeed, if the issuance of a trademark registration were enough to convert a trademark to government speech, the issuance of a copyright registration would do the same for copyrighted works, which would allow the government to strip works of copy-

right based on their viewpoint. That cannot be right.[6]

3. Trademarks are not pure commercial speech, and the disparagement clause would be contrary to the First Amendment even if they were.

The government contends (U.S. Br. 48) that trademarks are purely commercial speech. But trademarks are not purely commercial speech, and the disparagement clause would be unconstitutional even if they were.

Trademarks have both commercial and expressive functions. They identify the sources of goods and services and they also express points of view. In some trademarks, perhaps, the expressive component may be so minimal that it can be disregarded. *Friedman v. Rogers*, 440 U.S. 1 (1979), for instance, involved a bare-bones trade name ("Texas State Optical") that did not "editorialize on any subject, cultural, philosophical, or political," or "make generalized observations even about commercial matters."

---

[6] Amici Blackhorse et al. erroneously suggest (Blackhorse Br. 9-15) that the First Amendment does not restrict intellectual property regulation such as trademark and copyright. In fact, the Court has routinely applied the First Amendment to intellectual property regulation, including copyright and trademark-like protection. *See, e.g.*, *Golan v. Holder*, 132 S. Ct. 873 (2012); *Eldred v. Ashcroft*, 537 U.S. 186 (2003); *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987); *Harper & Row, Publishers, Inc. v. Nation Enters., Inc.*, 471 U.S. 539 (1985).

Id. at 11. The Court accordingly treated this trade name as commercial speech. *Id.*

In other trademarks, such as THE SLANTS, THINK ISLAM, or DYKES ON BIKES, the expressive component is the dominant feature of the mark. Such marks *do* editorialize on cultural, philosophical, and political subjects. They do more than merely facilitate commercial transactions. In such cases, where the commercial and expressive functions of speech "are inextricably intertwined, we cannot parcel out the speech, applying one test to one phrase and another test to another phrase. ... Therefore, we apply our test for fully protected expression." *Riley v. Nat'l Fed'n of the Blind*, 487 U.S. 781, 796 (1988).

Equally important, the disparagement clause regulates only the expressive component of trademarks, never the commercial component. As the Court of Appeals correctly concluded, "*every time* the PTO refuses to register a mark under § 2(a), it does so because it believes the mark conveys an expressive message." Pet. App. 25a. Other provisions in the Lanham Act regulate only the commercial component of trademarks. Even if these other provisions are assessed as regulations of commercial speech, the disparagement clause should not be, because it directly targets the viewpoint expressed by the trademark.

Classifying trademarks as pure commercial speech would produce very strange consequences. Commercial speech receives no First Amendment protection if it is misleading. *Thompson v. Western States Med. Ctr.*, 535 U.S. 357, 367 (2002). But many

trademarks take positions on contested issues. Such marks could be banned—not merely refused registration, but completely prohibited—if they were classified as commercial speech and deemed misleading. For example, GLOBAL WARMING SUCKS and GLOBAL WARMING IS GOOD! are both registered trademarks. Until recently, so was CITIZENS AGAINST THE GLOBAL WARMING HOAX. At least one of these marks must be misleading, and perhaps two are. If they were classified as commercial speech, the misleading ones would lose all First Amendment protection. The government would gain the power to prohibit their use.

In any event, even if trademarks were pure commercial speech, and even if the disparagement clause regulated trademarks' commercial components rather than their expressive components, the disparagement clause would still be contrary to the First Amendment. The Court has made clear that viewpoint discrimination is generally impermissible for commercial speech, just like for noncommercial speech. *Sorrell*, 564 U.S. at 571 (observing that "it is all but dispositive to conclude that a law is content-based and, in practice, viewpoint-discriminatory .... whether a special commercial speech inquiry or a stricter form of judicial scrutiny is applied"). For example, while the government may limit commercial advertising to prevent fraud, the government "may not prohibit only that commercial advertising that depicts men in a demeaning fashion," *R.A.V.*, 505 U.S. at 389, because such a prohibition would discriminate on the basis of viewpoint. "Commercial speech is no exception" to the rule that "[t]he First Amendment requires heightened scrutiny whenever

the government creates a regulation of speech because of disagreement with the message it conveys." *Sorrell*, 564 U.S. at 566 (internal quotation marks omitted).

Moreover, even if the disparagement clause did not discriminate on the basis of viewpoint, under the *Central Hudson* test the government would have to show that the disparagement clause directly advances a substantial state interest. *Thompson*, 535 U.S. at 367; *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557, 566 (1980). The government cannot make this showing.

First, the government can advance no interest other than that of preventing offense to listeners, but that is an interest the First Amendment renders off-limits, for commercial speech just as for noncommercial speech. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71-72 (1983); *Carey v. Population Servs., Int'l*, 431 U.S. 678, 701 (1977).

Second, even if the government had a substantial interest in preventing offense to listeners, the disparagement clause does not directly advance that interest. One can hardly say that denying registration to THE SLANTS and REPUBLICANS SHOULDN'T BREED, while permitting the registration of marks like TAKE YO PANTIES OFF and MURDER 4 HIRE, directly advances any interest in maintaining an inoffensive public discourse.

4. The government's "common thread" theory should be rejected.

In an implicit acknowledgement that registered trademarks are neither subsidies nor government speech, the government attempts (U.S. Br. 43) to blur these categories. The government suggests that although trademarks are not actually subsidies, they should be treated as if they were (U.S. Br. 17), and that although trademarks are not actually government speech (U.S. Br. 42), they should be treated as if they were (U.S. Br. 37). For the second time in recent years, the government advances a theory under which speech gets reduced protection or no protection at all when it shares a "common thread" (U.S. Br. 19) with categories of speech that get reduced or no protection, even when the speech does not fall within one of these categories. This theory should once again be rejected.

The Court has already rejected the government's theory. In *Stevens*, 559 U.S. at 469-70, the government suggested that depictions of animal cruelty should receive no First Amendment protection, on the ground that depictions of animal cruelty share a common thread with other forms of speech that receive no protection. Brief for the United States, *United States v. Stevens*, No. 08-769 (June 8, 2008), at 35 ("The depictions of animal cruelty at issue ... share several characteristics with other kinds of unprotected speech."). The Court found this theory "startling and dangerous." *Stevens*, 559 U.S. at 470. The Court held that it lacks "freewheeling authority to declare new categories of speech outside the scope of the First Amendment." *Id.* at 472. *See also Brown*

v. Entertainment Merchants Ass'n, 564 U.S. 786, 791-93 (2011) (rejecting a state's argument that violent speech should receive no First Amendment protection because it is analogous to obscenity).

Stevens disposes of the government's analogy to government speech, which receives no First Amendment protection. *Summum*, 555 U.S. at 467. Private speech cannot be denied First Amendment protection merely because it shares characteristics with government speech. Because such speech is private speech, it must be reviewed under existing doctrine, like any other private speech. *See Stevens*, 559 U.S. at 472.

The logic of *Stevens* disposes of the rest of the government's analogies as well. Certain categories of speech receive reduced First Amendment protection. Where speech does not fall within one of those categories, it cannot be treated as if it did, simply because it shares a common thread with speech that does. Thus speech cannot be given reduced protection on the ground that it is *similar to* commercial speech, if it is not actually commercial speech. Regulation cannot be given relaxed scrutiny on the ground that it *shares features with* a subsidy, if it is not actually a subsidy. These categories would be meaningless if courts had discretion to ignore them on an ad hoc basis.

II. The Lanham Act's disparagement clause does not bar the registration of Simon Tam's trademark.

Section 2(a)'s disparagement clause prohibits the registration of a trademark that "[c]onsists of or comprises ... matter which may disparage ... persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." 15 U.S.C. § 1052(a). This clause does not bar registration of THE SLANTS, for two reasons. First, the mark is simply not disparaging. Second, the statutory phrase "persons, living or dead" refers solely to natural and juristic persons, not to non-juristic entities such as racial or ethnic groups.[7]

---

[7] Because Simon Tam argued below that section 2(a) does not bar the registration of his trademark, he is entitled to defend the judgment below on this ground. *14 Penn Plaza LLC v Pyett*, 556 U.S. 247, 273 (2009). Even if that were not so, "it is a well-established principle governing the prudent exercise of this Court's jurisdiction that normally the Court will not decide a constitutional question if there is some other ground upon which to dispose of the case." *Bond v. United States*, 134 S. Ct. 2077, 2087 (2014) (citation and internal quotation marks omitted). A proper interpretation of section 2(a) is such a ground.

"Once a federal claim is properly presented, a party can make any argument in support of that claim; parties are not limited to the precise arguments they made below." *Yee v. City of Escondido*, 503 U.S. 519, 534 (1992); *see also Lebron v. National R.R. Passenger Corp.*, 513 U.S. 374, 379 (1995) (describing this as "[o]ur traditional rule"). Our claim is that section 2(a) does not bar the registration of Tam's trademark.

A. Simon Tam's trademark is not disparaging.

THE SLANTS, as used by Simon Tam to refer to his band, is not disparaging when the mark is considered in context. The PTO erroneously evaluates marks in isolation, shorn of context. That is not how ordinary people determine whether words are disparaging, so it cannot be what Congress intended when it prohibited the registration of disparaging marks.

Whether a word is disparaging depends primarily on context. To call someone an "assassin" is extremely disparaging in many circumstances, but the term is high praise on a football field. *See* Jack Tatum, *They Call Me Assassin* (1980). "Fat" may disparage the overweight, but when used in its alternative slang sense it is "a general term of approval," meaning "excellent, fantastic, attractive." *Green's Dictionary of Slang* (digital ed. 2016), https://greensdictofslang.com/entry/hvdvmki. In some contexts it is a compliment to call a person "punctual," but if that is the only adjective in a reference letter for a clerkship candidate, the reader will understand by such faint praise that the writer considers the candidate unfit for the job. Words are not disparaging in isolation. They disparage only when used in a context intended and understood to convey a negative viewpoint.

Even "nigger" and its variants are not disparaging when used with pride and understood that way. For example, the comedian and civil rights activist Dick Gregory entitled his 1964 autobiography *Nigger*. The

book sold more than a million copies. The comedian Richard Pryor won a Grammy Award for his 1974 album *That Nigger's Crazy*. One of the most well-known and influential musical groups of the 1980s and 1990s was N.W.A., which fans knew stood for "Niggaz Wit Attitudes." "Nigger" or "niggaz" can certainly be used in a disparaging way, but Gregory, Pryor, and N.W.A. did not use the terms that way, and their millions of fans did not interpret the terms as disparaging.

The same is true of THE SLANTS. Simon Tam and his band members are not disparaging Asian-Americans. They are doing precisely the opposite; they are appropriating a slur and using it as a badge of pride. Simon Tam is not a bigot; he is fighting bigotry with the time-honored technique of seizing the bigots' own language. "Slant" can certainly be used in a disparaging way, but Tam is not using it that way. Even the most cursory awareness of The Slants' music and the way it is packaged and marketed makes that clear.

If the PTO interpreted the statute literally, that would be enough to find that THE SLANTS does not "disparage" anyone. But the PTO instead uses a two-part test that is very different from the text of the statute. To determine whether matter in a trademark is disparaging, the PTO considers:

> 1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the man-

> ner in which the mark is used in the marketplace in connection with the goods or services; and
>
> 2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

Pet. App. 171a-172a. The PTO invented this test in *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1999 WL 375907, *36 (TTAB 1999), *rev'd on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003), and has applied it ever since.

Both parts of the PTO's test depart from the statute the PTO is ostensibly interpreting. The first part of the test tells examiners to rely on (a) dictionary definitions, (b) the design of the mark and its surrounding packaging, (c) the good or service being sold, and (d) the manner in which the applicant uses the mark. This list excludes the most important contextual considerations that make up the ordinary meaning of the word "disparage." Anyone familiar with The Slants' music and with Simon Tam's career would recognize instantly that Tam is not disparaging Asian-Americans by calling his band The Slants—anyone, that is, who is not constrained by the PTO's test. By excluding such contextual factors, the first part of the PTO's test treats Simon Tam as if he were a hate-spewing racist. The PTO's test would treat Dick Gregory and Richard Pryor as if they were George Wallace and Bull Connor. A

straightforward interpretation of the word "disparage" would not yield such absurd results.

The second part of the PTO's test is also contrary to the text of the statute. It tells examiners to determine whether the mark "may be disparaging to a substantial composite of the referenced group." A "substantial composite" means "not necessarily a majority," but the test provides no limit on how small a percentage of the referenced group must be offended. Pet. App. 172a. The test instructs examiners to refuse registration if a mark would be viewed as disparaging by a *minority* of a group's members, not if the mark would be viewed as disparaging by the affected group generally. But the statute does not include, or even hint at, this "substantial composite" formula. The statute bars the registration of disparaging marks, not marks that most members of the referenced group find non-disparaging.

The PTO's two-part test is not entitled to deference under *Chevron, U.S.A., Inc. v. NRDC*, 467 U.S. 837 (1984), because it is not a reasonable construction of the Lanham Act. The PTO's test does not clarify ambiguity in the disparagement clause. Rather, the PTO's test *rewrites* the disparagement clause, making it much easier for examiners to find disparagement than the text of the statute permits.

In this case, rather than considering the full context surrounding Simon Tam's use of THE SLANTS, the PTO simply looked up the word "slant" in several dictionaries. Pet. App. 163a-165a. Rather than asking whether Tam's use of THE SLANTS disparages Asian-Americans generally, the PTO quoted the

views of a blogger and a few self-styled spokespeople for Asian-Americans, Pet. App. 167a-168a, to conclude that "a substantial composite of the referenced group find the term objectionable." Pet. App. 181a. Had the PTO followed the text of the statute rather than its own two-part test, the outcome would have been different.

B. The disparagement clause bars the registration of marks that disparage natural and juristic persons, not marks that disparage non-juristic entities such as racial and ethnic groups.

The PTO also erred in construing section 2(a)'s bar on the registration of marks that may disparage "persons" to include marks that disparage non-juristic entities such as racial and ethnic groups. In fact, the quoted term includes only natural and juristic persons.

1. The text of the disparagement clause indicates that it does not bar the registration of marks that disparage minority groups.

The disparagement clause bars the registration of marks that disparage "persons," which is a defined term in the Lanham Act. "The term 'person' ... includes a juristic person as well as a natural person. The term 'juristic person' includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law." 15 U.S.C. § 1127. Non-juristic entities incapable of su-

ing and being sued, such as racial and ethnic groups, are not "persons" under this definition. Yet the PTO treats such groups as "persons" under the disparagement clause. *See, e.g., Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d 1600, 1999 WL 1040108, *5 (TTAB 1999).

The PTO is misinterpreting the statute. The disparagement clause bars the registration of marks—such as JOHN SMITH IS EVIL—that disparage *natural* persons. It also bars the registration of marks—such as THE REPUBLICAN PARTY IS EVIL—that disparage *juristic* persons. But the disparagement clause explicitly does *not* bar the registration of marks that disparage entities that are not juristic persons. Thus one can register LEFTHANDERS ARE EVIL or REDHEADS ARE EVIL or even ASIAN-AMERICANS ARE EVIL without running afoul of the disparagement clause.

To be sure, each individual Asian-American is a natural person. But the statute cannot be read to bar marks that disparage Asian-Americans on this ground, because *all* collective entities are made up of natural persons, including lefthanders, redheads, and all manner of associations and organizations that are not "juristic person[s]" because they are not capable of suing and being sued. If the disparagement of a non-juristic group were deemed to constitute the disparagement of the individuals who make up that group, the Lanham Act's distinction between juristic and non-juristic entities would be a nullity.

This conclusion is reinforced by the text of the sentence in which the disparagement clause is located. The disparagement clause immediately follows a

provision that bars registering a mark that comprises "immoral, deceptive, or scandalous matter." 15 U.S.C. § 1502(a). This provision is more sweeping than the disparagement clause, because it is not limited in scope by the definition of "person." It bars *all* matter that is immoral, deceptive, or scandalous. The disparagement clause could have been worded this way too, as a simple bar on all matter that is "disparaging," without reference to the word "person." So worded, the disparagement clause would have barred the registration of marks comprising matter disparaging to juristic and non-juristic entities alike. But Congress did not word the disparagement clause this way. The contrast between the two clauses provides further evidence that the disparagement clause does not bar the registration of marks that disparage non-juristic entities.

2. The history of the disparagement clause confirms that it does not bar the registration of marks that disparage minority groups.

The history of the disparagement clause confirms that it was not intended to protect racial and ethnic groups. The clause was added in 1939 to one of the bills that eventually became the Lanham Act in 1946. H.R. 4744, 76th Cong., 1st Sess. (1939), § 2(a). It is very unlikely that members of Congress were concerned about trademarks that were disparaging to racial or ethnic groups in a period when much worse forms of discrimination were still common and civil rights legislation was not yet on the horizon.

At the time, moreover, it was not unusual for registered trademarks to include racial epithets. Trademarks with registrations in effect during this period included NIGGER HEAD golf equipment (No. 221,097, registered in 1926 for a 20-year term), NIGGER PRIZE HEAD ice cream (No. 301,747, registered in 1933 for a 20-year term), NIGGER IN DE CANE PATCH syrup (No. 186,950, registered in 1924 for a 20-year term and renewed in 1944 for another 20-year term), and NIGGER BABY oranges and grapefruit (No. 217,067, registered in 1926 for a 20-year term and renewed in 1946 for another 20-year term). There is no evidence that the disparagement clause was intended to halt the registration of such trademarks. Rather, when the clause was discussed in Congress, the only examples of disparagement anyone mentioned concerned natural persons (such as Abraham Lincoln and George Washington) and juristic persons (including the New York Athletic Club and Harvard University). *Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents*, 76th Cong., 1st Sess. 19-21 (1939).

The purpose of the disparagement clause was not to protect minority groups. Rather, the purpose was to bring American trademark law into conformity with American treaty obligations. One of the primary objectives of the Lanham Act was, as the House and Senate reports both explained, "[t]o carry out by statute our international commitments." H.R. Rep. No. 219, 79th Cong., 1st Sess. 4 (1945); S. Rep. No. 1333, 79th Cong., 2d Sess. 5 (1946). Indeed, the full title of the Lanham Act is "An Act to provide for the

registration and protection of trade-marks used in commerce, to carry out the provisions of certain international conventions, and for other purposes." 60 Stat. 427 (1946).

At the time, the most recent of these international conventions was the Inter-American Convention for Trade Mark and Commercial Protection, which the United States ratified in 1931. 46 Stat. 2907 (1931). *See* Stephen P. Ladas, *The Lanham Act and International Trade*, 14 Law & Contemp. Probs. 269, 270 (1949) ("Prior to the adoption of the Lanham Act, our federal trade-mark legislation did not accord, in several respects, with the stipulations of the international or Pan American Conventions."); Harry Aubrey Toulmin, Jr., *The Trade-Mark Act of 1946* at 6 (1946) ("The bill ... eliminates those sources of friction with our Latin-American friends.").

Article 3.4 of the Inter-American Convention prohibited the registration of trademarks "[w]hich tend to expose persons, institutions, beliefs, national symbols or those of associations of public interest, to ridicule or contempt." 46 Stat. 2916. American trademark law included no such provision at the time. The Boston lawyer Harrison Lyman accordingly suggested that American law should bar the registration of any mark "which is calculated to bring into disrepute or ridicule anyone in the place or community he resides. That is the way our Latin friends interpret it." *Trade-Marks: Hearings on H.R. 9041 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents*, 75th Cong., 3d Sess. 80 (1938). Representative Lanham responded: "It seems to me to be

very good phraseology. ... We appreciate that suggestion, Mr. Lyman." *Id.*

As enacted, section 2(a) of the Lanham Act slightly reworded the Inter-American Convention provision without any loss in meaning. It barred the registration of marks that "disparage" or "bring ... into contempt, or disrepute" (rather than "expose ... to ridicule or contempt") the same list of plural nouns as in the Convention—persons, institutions, beliefs, and national symbols. The history of the disparagement clause thus confirms that the clause was not intended to protect minority groups against trademarks that use derogatory words.

3. For more than half a century, the PTO did not interpret the disparagement clause to bar the registration of marks that disparage minority groups.

After the enactment of the Lanham Act, the Patent Office (as it was then called) continued for many years to register trademarks that included text and images derogatory to minority groups. These marks included BLACK SAMBO candy (No. 521,115, registered in 1950), HONEY CHILE food (No. 534,667, registered in 1950, consisting of an image of a "pickaninny"), HIM HEEP BIG TRADER auto repair (No. 560,255, registered in 1952, consisting of an image of a Native American speaking to a motorist), GOLLIWOGG perfumes (No. 565,420, registered in 1952), WAMPUM INJUN corn chips (No. 734,604, registered in 1962), and U-NEED-UM tires (No. 797,805, registered in 1965, including an unflattering image of a

Native American). The Patent Office did not reject such marks as disparaging, in keeping with section 2(a)'s bar only on the registration of marks that disparage natural and juristic persons.

It was not until 1999, more than half a century after the enactment of the Lanham Act, that the TTAB first barred registration of a mark under the disparagement clause for including a word offensive to a racial or ethnic group. *See Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1999 WL 375907 (TTAB 1999) (holding that REDSKINS disparages Native Americans), *rev'd*, 284 F. Supp. 2d 96 (D.D.C. 2003). Since 1999, the TTAB has refused registration to several other marks on similar grounds. *See In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 2006 WL 1546500 (TTAB 2006) (holding that SQUAW disparages Native Americans); *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114 (TTAB 2008) (holding that HEEB disparages Jews); *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 2010 WL 766488 (TTAB 2010) (holding that KHORAN, used for wine, disparages Muslims); *In re Geller*, 2013 WL 2365001 (TTAB 2013) (holding that STOP THE ISLAMISATION OF AMERICA disparages Muslims); *In re Beck*, 114 U.S.P.Q.2d 1048, 2015 WL 1458229 (TTAB 2015) (holding that PORNO JESUS disparages Christians).

The contrast between the PTO's original view of the disparagement clause and its current view can be seen most starkly in *Lebanese Arak*, which presented facts virtually identical to a case from a half century before. In *In re Reemtsma Cigarettenfabriken G.M.B.H.*, 122 U.S.P.Q. 339, 1959 WL 6173 (TTAB 1959), when an applicant sought to register

SENUSSI for cigarettes, the TTAB determined that Senussi "is the name of a Moslem sect" the tenets of which "forbid the use of cigarettes." Because the use of the term "is an affront to such persons and tends to disparage their beliefs," the TTAB affirmed the denial of registration—not on the ground that the mark disparaged the Senussi sect, but on the ground that it was scandalous. *Id.* at *1. In *Lebanese Arak*, the mark was for wine, and it used the name of the Koran, which forbids alcoholic beverages. The TTAB refused registration on the ground that the mark was "disparaging to followers of Islam." *Lebanese Arak*, 2010 WL 766488, at *4. The TTAB explained in *Lebanese Arak* that although it had once assessed such marks under the "scandalous" provision of the Lanham Act, "it has become clear that the proper ground for refusing marks which would offend the sensibilities of an ethnic or religious group is that the matter is disparaging to the members of that group, rather than that the matter is offensive or scandalous." *Id.* at *3.

Despite the "juristic person" requirement in the Lanham Act, the TTAB now uses the disparagement clause to reject trademarks that disparage non-juristic groups. The PTO's interpretation of "person" to include non-juristic entities is not entitled to *Chevron* deference, because it flatly contradicts the text of the statute. The Lanham Act explicitly confines the disparagement bar to marks that disparage natural and juristic persons. Section 2(a) does not bar the registration of marks that disparage non-juristic entities, such as racial and ethnic groups.

III. The Lanham Act's disparagement clause is unconstitutionally vague.

The Due Process Clause "requires the invalidation of laws that are impermissibly vague." *FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012). The prohibition of vague laws serves two purposes: "first, that regulated parties should know what is required of them so they may act accordingly; second, precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory way." *Id.* "When speech is involved, rigorous adherence to these requirements is necessary to ensure that ambiguity does not chill protected speech." *Id.* For this reason, where a law burdens speech, "a more stringent vagueness test should apply." *Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 499 (1982).

The disparagement clause fails any vagueness test, stringent or not. The PTO's record speaks for itself. The Court of Appeals catalogued some of the highlights, in finding that "[t]he PTO's record of trademark registrations and denials often appears arbitrary and is rife with inconsistency." Pet. App. 33a n.7. The PTO refused registration to HAVE YOU HEARD SATAN IS A REPUBLICAN, because it disparaged the Republican Party, but did not find THE DEVIL IS A DEMOCRAT disparaging. The PTO has registered FAGDOG on some occasions, and on other occasions has found FAGDOG disparaging. After citing these examples and others, the Court of Appeals appropriately concluded: "We see no rationale for the PTO's seemingly arbitrary registration decisions, let alone

one that would give applicants much guidance." Pet. App. 33a n.7.

Part of the problem is the subjectivity inherent in deciding whether a word is disparaging. Different examiners in the PTO come to different conclusions about indistinguishable marks, because each has his or her own idea of what is disparaging. Just as the term "annoying" is an unconstitutionally vague basis for legal consequences because different people find different things annoying, *Coates v. City of Cincinnati*, 402 U.S. 611, 614 (1971), the term "disparage" is too vague a basis for burdening speech.

The PTO has been aware of this problem for some time. When Congress was considering the bill that became the Lanham Act, the Assistant Commissioner of Patents testified:

> I would like to make this suggestion with respect to the word "disparage." I am afraid that the use of that word in this connection is going to cause a great deal of difficulty in the Patent Office, because, as someone else has suggested, that is a very comprehensive word, and it is always going to be just a matter of the personal opinion of the individual parties as to whether they think it is disparaging.

Trade-Marks: Hearings on H.R. 4744, at 21. More recently, the PTO has acknowledged that "the guidelines for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one." *In re Over Our Heads, Inc.*, 16 U.S.P.Q.2d 1653, 1990 WL

354546, *1 (TTAB 1990) (citation, brackets, and internal quotation marks omitted). *See also Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1999 WL 375907, *35 (TTAB 1999) ("the determination of whether matter may be disparaging is highly subjective").

Another layer of vagueness is added by the statutory text, which does not merely bar the registration of marks that actually *do* disparage persons; it also bars the registration of marks that "*may* disparage" persons. This is subjectivity squared. What likelihood of disparagement suffices? No one knows, not even the PTO's own examiners. How could that likelihood be calculated? Again, no one knows.

The PTO has made the vagueness problem even worse by construing the statute non-literally to bar the registration of marks that disparage amorphous groups as well as natural and juristic persons. It can be hard enough to tell whether a mark disparages an individual or a company, but it is often far more ambiguous whether a mark disparages a race, or a gender, or any of the non-juristic groups to which we all belong. Is DANGEROUS NEGRO disparaging? AMISHHOMO? CELEBRETARDS? According to the PTO, the answers are no, yes, and no, Pet. App. 33a n.7, 35a, but the opposite answers would have been just as plausible.

The problem is compounded even further by the PTO's refusal to say how many members of the referenced group must perceive disparagement. All the PTO will say is that it must be "a substantial composite," which is "not necessarily a majority," Pet. App.

172a, but is presumably more than a single person. If a quarter or a tenth of the members of a group find a mark disparaging, is that a substantial composite? No one knows—again, not even the PTO's own examiners.

The PTO might as well be tossing a coin. It granted registration to HEEB in 2004 as the name of a magazine about Jewish culture, but refused registration to the same applicant for HEEB in 2008 as the name of a clothing line on the ground that the word is "a highly disparaging reference to Jewish people." *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114, *1 (TTAB 2008). The PTO refused registration in 2008 to MARRIAGE IS FOR FAGS on the ground that "fag" is "an offensive term for a gay man" (serial no. 77477549, office action 11/19/2008), but granted registration in 2005 to F.A.G. FABULOUS AND GAY. Pet. App. 33a n.7. Applicants have no way to predict what the PTO will do.

The list of arbitrary disparagement decisions goes on and on. The PTO granted registration in 1992 to WILD INJUN as the name of a "frame assembly for holding a ballcap when washed in a dishwasher" (reg. no. 1673489), but refused registration in 2007 to URBAN INJUN as the name of a booking service for Native American musicians, on the ground that the word "Injun" "refers to 'Native Americans' in a disparaging manner" (serial no. 77186637, office action 11/19/2007). The PTO granted registration in 2013 to DAGO SWAGG for athletic apparel, but refused registration in 2007 to DAGO MARY'S as the name of a restaurant on the ground that "Dago" is "an offensive slur against Italians and Italian Americans, intend-

ed to refer to them in a disparaging manner" (serial no. 78954137, office action 1/17/2007). Judge O'Malley put it well in her concurring opinion below: The disparagement clause's vagueness "provides the government with virtually unlimited ability to pick and choose which marks to allow and which to deny." Pet. App. 75a.

"Vague laws force potential speakers to 'steer far wider of the unlawful zone' ... than if the boundaries of the forbidden areas were clearly marked." *Brown v. Entertainment Merchants Ass'n*, 564 U.S. 786, 807 (2011) (Alito, J., concurring in the judgment) (quoting *Baggett v. Bullitt*, 377 U.S. 360, 372 (1964) (quoting *Speiser v. Randall*, 357 U.S. 513, 526 (1958))). The vagueness of the disparagement clause is a strong incentive to shy away from names the PTO might conceivably find disparaging, because it can be extraordinarily disruptive and costly to change the name of a product that is already in the market. The vagueness of a content-based speech regulation "raises special First Amendment concerns because of its obvious chilling effect on free speech." *Reno v. ACLU*, 521 U.S. 844, 871-72. The disparagement clause is a perfect example.

Vague speech restrictions do not just chill speech; they also facilitate "discriminatory enforcement." because a "vague law impermissibly delegates basic policy matters" to low-level decision-makers "for resolution on an *ad hoc* and subjective basis, with the attendant dangers of arbitrary and discriminatory application." *Grayned v. City of Rockford*, 408 U.S. 104, 108-09 (1972). The PTO's consideration and rejection of MARRIAGE IS FOR FAGS took place right in

the midst of the controversy over California's Proposition 8, which prohibited same-sex marriage. The applicant lived in California. We will never know whether the PTO's examiner was discriminating against the view expressed in the trademark, and that is precisely why vague speech restrictions like the disparagement clause are so pernicious.

The problem is not, as the government contends (U.S. Br. 51-52), merely that some of the PTO's less skillful examiners make occasional mistakes in applying the disparagement clause. The problem is deeper than that. The disparagement clause is too vague to be applied in a predictable manner, even by the best of examiners. The PTO itself has admitted that the clause is "vague" and that decisions under it are "highly subjective." The PTO has had seventy years to work on this problem, and it is no closer to a solution today than at any time in the past.

CONCLUSION

The judgment of the Court of Appeals should be affirmed.

Respectfully submitted,

STUART BANNER
EUGENE VOLOKH
UCLA School of Law
Supreme Court Clinic
405 Hilgard Ave.
Los Angeles, CA 90095

JOHN C. CONNELL
Counsel of Record
RONALD D. COLEMAN
JOEL G. MACMULL
Archer & Greiner, P.C.
One Centennial Square
P.O. Box 3000
Haddonfield, NJ 08033
(856) 795-2121
jconnell@archerlaw.com

RECORD AND BRIEFS.

Supreme Court, U.S.
FILED
JAN 9 - 2017
OFFICE OF THE CLERK

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

SIMON SHIAO TAM

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF FOR THE PETITIONER

IAN HEATH GERSHENGORN
Acting Solicitor General
Counsel of Record
Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217

TABLE OF CONTENTS

Page

A. Section 1052(a)'s disparagement provision does not burden speech 2
B. Section 1052(a) establishes eligibility criteria for a government program and does not discriminate based on viewpoint 6
C. The trademark-registration program is facially constitutional, like other government programs this Court has upheld 12
D. Respondents' statutory-construction and vagueness arguments lack merit 18

TABLE OF AUTHORITIES

Cases:

Agency for Int'l Dev. v. *Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321 (2013) 15
American Freedom Def. Initiative v. *Massachusetts Bay Transp. Auth.*, 781 F.3d 571 (1st Cir. 2015), cert. denied, 136 S. Ct. 793 (2016) 11
Boulevard Entm't, Inc., In re, 334 F.3d 1336 (Fed. Cir. 2003) 2, 23
Brown v. *Entertainment Merchs. Ass'n*, 564 U.S. 786 (2011) 5
Brunetti, In re, Serial No. 85310960, 2014 WL 3976439, (T.T.A.B. Aug. 1, 2014), appeal pending, No. 15-1109 (Fed. Cir. docketed Oct. 28, 2014) 18
Chevron U.S.A. Inc. v. *NRDC, Inc.*, 467 U.S. 837 (1984) 19
Cornelius v. *NAACP Legal Def. & Educ. Fund, Inc.*, 473 U.S. 788 (1985) 4
Cutter v. *Wilkinson*, 544 U.S. 709 (2005) 20
Davenport v. *Washington Educ. Ass'n*, 551 U.S. 177 (2007) 14

Cases—Continued: Page

Eldred v. *Ashcroft*, 537 U.S. 186 (2003) 16
FCC v. *Pacifica Found.*, 438 U.S. 726 (1978) 5, 11
Forsyth Cnty. v. *Nationalist Movement*, 505 U.S. 123 (1992) 4
Geller, In re, 751 F.3d 1355 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 944 (2015) 19, 22
Greyhound Corp. v. *Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1988 WL 252489 (T.T.A.B. Mar. 30, 1988) 8
Holder v. *Humanitarian Law Project*, 561 U.S. 1 (2010) 22
Lebanese Arak Corp., In re, 94 U.S.P.Q.2d 1215, 2010 WL 766488 (T.T.A.B. Mar. 4, 2010) 20
Legal Servs. Corp. v. *Velazquez*, 531 U.S. 533 (2001) 13
McGinley, In re, 660 F.2d 481 (C.C.P.A. 1981) 8, 18
Miller v. *California*, 413 U.S. 15 (1973) 17
National Endowment for the Arts v. *Finley*, 524 U.S. 569 (1998) 10, 22
Park 'N Fly, Inc. v. *Dollar Park & Fly, Inc.*, 469 U.S. 189 (1985) 6, 8
Perry v. *McDonald*, 280 F.3d 159 (2d Cir. 2011) 11, 15
Perry Educ. Ass'n v. *Perry Local Educators' Ass'n*, 460 U.S. 37 (1983) 10
R.A.V. v. *City of St. Paul*, 505 U.S. 377 (1992) 5, 11
Reed v. *Town of Gilbert*, 135 S. Ct. 2218 (2015) 5
Regan v. *Taxation With Representation of Wash.*, 461 U.S. 540 (1983) 12, 13
Ridley v. *Massachusetts Bay Transp. Auth.*, 390 F.3d 65 (1st Cir. 2004) 11
Rosenberger v. *Rector & Visitors of Univ. of Va.*, 515 U.S. 819 (1995) 4
Rust v. *Sullivan*, 500 U.S. 173 (1991) 3, 4, 12, 13, 17

Cases—Continued: Page

San Francisco Arts & Athletics, Inc. v. *United States Olympic Comm.*, 483 U.S. 522 (1987) 9, 16
Shinnecock Smoke Shop, In re, 571 F.3d 1171 (Fed. Cir. 2009), cert. denied, 558 U.S. 1149 (2010) 23
Simon & Schuster, Inc. v. *Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105 (1991) 5, 12
Snyder v. *Phelps*, 562 U.S. 443 (2011) 5
Sorrell v. *IMS Health Inc.*, 564 U.S. 552 (2011) 4, 5
Texas v. *Johnson*, 491 U.S. 397 (1989) 5
United States v. *Stevens*, 559 U.S. 460 (2010) 13
Wal-Mart Stores, Inc. v. *Samara Bros., Inc.*, 529 U.S. 205 (2000) 9
Walker v. *Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015) 9, 10, 13, 15
Wooley v. *Maynard*, 430 U.S. 705 (1977) 9
Ysursa v. *Pocatello Educ. Ass'n*, 555 U.S. 353 (2009) 3, 13

Constitution, treaties and statutes:

U.S. Const. Amend. I ..... *passim*
Paris Convention for the Protection of Industrial Property, Art. 6quinquies, July 14, 1967, 21 U.S.T. 1643-1645, 828 U.N.T.S. 331, 333 7
Act of July 5, 1946 (Lanham Act), ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*) 7
15 U.S.C. 1051 16
15 U.S.C. 1051(a)(1) 6
15 U.S.C. 1052 2
15 U.S.C. 1052(a) ..... *passim*
15 U.S.C. 1052(c) 21
15 U.S.C. 1057(a) 6

Statutes--Continued: Page

15 U.S.C. 1057(b) 7
15 U.S.C. 1062 6
15 U.S.C. 1064 23
15 U.S.C. 1070 23
15 U.S.C. 1071 23
15 U.S.C. 1072 7
15 U.S.C. 1091 6
15 U.S.C. 1115(a) 7
15 U.S.C. 1125(a) 3
15 U.S.C. 1127 ..... 16, 21
15 U.S.C. 1141b 7
17 U.S.C. 102 16
18 U.S.C. 48 13
20 U.S.C. 954(d)(1) 10
Tex. Transp. Code Ann. § 504.801(c) (West Supp. 2015) 11

In the Supreme Court of the United States

No. 15-1293

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE, PETITIONER

v.

SIMON SHIAO TAM

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

REPLY BRIEF FOR THE PETITIONER

The statutory provision at issue, 15 U.S.C. 1052(a), does not restrict speech. Instead, it declines to assist, and declines to associate the federal government with, marks containing disparaging terms. Congress sensibly chose not to spend federal resources on encouraging the use of racial epithets, religious insults, and profanity as trademarks—especially because, as part of the federal program, the United States Patent and Trademark Office (PTO) publishes registered marks and issues registration certificates, which are transmitted to foreign nations. In a variety of settings, this Court has recognized Congress's broad authority to grant or withhold assistance to private speakers, or to decline to associate the government with messages that Congress finds objectionable. These principles apply here.

Perhaps the most striking feature of respondent's brief is its unwillingness to acknowledge *any* federal power to withhold the benefits of federal trademark registration from marks within categories that Congress views as inappropriate to indicate source. Although respondent asserts an intent to "appropriat[e]" a racial slur and to "us[e] it as a badge of pride" (Br. 13), his First Amendment theory would apply equally to slurs used with disparaging intent. Under that theory, the PTO would be required to confer the benefits of registration on, and incorporate into its own communications, the vilest racial, sexual, and religious slurs.

Although the First Amendment gives respondent broad latitude to use racial slurs in his own communications, it does not require the government to assist him in that endeavor. The court of appeals therefore erred in facially invalidating Section 1052(a)'s disparagement provision. Respondent's statutory-construction and vagueness arguments also lack merit. The judgment of the court of appeals therefore should be reversed.

A. Section 1052(a)'s Disparagement Provision Does Not Burden Speech

1. Section 1052 defines the categories of marks that are "registrable on [the] principal register." 15 U.S.C. 1052. If a mark does not meet the criteria established by Congress, the only consequence is that it is refused registration. Although denial of registration renders certain federal benefits unavailable, it "does not affect the applicant's right to use the mark." *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003); see Gov't Br. 21-22.

Respondent therefore is "free to spread his chosen message to all who would listen without fear of government intervention or reprisal." Pet. App. 120a (Reyna, J., dissenting). Respondent may use THE SLANTS to identify his band and may invoke the federal cause of action and common-law protections to enforce his mark. See Gov't Br. 20-21 (citing 15 U.S.C. 1125(a)). Section 1052(a) simply renders unavailable certain additional legal benefits that federal registration of his mark would provide.

2. There is a fundamental constitutional difference between laws that regulate speech and laws that set parameters for participation in a government program. Gov't Br. 14-19. That distinction follows from the First Amendment's text, which "prohibits government from 'abridging the freedom of speech'" but "does not confer an affirmative right" to government assistance in speaking. *Ysursa* v. *Pocatello Educ. Ass'n*, 555 U.S. 353, 355 (2009) (quoting U.S. Const. Amend. I); see Gov't Br. 29 (citing additional cases). The government has much more flexibility when it does not "restrict" speech, but instead "declines to promote" it. *Ysursa*, 555 U.S. at 355; see Gov't Br. 28-31 (explaining that ineligibility for a government program is not itself a First Amendment burden).

To be sure, the provision of government funding or other assistance is not "invariably sufficient to justify Government control over the content of expression." *Rust* v. *Sullivan*, 500 U.S. 173, 199 (1991). For example, on types of public property that have traditionally been used for speech or expressive activity, particular restrictions have been held to violate the First Amendment despite the government's status as property

owner. See *id.* at 199-200. As respondent has acknowledged (C.A. En Banc Reply Br. 7, 9 n.6), however, the government has not created a forum here. The Principal Register and Supplemental Register are not places for mark owners to express themselves; they are official government reports of the results of the PTO's examination and registration of marks, in order to provide notice of the marks' ownership and use. And registration confers other advantages, and entails other forms of government participation, that bear no resemblance to public-forum settings.

Because there is no public forum here, cases such as *Rosenberger* v. *Rector & Visitors of University of Virginia*, 515 U.S. 819 (1995), are inapposite.[1] Nor has respondent identified any other basis for viewing trademark registration as "a traditional sphere of free expression so fundamental to the functioning of our society" that Congress's use of content-based distinctions is constitutionally proscribed. *Rust*, 500 U.S. at 200. Accordingly, "the general rule that the Government may choose not to subsidize speech applies with full force." *Ibid.*

3. Section 1052(a)'s disparagement provision is fundamentally different from laws this Court has found to "burden" speech. Respondent invokes (Br. 21) this Court's statement in *Sorrell* v. *IMS Health Inc.*, 564 U.S. 552, 566 (2011), that the government "may no[t]

---

[1] Petitioner also cites (Br. 22-24, 34) *Forsyth County* v. *Nationalist Movement*, 505 U.S. 123 (1992), which addressed restrictions on parade permits that were "prior restraint[s] on speech" in a "public forum," *id.* at 126, 130 (citation omitted), and *Cornelius* v. *NAACP Legal Defense & Educational Fund, Inc.*, 473 U.S. 788 (1985), which addressed a charitable fundraising campaign the Court described as a "nonpublic forum," *id.* at 799-806.

silence unwanted speech by burdening its utterance." But *Sorrell* involved a prohibition on disclosure or use of information about pharmaceutical prescription practices, *id.* at 563-564, not the denial of a government benefit. The other decisions petitioner cites (Br. 23-25) likewise involved bans, restrictions, or financial penalties on speech.[2] Denial of federal trademark registration, by contrast, leaves respondent free to use the term "slants" or any other insult or racial epithet without fear of government sanctions.

Contrary to respondent's characterization (Br. 24), Section 1052(a) does not impose a financial burden on speech. Unlike the authors who were required to relinquish book profits under the law at issue in *Simon & Schuster, Inc.* v. *Members of the New York State Crime Victims Board*, 502 U.S. 105 (1991), respondent is no worse off as a result of the government's adoption of a voluntary trademark-registration program. Respondent has all of the rights to use the mark that he would have in the absence of that program. If respondent's view were correct, then every government decision to selectively fund exercise of a constitutional right could be characterized as a "burden" on that right.

---

[2] See *Reed* v. *Town of Gilbert*, 135 S. Ct. 2218, 2224-2225 (2015) (banning display of certain signs); *Brown* v. *Entertainment Merchs. Ass'n*, 564 U.S. 786, 789 (2011) (ban on providing violent video games to minors); *Snyder* v. *Phelps*, 562 U.S. 443, 450 (2011) (tort liability for offensive funeral picketing); *R.A.V.* v. *City of St. Paul*, 505 U.S. 377, 380 (1992) (criminal ban on cross burning); *Simon & Schuster, Inc.* v. *Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 109-110 (1991) (law requiring authors to relinquish income from books about their crimes); *Texas* v. *Johnson*, 491 U.S. 397, 400 (1989) (criminal prosecution for flag burning); *FCC* v. *Pacifica Found.*, 438 U.S. 726, 730 (1978) (restriction on profanities).

B. Section 1052(a) Establishes Eligibility Criteria For A Government Program And Does Not Discriminate Based On Viewpoint

1. The basic purpose of the federal trademark-registration program is to facilitate commercial activity by providing enhanced legal benefits to certain marks that connect particular goods or services to their sources. See, *e.g.*, *Park 'N Fly, Inc.* v. *Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985). In creating that program, Congress precluded registration of generic, descriptive, and functional marks, as well as marks containing a person's name or likeness without consent, or a flag or national symbol, or scandalous or disparaging matter. Gov't Br. 22-23. The federal trademark-registration program has included these types of content-based restrictions for more than one hundred years. See Pet. App. 105a (Lourie, J., dissenting); Gov't Br. 23-24. Although the various restrictions on registrability serve somewhat different purposes, no one thinks that these restrictions are suspect simply because a person has a First Amendment right to use certain types of words. The federal registration program would be eviscerated if a vendor's First Amendment right to *use* particular words in labeling or advertising were held to imply a First Amendment right to *register* those words as trademarks.

Congress reasonably declined to associate the federal government with marks containing disparaging matter. The PTO publishes registered marks in official government publications and records them on the PTO's official register. See 15 U.S.C. 1051(a)(1), 1057(a), 1062, 1091. It also issues certificates of registration to mark owners "in the name of the United States," 15 U.S.C. 1057(a), and those certificates are

transmitted to other countries and to the World Intellectual Property Organization to facilitate enforcement abroad, see Paris Convention for the Protection of Industrial Property, Art. 6^{quinquies}, July 14, 1967, 21 U.S.T. 1643-1645, 828 U.N.T.S. 331, 333; see also 15 U.S.C. 1141b.

The government's association with a registered mark is by no means an incidental part of the trademark-registration program. Respondent identifies (Br. 19-20) various ways in which registration would strengthen his claim of ownership in the mark and enhance his ability to prevent others from using his mark. That assistance is available only because of the government's involvement in examining and publishing the mark. "[R]egistration serves as nationwide constructive notice of the registrant's claim of ownership," Resp. Br. 19 (citing 15 U.S.C. 1072), precisely because registered marks are listed in official government publications. "Registration constitutes prima facie evidence of the mark's validity and the registrant's exclusive right to use the mark," *ibid.* (citing 15 U.S.C. 1057(b) and 1115(a)), because a PTO examining attorney's determination that the prerequisites to registration are satisfied is entitled to weight. Respondent cannot obtain the advantages he seeks without the government's expending resources and becoming associated with the mark.

2. Respondent contends (Br. 30-31) that Section 1052(a)'s limitations "do not advance" the Lanham's Act purpose of promoting the identification of goods and services in commerce because disparaging marks can function effectively as source identifiers. But protecting and assisting consumers is one of the key goals of the federal trademark-registration system. See

Park 'N Fly, Inc., 469 U.S. at 198. Encouraging commercial actors to conduct business in a way that does not insult potential consumers furthers that objective. See Pet. App. 115a, 117a-118a (Reyna, J., dissenting) (explaining that use of disparaging terms "tends to disrupt commercial activity and to undermine the stability of the marketplace in much the same manner as discriminatory conduct"); see also Members of Congress Amicus Br. 5-6. The government likewise has an interest in encouraging marks that identify and promote a person's own goods and services without disparaging competitors. See *Greyhound Corp.* v. *Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635, 1988 WL 252489, at *4-*5 (T.T.A.B. Mar. 30, 1988). And the government has a significant interest in preventing the incorporation of racial slurs and other insults into official federal records and publications.

Congress reasonably declined to provide federal incentives for commercial actors to identify their products with racial epithets, insults, or profanity. See Pet. App. 81a (Dyk, J., concurring in part and dissenting in part). This is not a restriction on respondent's behavior, but "a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government." *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981), overruled by Pet. App. 1a-122a. And while "preventing offense to listeners" (Resp. Br. 1) would be a constitutionally insufficient rationale for a *ban* on the use of disparaging language, Congress may seek to encourage the use of non-disparaging marks by making the benefits of federal registration unavailable for racial slurs and personal insults.

Respondent's apparent view is that, because the trademark-registration program was not designed to

convey any affirmative government message, registration of disparaging or otherwise offensive marks cannot undermine the program's operation. But there is no logical inconsistency between (a) Congress's general preference for non-disparaging trademarks, and (b) Congress's willingness to leave the choice of suitable marks, within broad parameters, to private commercial actors. And the interests of both private and governmental actors in disassociating themselves from language or symbols they find offensive are not limited to situations where those actors have a specific contrary message to convey. See *Walker* v. *Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2253 (2015) (private organization "cannot force Texas to include a Confederate battle flag on its specialty license plates"); *Wooley* v. *Maynard*, 430 U.S. at 705, 715-717 (1977) (State could not require private motorist to display state motto on his license plate).

3. Respondent emphasizes (see, *e.g.*, Br. 35-37) that some trademarks, including THE SLANTS, have expressive aspects and/or are part of a larger expressive endeavor. The purpose of a trademark, however, is to identify source, and many of the most effective trademarks are fanciful, arbitrary, or suggestive terms that communicate nothing other than source. See *Wal-Mart Stores, Inc.* v. *Samara Bros., Inc.*, 529 U.S. 205, 212-213 (2000); see also 15 U.S.C. 1127. This Court has described trademarks as "commercial speech," which receives "a limited form of First Amendment protection." *San Francisco Arts & Athletics, Inc.* v. *United States Olympic Comm.*, 483 U.S. 522, 535 (1987) (citation omitted). And the statutory restrictions on the marks that may be registered leave respondent free to use

whatever words he wishes to identify and promote his services.

Respondent's assertion (Br. 36) that "the disparagement clause regulates only the expressive component of trademarks, never the commercial component," gets the matter exactly backwards. Federal registration is advantageous principally because it assists the mark owner in obtaining redress from infringers. See p. 7, *supra*; Resp. Br. 19-20. Respondent asserts a First Amendment right not simply to government assistance, but to government assistance in suppressing his competitors' speech. Denial of registration renders those *commercial* advantages unavailable, but it does not impair the mark owner's ability to *use* the mark for his own expressive purposes.

4. Respondent contends (Br. 15-19) that Section 1052(a) discriminates on the basis of viewpoint. But Section 1052(a)'s disparagement provision is "not an effort to suppress expression merely because public officials oppose the speaker's view." *Perry Educ. Ass'n* v. *Perry Local Educators' Ass'n*, 460 U.S. 37, 46 (1983). Marks that disparage Democrats and marks that disparage Republicans, for example, are equally unregistrable. Congress permissibly chose not to encourage adoption of "disparag[ing]" terms as trademarks, 15 U.S.C. 1052(a), just as Congress previously chose not to fund art inconsistent with "general standards of decency and respect for the diverse beliefs and values of the American public," *National Endowment for the Arts* v. *Finley*, 524 U.S. 569, 572 (1998) (quoting 20 U.S.C. 954(d)(1)), and just as the State of Texas declined to issue specialty license plates that "might be offensive to * * * the public." *Walker*, 135 S. Ct. at

2245 (quoting Tex. Transp. Code Ann. § 504.801(c) (West Supp. 2015)).

Respondent contends (Br. 16) that Section 1052(a) turns on viewpoint because it permits registration of marks that "express a positive or neutral view of a person," but not those that "express a negative view." But Section 1052(a) does not "disfavor[] * * * one side of a debate," *ibid.*, since no side may register racial epithets or personal insults. The Court made this point in *R.A.V.* v. *City of St. Paul*, 505 U.S. 377 (1992), when it explained that a statute prohibiting the use of "odious racial epithets" by "proponents of all views" would not discriminate based on viewpoint. *Id.* at 391. Relying on *R.A.V.*, the First Circuit concluded that limiting disparaging transit advertisements was not a viewpoint-based "attempt[] to give one group an advantage over another in the marketplace of ideas." *Ridley* v. *Massachusetts Bay Transp. Auth.*, 390 F.3d 65, 91 (1st Cir. 2004); see *American Freedom Def. Initiative* v. *Massachusetts Bay Transp. Auth.*, 781 F.3d 571, 574 (1st Cir. 2015), cert. denied, 136 S. Ct. 793 (2016).

Respondent notes (Br. 17-18) that Section 1052(a) is not limited to racial epithets; that the Court in *R.A.V.* did not actually rule on the constitutionality of a ban on racial epithets; and that libel and fighting words are unprotected speech. But respondent offers no affirmative reason that treating disparaging trademarks as categorically unregistrable should be equated, for First Amendment purposes, with attempts to suppress disfavored messages. Instead, it is similar to the FCC's decision to limit the use of profanities on the radio, see *FCC* v. *Pacifica Found.*, 438 U.S. 726, 743-745 (1978), or to Vermont's decision not to allow scatological terms on vanity license plates, *Perry* v. *McDonald*, 280 F.3d

159, 170 (2d Cir. 2011), both of which were viewpoint-neutral. Any concern that Section 1052(a) might "drive certain ideas or viewpoints from the marketplace," *Simon & Schuster*, 502 U.S. at 116, is further alleviated by the fact that the disparagement provision does not limit speech at all, but simply renders unavailable the additional benefits that attend federal registration. See Gov't Br. 43-44.

C. The Trademark-Registration Program Is Facially Constitutional, Like Other Government Programs This Court Has Upheld

1. This Court has frequently upheld eligibility criteria for government programs that have the effect of encouraging speech, on the theory that the government has broad (though not unlimited) authority to "selectively fund a program to encourage certain activities it believes to be in the public interest." *Rust*, 500 U.S. at 193; see Gov't Br. 14-19. Because "a legislature's decision not to subsidize the exercise of a fundamental right does not infringe the right," the Court has rejected the view that "strict scrutiny applies whenever Congress subsidizes some speech, but not all speech." *Regan* v. *Taxation With Representation of Wash.*, 461 U.S. 540, 548-549 (1983).

Respondent argues (Br. 25-31) that this principle is inapposite here because the present case does not fit neatly within any one of the doctrinal boxes this Court's precedents have identified. But the Court has treated those doctrinal categories as reflecting an overarching principle that the government ordinarily has no obligation to *assist* private speakers. Thus, the Court has relied on a decision involving direct financial benefits in a case about a different form of government assistance (the provision of a payroll-deduction mechanism), see

Ysursa, 555 U.S. at 358 (citing *Regan*, 461 U.S. at 549); and on a financial-subsidy decision in a case implicating government-speech interests, see *Walker*, 135 S. Ct. at 2246 (citing *Rust*, 500 U.S. at 194). And while the Court initially described *Rust* as a case involving "subsidies," 500 U.S. at 192, it later characterized *Rust* as also implicating "governmental speech," *Legal Servs. Corp.* v. *Velazquez*, 531 U.S. 533, 541 (2001)—underscoring that fundamental principles, not neat doctrinal boxes, drive the Court's analysis.

When the Court has analyzed a new government program that selectively assists speech, it has begun with the overarching principle that failure to assist speech does not abridge speech and has then evaluated the challenged program on its own terms. See Gov't Br. 15-19. Deciding this case in the government's favor thus does not require breaking new doctrinal ground or addressing any other programs; it requires applying well-settled principles to the particular program at issue.[3]

---

[3] Respondent's reliance (Br. 39-40) on *United States* v. *Stevens*, 559 U.S. 460 (2010), is misplaced. The law at issue in *Stevens* did not simply deny government assistance; it "criminalize[d] the commercial creation, sale, or possession of certain depictions of animal cruelty." *Id.* at 464 (citing 18 U.S.C. 48). In holding the statute unconstitutionally overbroad, see *id.* at 481-482, the Court disavowed any "freewheeling authority to declare new categories of speech outside the scope of the First Amendment," *id.* at 472. This case, by contrast, does not involve any prohibition on speech; and the government does not contend that respondent's use of the term THE SLANTS to identify his band is "outside the scope of the First Amendment." Rather, our argument is that, under "the general rule that the Government may choose not to subsidize speech," *Rust*, 500 U.S. at 200, respondent's speech is not "abridge[d]" by the government's refusal to assist it, *Ysursa*, 555 U.S. at 355 (citation omitted). Nothing in *Stevens* suggests that this fundamental First

2. The federal trademark-registration criteria are like other program criteria that have satisfied First Amendment scrutiny. The registration program defines eligibility for a form of government assistance; the eligibility criteria further Congress's policy preferences; and the government assistance depends only on the nature of the trademark the applicant seeks to register, not on the speech or other activities of mark owners outside the program. See Gov't Br. 35-37.

Respondent offers no sound basis for distinguishing the trademark-registration program from others this Court has upheld. A government program need not involve an "actual disbursement[] of funds" or its "equivalent" (Resp. Br. 26) to be analyzed as a form of selective assistance of speech: *Walker*, *Ysursa*, and *Davenport* v. *Washington Education Association*, 551 U.S. 177 (2007), all involved forms of assistance other than the direct provision of government money. See Gov't Br. 41. And the benefits that trademark registrants obtain follow directly from the resources the government invests in administering the program. See p. 7, *supra*; Gov't Br. 27-28; see also Pet. App. 94a (Dyk, J., concurring in part and dissenting in part).

3. Contrary to respondent's contention (Br. 31-35), this case squarely implicates the distinct concerns that underlie this Court's government-speech jurisprudence. Respondent asserts (Br. 31) that registration of a trademark "does not convert the trademark into government speech." It is true that, even after a mark is registered, the owner's placement of the mark on goods or advertisements in commerce is private rather than government speech. But registration *also* causes the

---

Amendment principle is limited to the specific forms of government assistance that the Court has previously had occasion to analyze.

mark to be placed on the PTO's Principal Register or Supplemental Register and on certificates of registration, which are communicated to foreign governments. This incorporation of marks into official government documents and records is not an incidental feature of the trademark-registration program; it is how the program works.

Respondent argues (Br. 32-34) that government-speech principles are inapplicable because trademarks are chosen by their owners and are neither intended nor understood to communicate any governmental message. The Court in *Walker*, however, applied government-speech principles to a similar hybrid communication, holding that a private organization had no First Amendment right to have a design of its own choosing reproduced on specialty license plates produced and issued by the State of Texas. 135 S. Ct. at 2246-2253. The federal government has an analogous interest in resisting the incorporation of racial slurs and other disparaging language into its own communications. See Gov't Br. 37-41; see also *Perry*, 280 F.3d at 169 ("The state has a legitimate interest in not communicating the message that it approves of the public display of offensive scatological terms on state license plates.").

4. Contrary to respondent's contention (Br. 30-31), Section 1052(a) does not impose an unconstitutional condition on speech. A condition on participation in a government program is impermissible when it "seek[s] to leverage funding to regulate speech outside the contours of the program itself," rather than "defin[ing] the limits of" the program. *Agency for Int'l Dev.* v. *Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013). Section 1052(a) limits the range of marks that

may be registered, but it does not prevent owners of registered trademarks from engaging in any other type of speech. See Gov't Br. 31-34; Law Professors (Farley) Amicus Br. 20-29.

5. Respondent contends (Br. 26-28, 33-34) that, if Section 1052(a)'s disparagement provision is held to be constitutional, the government could deny copyright protection to works based on their content. That is incorrect. If Congress barred the U.S. Copyright Office from registering copyrights in particular types of creative works, the First Amendment analysis would depend in part on the precise legal consequences that denial of registration entailed and on the justifications offered for the ban. But in conducting that analysis, a court would take account of the different purposes that trademark and copyright laws have historically served, and of the special role that copyright has historically played in facilitating free expression.

There is a significant difference between a trademark, which is a source identifier for goods and services to facilitate commerce, 15 U.S.C. 1051, 1127; *San Francisco Arts & Athletics, Inc.*, 483 U.S. at 535, and a copyright, which protects expression itself, *i.e.*, "original works of authorship fixed in a[] tangible medium of expression," 17 U.S.C. 102. Trademarks by their nature serve to identify the sources of goods or services in commerce. By contrast, this Court has described copyright law as "the engine of free expression" and has explained that, "[b]y establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create and disseminate ideas." *Eldred* v. *Ashcroft*, 537 U.S. 186, 219 (2003) (citation omitted).

Because copyrighted creative works are *themselves* the goods that the author seeks to market, rather than simply source identifiers for such goods, content-based limits on copyright registrability (or on copyright protection) likely would have much more significant impacts on protected expression than analogous limits in the trademark-registration context. That would be particularly true if eligibility for copyright registration could be refused based on a portion of a much longer work, rather than on the work as a whole. Cf. *Miller* v. *California*, 413 U.S. 15, 24 (1973) (explaining that whether a work is obscene depends on an analysis of the work "as a whole"). And while significant content-based restrictions on registrability have long been a feature of federal trademark law, see p. 6, *supra*, those provisions lack any meaningful analogue in past or present copyright statutes. Cf. *Rust*, 500 U.S. at 199-200 (discussing significance of traditional practices in identifying exceptions to "the general rule that the Government may choose not to subsidize speech"). Nothing in the government's position here would prevent those differences from being taken into account in conducting First Amendment analysis of a (hypothetical) Act of Congress that barred registration of copyrights in "disparaging" works.

6. Respondent's apparent view is that, so long as he has a First Amendment right to *use* particular words or images to market his products, the PTO cannot refuse to register those words or images as trademarks, at least on the ground that they are disparaging or otherwise offensive. Under that approach, the federal government would be required to register and prepare certificates for transmittal to foreign nations of marks that include words widely regarded as the most offensive

terms for African-Americans, women, or gay people; offensive racial and ethnic caricatures; religious insults and demeaning pictures of religious figures; and marks that disparage foreign nations. See, *e.g.*, Pet. App. 101a (Dyk, J., concurring in part and dissenting in part); Blackhorse Amicus Br. 21-22; Members of Congress Amicus Br. 7-8.

Respondent's arguments also apply to the other content-based distinctions in Section 1052(a), including the ban on registration of "scandalous" marks, which the PTO invokes to refuse registration of profanities and sexual imagery. See Gov't Br. 23 n.6 (discussing *In re Brunetti*, Serial No. 85310960, 2014 WL 3976439, at *4-*6 (T.T.A.B. Aug. 1, 2014) (non-precedential opinion), appeal pending, No. 15-1109 (Fed. Cir. docketed Oct. 28, 2014)). In respondent's view, the PTO is constitutionally required to register and transmit marks containing all variety of profanities, as well as sexual images and pictures of genitalia. See, *e.g.*, *McGinley*, 660 F.2d at 486. Such an approach would unreasonably deprive the federal government of the flexibility, in administering a program designed to facilitate commerce, to decline to encourage (or to associate itself with) the use of profanities and offensive sexual images as source identifiers.

D. Respondents' Statutory-Construction And Vagueness Arguments Lack Merit

Respondent contends (Br. 41-59) that his own mark is not covered by Section 1052(a)'s disparagement provision, and that the provision is unconstitutionally vague. Those arguments lack merit.[4]

---

[4] At the certiorari stage, respondent raised several arguments in addition to its First Amendment argument. See Br. in Opp. 13-21, 30-33. The government noted that respondent had not raised one of

1. Respondent contends (Br. 42-46) that the PTO uses the wrong standard for finding a mark "disparag[ing]" under Section 1052(a). But respondent acknowledges that his own mark is a "derogatory reference to Asian-Americans," and he characterizes it as a racial "slur" that he wishes to "reappropriat[e]." Br. 2, 13, 43. The en banc court of appeals likewise recognized that substantial evidence supported the PTO's finding that respondent's mark "is disparaging." Pet. App. 12a n.3. Respondent did not challenge the PTO's test below, see Cert. Reply Br. 6, and he does not propose any different test for determining whether a mark is disparaging.

In any event, the PTO's two-part test reflects a permissible interpretation of the statute. See *Chevron U.S.A. Inc.* v. *NRDC, Inc.*, 467 U.S. 837, 843-844 (1984). The PTO first determines the meaning of a mark, then asks whether that meaning is disparaging to a substantial composite of the referenced group. Pet. App. 171a-172a; see *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 944 (2015). That objective approach is consistent with Section 1052(a)'s text, which focuses on the "matter" for which registration is sought, not on the state of mind of the would-be registrant. 15 U.S.C. 1052(a).

Respondent asserts (Br. 42) that the PTO evaluates "marks in isolation, shorn of context." But while the PTO

---

his statutory-construction arguments below and recommended that, if the Court wished to address that issue, it should explicitly request briefing on the question presented when it granted certiorari. See Cert. Reply Br. 9. The Court granted certiorari without requesting briefing on any question other than the First Amendment issue decided below and raised in the certiorari petition. See 137 S. Ct. 30 (2016).

does not consider the would-be registrant's intent in using the mark, the agency considers not only definitions of the challenged element, but also "the relationship of [that element] to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services." *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 2010 WL 766488, at *3 (T.T.A.B. Mar. 4, 2010). Respondent also complains that the PTO looks to the views of a "substantial composite" of the referenced group to determine if particular matter is disparaging. Br. 45 (citation omitted). But that is an objective, reasonable way to ascertain whether a term is disparaging.

2. Respondent further argues (Br. 46-53) that Section 1052(a)'s disparagement provision applies only to marks including matter that disparages "natural and juristic persons," not groups of people. Respondent did not present that argument to the Trademark Trial and Appeal Board or to the court of appeals, and he identifies no court that has decided the issue. See *Cutter* v. *Wilkinson*, 544 U.S. 709, 718 n.7 (2005) ("[W]e are a court of review, not of first view.").

Section 1052(a) refers to a mark containing matter that disparages "persons, living or dead, institutions, beliefs, or national symbols." 15 U.S.C. 1052(a). That language easily encompasses the mark at issue here, since a mark that refers disparagingly to Asians as a group disparages "persons." And Congress would have no evident reason to preclude registration of a mark that insults a single Asian-American on account of his ancestry, while allowing registration of a mark that insults all Asian-Americans. If Congress had intended

that result, it could have used the term "a particular individual" or similar language, as it did two paragraphs later in the statute, when it prohibited registration of a mark that consists of "a name, portrait, or signature identifying a *particular living individual.*" 15 U.S.C. 1052(c) (emphasis added).

Respondent premises his argument (Br. 46-47) on the statutory definition of "person," which states that "[t]he term 'person' * * * *includes* a juristic person as well as a natural person." 15 U.S.C. 1127 (emphasis added). That definition encompasses artificial entities like corporations, but it does not render the disparagement provision inapplicable to marks that disparage groups of natural persons. The PTO's construction makes particular sense in the context of the disparagement provision as a whole, which refers to disparagement of "persons, living or dead, institutions, beliefs, or national symbols." 15 U.S.C. 1052(a). Congress's inclusion of "institutions," "beliefs," and "national symbols" makes clear that the provision is not limited to marks that disparage individual persons. And it would make little sense to preclude registration of the mark THE REPUBLICAN PARTY IS EVIL (Resp. Br. 47) while allowing registration of the mark REPUBLICANS ARE EVIL.

3. Finally, respondent contends (Br. 54-59) that Section 1052(a)'s disparagement provision is unconstitutionally vague. But Section 1052(a) is not vague as to respondent; he acknowledges that the term "slants" (when used in reference to Asians) is disparaging, though he asserts an intent to "reappropriat[e]" the mark. *Id.* at 2, 13, 43. Because his mark is clearly covered, respondent "cannot complain of the vagueness of

the law as applied to the conduct of others." *Holder* v. *Humanitarian Law Project*, 561 U.S. 1, 18-19 (2010).

For more difficult cases, the PTO looks to the settled legal meaning of the word "disparage" in Section 1052(a). Under the PTO's two-part test, a disparaging mark is one that "slight[s], deprecate[s], degrade[s], or affect[s] or injure[s] by unjust comparison." *Geller*, 751 F.3d at 1358 (citations omitted; brackets in original). Because the PTO uses an objective, established test for disparagement, the contours of which have been explored and elaborated in published administrative and judicial decisions, the public has fair notice as to the standards for, and evidence relevant to, determining which marks are unregistrable. Respondent has not provided any alternative standard for identifying "disparag[ing]" marks; his view is that Congress cannot limit registration of marks comprised of racial epithets, religious insults, and profanities at all.

The existence of close cases at the margins provides no sound basis for declaring the provision facially invalid. Because Section 1052(a) does not prohibit speech or impose any civil or criminal penalties, but simply confers benefits on owners of marks that satisfy the statutory criteria, the vagueness standard is relaxed. See *Finley*, 524 U.S. at 588-589; see also *id.* at 599 (Scalia, J., concurring in the judgment). Under that relaxed standard, the Court has upheld even criteria that are "undeniably opaque," *id.* at 588-589—which Section 1052(a) is not.

Citing instances in which superficially similar marks were treated differently during registration, respondent argues (Br. 57-58) that Section 1052(a) is arbitrarily enforced. But analysis of whether a mark is disparag-

ing requires consideration of the mark's meaning in relation to the particular goods and services for which registration is sought and the context in which the mark is used. See *Boulevard Entm't, Inc.*, 334 F.3d at 1341-1343. And respondent has not identified any instance where the PTO has used its standard to favor a particular viewpoint.

In any event, the PTO examines more than 300,000 trademark applications each year. If an individual PTO employee improperly registers (or refuses to register) a mark, that error "do[es] not bind the USPTO to improperly register" or refuse to register similar marks in the future. *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174 (Fed. Cir. 2009), cert. denied, 558 U.S. 1149 (2010). Congress has authorized administrative and judicial review to ensure that such errors may be corrected, see 15 U.S.C. 1070, 1071, and if they are not, Congress has authorized cancellation of erroneous registrations on Section 1052(a) grounds "[a]t any time," 15 U.S.C. 1064. Those provisions reflect Congress's recognition that registration errors occasionally occur. Thus, even if respondent could identify a clear inconsistency between particular registration decisions, there would be no sound basis for concluding that Section 1052(a)'s disparagement provision is incapable of principled application.

* * * * *

For the foregoing reasons and those stated in our opening brief, the judgment of the court of appeals should be reversed.

Respectfully submitted.

IAN HEATH GERSHENGORN
Acting Solicitor General

JANUARY 2017

RECORD AND BRIEFS

Supreme Court, U.S.
FILED
DEC 16 2016
OFFICE OF THE CLERK

No. 15-1293

IN THE
Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,
Petitioner,

v.

SIMON SHIAO TAM,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF AMICUS CURIAE ALLIANCE DEFENDING FREEDOM IN SUPPORT OF RESPONDENT

DAVID A. CORTMAN
RORY T. GRAY
ALLIANCE DEFENDING FREEDOM
1000 Hurricane Shoals Rd. N.E., Ste. D-1100
Lawrenceville, GA 30043
(770) 339-0774

KRISTEN WAGGONER
KEVIN H. THERIOT
Counsel of Record
ALLIANCE DEFENDING FREEDOM
15100 N. 90th Street
Scottsdale, AZ 85260
(480) 444-0020
ktheriot@ADFlegal.org

Counsel for Amicus Curiae

QUESTION PRESENTED

The disparagement clause in section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), prohibits the registration of a trademark that "may disparage ... persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." The question presented is whether the disparagement clause is contrary to the First Amendment.

TABLE OF CONTENTS

QUESTION PRESENTED i

TABLE OF AUTHORITIES iii

INTEREST OF AMICUS CURIAE 1

SUMMARY OF ARGUMENT 1

ARGUMENT 2

I. First Amendment Protection for Disparaging Speech is Vital to Freedom. 2

II. Use of Vague Terms Like "Disparaging" to Penalize Speech Allows for Unbridled Discretion. 5

III. Burdening Disparaging Speech by Denying Trademark Registration is Impermissibly Overbroad. 6

CONCLUSION 8

TABLE OF AUTHORITIES

Cases:

Board of Regents of University of Wisconsin System v. Southworth, 529 U.S. 217 (2000) 5

Broadrick v. Oklahoma, 413 U.S. 601 (1973) 7

Brown v. Entertainment Merchant Association, 564 U.S.786 (2011) 6

City of Lakewood v. Plain Dealer Publishing Co., 486 U.S. 750 (1988) 6

Dambrot v. Central Michigan University, 55 F.3d 1177 (6th Cir. 1995) 8

De Jonge v. Oregon, 299 U.S. 353 (1937) 4

Doe v. University of Michigan, 721 F. Supp. 852 (E.D. Michigan 1989) 8

Killion v. Franklin Regional School District, 136 F. Supp. 2d 446 (W.D. Pa. 2001) 8

R.A.V. v. City of St. Paul, 505 U.S. 377 (1992) 3

Reed v. Town of Gilbert, 135 S. Ct. 2218 (2015) 1

Rosenberger v. Rector & Visitors of University of Virginia, 515 U.S. 819 (1995) 2

Saxe v. State Collection Area School District, 240 F.3d 200 (3rd Cir. 2001). 7

Shuttlesworth v. City of Birmingham, 394 U.S. 147 (1969) 6

Sypniewski v. Warren Hills Regional Board of Education, 307 F.3d 243 (3d Cir. 2002) 7

Terminiello v. City of Chicago, 377 U.S. 1 (1949) ..... 2 - 5

Tinker v. Des Moines Independent Commission School District, 393 U.S. 503 (1969) 5

UVM Post, Inc. v. Board of Regents of the University of Wisconsin System, 774 F. Supp. 1163 (E.D. Wis. 1991) 8

Statute:

15 U.S.C. § 1052(a) 1

INTEREST OF AMICUS CURIAE[1]

Alliance Defending Freedom is a not-for-profit public interest legal organization providing strategic planning, training, funding, and direct litigation services to protect civil liberties and family values. Since its founding in 1994, Alliance Defending Freedom has played a role, either directly or indirectly, in dozens of cases before the Supreme Court, numerous cases before the courts of appeals, and in hundreds of cases before federal and state courts across the country, as well as in tribunals around the world.

Alliance Defending Freedom and its over 3,000 allied attorneys regularly litigate free speech cases. We rely on the Free Speech Clause to protect individuals and organizations whose speech is restricted by laws and errant government officials. *See, e.g.*, *Reed v. Town of Gilbert*, 135 S. Ct. 2218 (2015). Alliance Defending Freedom has strong interest in ensuring that laws and regulations discriminating based on content and viewpoint undergo the strictest of scrutiny.

SUMMARY OF ARGUMENT

The disparagement clause of the Lanham Act, 15 U.S.C. § 1052(a), is another in a line governmental

---

[1] The parties to this case have consented to the filing of this brief and letters indicating their consent are on file with the Clerk. *Amicus* states that no counsel for a party authored this brief in whole or in part, and no person other than the *amicus* and its counsel made any monetary contribution intended to fund the preparation or submission of this brief.

efforts to penalize negative or offensive speech. This Court has long rejected such censorship because provocative speech that stirs people to anger is foundational to freedom. *Terminiello v. City of Chicago*, 377 U.S. 1, 5 (1949). It is precisely the type of speech the First Amendment was designed to protect because officials generally do not censor positive, complimentary speech that is not likely to offend.

Penalizing speech that "may disparage" by denying it the important benefits of trademark registration endangers all speech—especially when done in a vague and overbroad fashion as is the case here. This Court should affirm the Federal Circuit's holding that such censorship by government officials is unconstitutional.

ARGUMENT

I. First Amendment Protection for Disparaging Speech is Vital to Freedom.

Petitioners' Policy prohibits registering any trademark a government official thinks may be disparaging. For instance, if a mark is complimentary to religious persons the government allows it, but any views that government officials deem disparaging of religious persons are prohibited. This regulation is facially unconstitutional. *See Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 828 (1995) ("Discrimination against speech because of its message is presumed to be unconstitutional.").

This proscription of viewpoint discrimination applies even if the speech is traditionally less protected like fighting words, defamation, and obscenity. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 391 (1992) (explaining that even in the context of proscribable speech like fighting words "[t]he government may not regulate use based on hostility—or favoritism—towards the underlying message expressed").

Unlike fighting words, disparaging speech enjoys full First Amendment protection. In 1949, this Court decided *Terminiello* during an era when fear of Communism ran rampant, and the evils of Fascism were still fresh in everyone's mind. Father Terminiello was a Catholic priest who belonged to a group called the Christian Veterans of America, which was vehemently anti-communist, but definitely had fascist leanings (though Father Terminiello denied that he was fascist). *Id.* at 22 (Jackson, J., dissenting) (Justice Jackson outlines the facts and Terminiello's speech in detail).

The case arose from a fine levied against Father Terminiello for a speech he delivered to members of his group in Chicago. The speech was anti-Communist and anti-Semitic. A crowd of over one thousand people gathered outside the building and became unruly. Terminiello was fined $100 because "his speech stirred people to anger, invited public dispute, or brought about a condition of unrest." *Id.* at 5. Despite the fact that his views were disparaging of Jews and Communists, the conviction and fine were reversed because [t]he vitality of civil and political institutions in our society depends on free discussion.

As Chief Justice Hughes wrote in *De Jonge v. Oregon*, 299 U.S. 353, 365, 57 S.Ct. 255, 260, 81 L.Ed. 278 [1937], it is only through free debate and free exchange of ideas that government remains responsive to the will of the people and peaceful change is effected. The right to speak freely and to promote diversity of ideas and programs is therefore one of the chief distinctions that sets us apart from totalitarian regimes.

> Accordingly a function of free speech under our system of government is to invite dispute. It may indeed best serve its high purpose when it induces a condition of unrest, creates dissatisfaction with conditions as they are, or even stirs people to anger. Speech is often provocative and challenging. It may strike at prejudices and preconceptions and have profound unsettling effects as it presses for acceptance of an idea.

Id. (internal citation omitted). Respondents' band name, The Slants, falls precisely in this category of speech.

Twenty years after *Terminiello* and in the context of an anti-war protest in a public school (where freedom of speech is necessarily somewhat restricted), this Court observed:

> Any departure from absolute regimentation may cause trouble. Any variation from the majority's opinion may inspire fear. Any word spoken, in class, in the lunchroom, or on the campus, that deviates from the views of

> another person may start an argument or cause a disturbance. But our Constitution says we must take this risk, *Terminiello v. Chicago*, 337 U.S. 1 (1949); and our history says that it is this sort of hazardous freedom—this kind of openness—that is the basis of our national strength and of the independence and vigor of Americans who grow up and live in this relatively permissive, often disputatious, society.
>
> [T]o justify prohibition of a particular opinion, . . . [the state] must be able to show that its action was caused by something more than a mere desire to avoid the discomfort and unpleasantness that always accompany an unpopular viewpoint.

Tinker v. Des Moines Indep. Cmty. Sch. Dist., 393 U.S. 503, 508-09 (1969). Refusal to register Mr. Tam's trademark because it may cause discomfort is unconstitutional.

II. Use of Vague Terms Like "Disparaging" to Penalize Speech Allows for Unbridled Discretion.

The disparagement clause cannot be viewpoint neutral, as a facial matter, unless it contains "protection ... for viewpoint neutrality [as] part of the [approval] process." *See Bd. of Regents of Univ. of Wis. Sys. v. Southworth*, 529 U.S. 217, 235 (2000).

But Petitioner has virtually unlimited discretion to determine whether a mark "may disparage." In

such circumstances, "the possibility is too great that this power will be exercised in order to suppress disfavored speech." *City of Lakewood v. Plain Dealer Publ'g Co.*, 486 U.S. 750, 757 (1988) (ordinance permitting mayor to decline a permit to place newsracks on public property if it was "not in the public interest" unconstitutionally conferred unfettered discretion).

For example, in *Shuttlesworth v. City of Birmingham*, 394 U.S. 147 (1969), an ordinance impermissibly conferred unfettered discretion by allowing refusal of a parade permit if the city commission determined in "its judgment the public welfare, peace, safety, health, decency, good order, morals or convenience require that it be refused." *Id.* at 149-51. This Court held that regulations governing speech must contain "narrow, objective, and definite standards" to avoid censorship. *Id.* at 151.

Excluding any mark that "may disparage" is completely subjective and anything but narrow, objective, and definite. Instead it is a hopelessly vague restriction on speech—a context where "a heightened vagueness standard appli[es]." *Brown v. Entm't Merch. Ass'n*, 564 U.S. 786, 793 (2011).

III. Burdening Disparaging Speech by Denying Trademark Registration is Impermissibly Overbroad.

"It has long been recognized that the First Amendment needs breathing space and that statutes attempting to restrict or burden the exercise of First Amendment rights must be narrowly drawn and

represent a considered legislative judgment that a particular mode of expression has to give way to other compelling needs of society." *Broadrick v. Oklahoma*, 413 U.S. 601, 611-12 (1973) (citations omitted). To protect these vital freedoms, litigants may challenge an overly broad statute on its face because "the statute's very existence may cause others not before the court to refrain from constitutionally protected speech . . . ." *Id.* at 612. A law regulating speech is overbroad on its face if it sweeps within its ambit a substantial amount of protected speech along with that which it may legitimately regulate. *Id.* at 615.

Section I of this brief demonstrates that disparaging speech is not only protected, but the very type of speech the First Amendment was designed to guard. Denying any speech that may be disparaging the substantial benefits that accompany trademark registration broadly penalizes protected speech.

Numerous lower courts have stricken similar restrictions even in the school context where speech is often less protected. For instance, the Third Circuit held that a high school speech policy which prohibited negative, demeaning, and derogatory speech was unconstitutional. *Saxe v. State Coll. Area Sch. Dist.*, 240 F.3d 200, 214-217 (3rd Cir. 2001). *See also Sypniewski v. Warren Hills Reg'l Bd. of Educ.*, 307 F.3d 243, 262 (3d Cir. 2002) (striking down policy prohibiting speech that creates "ill will" because it was likely that there will be a "good deal of speech" falling within this category that "does not substantially interfere with the rights of other students or with the operation of the school");

Dambrot v. Central Mich. Univ., 55 F.3d 1177, 1183-84 (6th Cir. 1995) (striking down policy prohibiting "demeaning" speech or "negative connotations" about a person's racial or ethnic affiliation); *Killion v. Franklin Reg'l Sch. Dist.*, 136 F. Supp. 2d 446, 459 (W.D. Pa. 2001) (striking down policy that prohibits "verbally or otherwise abus[ing] a staff member" because "it is not limited to speech that causes substantial disruption or interference with the work of the school, as required by Tinker"); *UWM Post, Inc. v. Bd. of Regents of the Univ. of Wis. System*, 774 F. Supp. 1163, 1178 (E.D. Wis. 1991) (striking down as overbroad a policy prohibiting discriminatory speech, directed at an individual, which demeans that person's race, sex, religion, color, creed, disability, sexual orientation, national origin, ancestry, or age, and creates an intimidating, hostile, or demeaning educational environment); *Doe v. Univ. of Mich.*, 721 F. Supp. 852, 866 (E.D. Mich. 1989) (striking down as overbroad a policy prohibiting "any behavior, verbal or physical, that stigmatizes or victimizes an individual" on the basis of specified characteristics).

CONCLUSION

The Court should be affirm.

Respectfully submitted,

KRISTEN WAGGONER
KEVIN H. THERIOT
Counsel of Record
ALLIANCE DEFENDING FREEDOM
15100 N. 90th Street
Scottsdale, AZ 85260
(480) 444-0020
ktheriot@ADFlegal.org

DAVID A. CORTMAN
RORY T. GRAY
ALLIANCE DEFENDING FREEDOM
1000 Hurricane Shoals Rd. NE,
Ste. D-1100
Lawrenceville, GA 30043
(770) 339-0774

December 16, 2016

AND
BRIEFS

Supreme Court, U.S.
FILED
NOV 16 2016
OFFICE OF THE CLERK

No. 15-1293

In the
Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF THE AMERICAN BAR ASSOCIATION AS *AMICUS CURIAE* SUPPORTING NEITHER PARTY

Of Counsel:
JONATHAN S. JENNINGS
THEODORE H. DAVIS JR.
THOMAS L. STOLL
JACQUELYN R. MCPEAK

LINDA A. KLEIN
Counsel of Record
AMERICAN BAR ASSOCIATION
321 North Clark Street
Chicago, Illinois 60654
(312) 988-5000
abapresident@americanbar.org

Counsel for Amicus Curiae

Library of Congress
Law Library

QUESTION PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), provides that no trademark shall be refused registration on account of its nature unless, inter alia, it "[c]onsists of . . . matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." The question presented is as follows:

Whether the disparagement provision in 15 U.S.C. § 1052(a) is facially invalid under the Free Speech Clause of the First Amendment.

TABLE OF CONTENTS

TABLE OF AUTHORITIES iv

STATEMENT OF INTEREST 1

SUMMARY OF ARGUMENT 4

ARGUMENT 4

I. THE UNREGISTRABILITY OF A MARK DOES NOT RESTRICT THE MARK OWNER'S ABILITY TO USE THE MARK IN COMMERCE 7

II. ONLY INVALID MARKS ARE BOTH UNREGISTRABLE AND UNPROTECTABLE 8

A. The Grounds for Mark Unregistrability and Mark Invalidity are Not Coextensive, and the Mere Absence of a Federal Registration Does Not Unleash the Mark to Public Use 9

B. Federal and State Causes of Action are Available to Protect Unregistered, but Otherwise Valid, Marks 13

C. Under Certain Circumstances, Protection Against Unfair Competition is Available to the Owners of Claimed, but Invalid, Marks 16

III. UNREGISTRABILITY ON THE PRINCIPAL REGISTER DEPRIVES A MARK

OWNER OF VALUABLE PROCEDURAL AND SUBSTANTIVE ADVANTAGES..... 18

CONCLUSION..... 21

TABLE OF AUTHORITIES

Cases

Accuride Int'l, Inc. v. Accuride Corp.,
871 F.2d 1531 (9th Cir. 1989) 10

B & B Hardware, Inc. v. Hargis Indus.,
135 S. Ct. 1293 (2015) 18

Belmora LLC v. Bayer Consumer Care AG,
819 F.3d 697 (4th Cir. 2016) 13

Blinded Veterans Ass'n v. Blinded Am. Veterans Found.,
872 F.2d 1035 (D.C. Cir. 1989) 18

Bros. of the Wheel M.C. Exec. Council, Inc. v. Mollohan,
909 F. Supp. 2d 506 (S.D. W. Va. 2012)..... 11

Browning King Co. of N.Y. v. Browning King Co.,
176 F.2d 105 (3d Cir. 1949)..... 17

Cal. Cooler, Inc. v. Loretto Winery, Ltd.,
774 F.2d 1451 (9th Cir. 1985) 12

In re Certain Digital Multimeters, & Prods. With Multimeter Functionality, Inv. No. 337-TA-588, USITC Pub. 4210, 2010 ITC LEXIS 2867 (Int'l Trade Comm'n Dec. 1, 2010) 15

In re Clorox Co.,
578 F.2d 305 (C.C.P.A. 1978)..... 19

Compco Corp. v. Day-Brite Lighting, Inc.,
376 U.S. 234 (1964) 18

Crash Dummy Movie, LLC v. Mattel, Inc.,
601 F.3d 1387 (Fed. Cir. 2010) 12

DaimlerChrysler v. Net Inc.,
388 F.3d 201 (6th Cir. 2004) 15

Dastar Corp. v. Twentieth Century Fox Film Corp.,
539 U.S. 23 (2003) 17

Del. & Hudson Canal Co. v. Clark,
80 U.S. 311 (1871) 9

Eckles v. Atlanta Tech Grp.,
485 S.E.2d 22 (Ga. 1997) 10

Far Out Prods., Inc. v. Oskar,
247 F.3d 986 (9th Cir. 2001) 12

Fin. Inv. Co. (Bermuda) Ltd. v. Geberit AG,
65 F.3d 526 (7th Cir. 1998) 20

In re Fox,
702 F.3d 633 (Fed. Cir. 2012) 7

Gaia Techs., Inc. v. Reconversion Techs., Inc.,
93 F.3d 774 (Fed. Cir. 1996) 21

Gamut Trading Co. v. U.S. Int'l Trade Comm'n,
200 F.3d 775 (Fed. Cir. 1999) 15

Hanover Star Milling Co. v. Metcalf,
240 U.S. 403 (1916) 17

Herbko Int'l, Inc. v. Kappa Books, Inc.,
308 F.3d 1156 (Fed. Cir. 2002) 11

Keebler Co. v. Rovira Biscuit Corp.,
624 F.2d 366 (1st Cir. 1980) 12

Kellogg Co. v. Nat'l Biscuit Co.,
305 U.S. 111 (1938) 18

In re McGinley,
660 F.2d 481 (C.C.P.A. 1981) 7

MNI Mgmt., Inc. v. Wine King, LLC,
542 F. Supp. 2d 389 (D.N.J. 2008) 20

Moseley v. V Secret Catalogue, Inc.,
537 U.S. 418 (2003) 10, 17

Murphy Door Bed Co. v. Interior Sleep Sys., Inc.,
874 F.2d 95 (2d Cir. 1989) 18

New York City Triathlon, LLC v. NYC Triathlon Club, Inc.,
704 F. Supp. 2d 305 (S.D.N.Y. 2010) 13

Orient Exp. Trading Co. v. Federated Dep't Stores, Inc.,
842 F.2d 650 (2d Cir. 1988) 12

Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.,
469 U.S. 189 (1985) 9, 20

Patsy's Italian Rest. v. Banas,
658 F.3d 254 (2d Cir. 2011) 7

Qualitex Co. v. Jacobson Prods. Co.,
514 U.S. 159 (1995) 9

San Juan Prods., Inc. v. San Juan Pools of Kan., Inc.,
849 F.2d 468 (10th Cir. 1988) 12

Santana Prods., Inc. v. Compression Polymers, Inc.,
8 F.3d 152 (3d Cir. 1993) 12

Sears, Roebuck & Co. v. Stiffel Co.,
376 U.S. 225 (1964) 18

Singer Mfg. Co. v. June Mfg. Co.,
163 U.S. 169 (1896) 17

Specht v. Google Inc.,
747 F.3d 929 (7th Cir. 2014) 9

Specialized Seating, Inc. v. Greenwich Indus.,
616 F.3d 722 (7th Cir. 2010) 12

Sugar Busters LLC v. Brennan,
177 F.3d 258 (5th Cir. 1999) 11

In re Tam,
785 F.3d 567 (Fed. Cir.), *reh'g en banc granted, opinion vacated*, 600 F. App'x 775 (Fed. Cir. 2015), *rev'd*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam*, No. 15-1293, 2016 WL 1587871 (U.S. Sept. 29, 2016) 8

In re Tam,
808 F.3d 1321 (Fed. Cir. 2015) (en banc) *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam*, No. 15-1293, 2016 WL 1587871 (U.S. Sept. 29, 2016) ..... *passim*

Two Pesos, Inc. v. Taco Cabana, Inc.,
505 U.S. 763 (1992) 14

Volkswagenwerk Aktiengesellschaft v. Wheeler,
814 F.2d 812 (1st Cir. 1987) 12

Wal-Mart Stores, Inc. v. Samara Bros.,
529 U.S. 205 (2000) 14

Walt-W. Enters. v. Gannett Co.,
695 F.2d 1050 (7th Cir. 1982) 10

WWP, Inc. v. Wounded Warriors, Inc.,
566 F. Supp. 2d 970 (D. Neb. 2008) 18

Statutes

15 U.S.C. § 1051 3

15 U.S.C. § 1052 5

15 U.S.C. § 1052(a) ..... *passim*

15 U.S.C. § 1052(b) 11

15 U.S.C. § 1052(d) 5, 14

15 U.S.C. § 1052(e)(1) 5

15 U.S.C. § 1052(e)(5) 5

15 U.S.C. § 1057(b) 20

15 U.S.C. § 1057(c) 20

15 U.S.C. § 1063 5

15 U.S.C. § 1064(1) 6

15 U.S.C. § 1064(3) 6
15 U.S.C. § 1065 20
15 U.S.C. § 1070 5
15 U.S.C. § 1072 20
15 U.S.C. § 1111 19
15 U.S.C. § 1114 ..... 10, 21
15 U.S.C. § 1115(a) 19
15 U.S.C. § 1115(b) 19
15 U.S.C. § 1116 20
15 U.S.C. § 1116(d) 20
15 U.S.C. § 1116(d)(1)(b) 20
15 U.S.C. § 1117 21
15 U.S.C. § 1117(c) 21
15 U.S.C. § 1121 19
15 U.S.C. § 1124 20
15 U.S.C. § 1125(a) ..... *passim*
15 U.S.C. § 1125(c) 13
15 U.S.C. § 1125(c)(2) 13, 21
15 U.S.C. § 1125(c)(6) 20
15 U.S.C. § 1125(d) 15
15 U.S.C. § 1127 ..... 4, 20

15 U.S.C. § 1141b 20

19 U.S.C. § 1337 15

19 U.S.C. § 1526 20

19 U.S.C. § 1526(a) 21

765 ILL. COMP. STAT. 1036/6 16

Rules and Regulations

Sup. Ct. R. 37.6 1

Other Authorities

3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed.) 11, 13

5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed.) 15

Drew Jurgensen, *When All You Have is a Hammer, Everything Looks Like a Nail In Re Tam and the Federal Circuit's Conflation of Federal Trademark Registration and the First Amendment*, 98 J. PAT. & TRADEMARK OFF. SOC'Y 512 (2016) 8

INT'L TRADEMARK ASS'N, STATE TRADEMARK AND UNFAIR COMPETITION LAW, http://applications.inta.org/apps/states/full_report/ (2016) 16

Jason Rantanen & Mark P. McKenna, *Guest Post by Prof. McKenna: The*

Implications of Blackhorse v. Pro-Football, Inc., Patentlyo, http://patentlyo.com/patent/2014/06/implications-blackhorse-football.htm l (2014) 14

RESTATEMENT (THIRD) OF UNFAIR COMPETITION (1995) 17

U.S. Patent and Trademark Office, *Protecting Your Trademark, Enhancing Your Rights Through Federal Registration*, https://www.uspto.gov/sites/default/files/BasicFacts.pdf (Jan. 2016) 14

STATEMENT OF INTEREST[1]

The American Bar Association ("ABA") respectfully submits this brief in support of neither party.

The ABA is the leading national organization of the legal profession, with more than 400,000 members from all 50 states, the District of Columbia and the U.S. territories. Membership is voluntary and includes attorneys in private practice, government service, corporate law departments and public interest organizations. ABA members comprise judges, legislators, law professors, law students and non-lawyer "associates" in related fields, and represent the full spectrum of public and private litigants.[2]

The ABA Section of Intellectual Property Law ("IPL Section"), which was established in 1894, is the world's oldest and largest organization of intellectual property professionals. The IPL Section has approximately 20,000 members, including attorneys who

---

[1] Pursuant to Rule 37.6, amicus curiae certifies that no counsel for a party authored this brief in whole or in part and that no person or entity, other than amicus, its members or its counsel, has made a monetary contribution to the preparation or submission of this brief. Sup. Ct. R. 37.6. Further, amicus curiae certifies that Petitioner has provided its blanket consent to this filing; Respondent's written consent has been filed with the Clerk with this brief.

[2] Neither this brief nor the decision to file it should be interpreted to reflect the views of any judicial member of the American Bar Association. No inference should be drawn that any member of the Judicial Division Council has participated in the adoption or endorsement of the positions in this brief. This brief was not circulated to any member of the Judicial Division Council prior to filing.

represent trademark owners, accused infringers, and small corporations and universities and research institutions across a wide range of industries. The IPL Section promotes the development and improvement of intellectual property law and takes an active role in addressing proposed legislation, administrative rule changes and international initiatives regarding intellectual property. It also develops and presents resolutions to the ABA House of Delegates for adoption as ABA policy to foster necessary changes to the law. These policies provide a basis for the preparation of ABA amicus curiae briefs, which are filed primarily in this Court and the United States Court of Appeals for the Federal Circuit.[3] The IPL Section comprises and represents attorneys on all sides of the issues, and the uniqueness of its size and diverse representations makes the Section unlike other entities. The IPL Section's reliance on the expertise of its members to develop consensus positions within the ABA ensures its positions reflect those of the broader intellectual property community.

Through a collaborative process, the diverse members of the IPL Section have developed a consensus on basic propositions of trademark law germane to the Court's resolution of the constitutional issue set forth in the question presented. The ABA's House of Delegates adopted that consensus as formal policy in August 2016:

---

[3] *See* American Bar Ass'n, Amicus Curiae Briefs, http://www.americanbar.org/amicus/1998-present.html (last visited Oct. 21, 2016).

> [T]he American Bar Association supports an interpretation of the federal Lanham Act, 15 U.S.C. § 1051 et seq., recognizing that the ineligibility of an otherwise valid mark for registration with the U.S. Patent and Trademark Office ("USPTO"), through the cancellation of an existing federal registration or the denial of an application for a federal registration, does not in and of itself disqualify that mark for protection under all provisions of the Lanham Act, the common law, or from registration on state registers; and
>
> . . . supports an interpretation of the Lanham Act recognizing that the ineligibility of a mark for registration with the USPTO does not in and of itself restrict the mark owner's right to use the mark in commerce; and
>
> . . . supports an interpretation of the Lanham Act recognizing that the owners of marks registered on the Principal Register, the primary register of trademarks maintained by the USPTO, enjoy procedural and substantive advantages in litigation to protect their marks otherwise not available to owners of common-law marks not registered on the Principal Register.

The ABA takes no position on whether the potential disparagement provision of the Lanham Act, 15 U.S.C. § 1052(a), is facially invalid under the Free Speech Clause of the First Amendment or whether the service mark at issue was properly denied registration under that provision. Rather, the ABA sub-

mits this brief to clarify certain principles of trademark law erroneously set forth by the court of appeals.

SUMMARY OF ARGUMENT

The court of appeals' invalidation of a portion of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), under the Free Speech Clause of the First Amendment, raises important questions about the relationship between trademark validity and trademark registrability, as well as the legal significance of a determination of unregistrability. A correct understanding of those issues is important to answering properly the ultimate question in this case concerning the Free Speech Clause of the First Amendment. The ABA therefore files this brief to rectify errors of basic trademark law in the opinion of the court of appeals and to confirm that: (1) a determination of mark unregistrability does not restrict the mark owner's right to use the mark in commerce; and (2) a determination that a mark is ineligible for registration on the USPTO's Principal Register does not necessarily render that mark invalid and unprotectable; but (3) owners of marks registered on the Principal Register enjoy certain substantive and procedural advantages in litigation to protect their marks that are not available to the owners of unregistered marks.

ARGUMENT

Under Section 45 of the federal Lanham Act, 15 U.S.C. § 1127 (2012), "[t]he term 'trademark' includes any word, name, symbol . . . to identify and distinguish his or her goods, including a unique

product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown"; the same statute contains a substantively identical definition of "service mark."[4] Pursuant to the Act, the owner of either type of mark may seek to register it on one of two "registers" maintained by the USPTO, namely, the Principal Register and the Supplemental Register—often referred to as "federal registration" of a trademark. This case arises from an application to register a service mark on the Principal Register.

Section 2 of the Lanham Act, *id.* § 1052, prohibits the registration on the Principal Register of certain marks and certain claimed marks.[5] Of great-

---

[4] Courts, practitioners, and commentators typically use "marks" as shorthand references to both trademarks and service marks.

[5] Among the most commonly invoked grounds for unregistrability under Section 2 are that the claimed mark is deceptive, 15 U.S.C. § 1052(a), is likely to be confused with another party's prior-registered or prior-used mark, *id.* § 1052(d), is merely descriptive and lacks acquired distinctiveness, *id.* § 1052(e)(1), or is functional. *Id.* § 1052(e)(5). A claimed mark may be found unregistrable under these or the other provisions of Section 2 in three contexts: (1) an examiner assigned to an application to register the mark can reject the application, in which case the applicant can appeal to the Trademark Trial and Appeal Board (the "Board"), an administrative tribunal within the USPTO, 15 U.S.C. § 1070; (2) another party can challenge the application in an "opposition proceeding" before the Board, *id.* § 1063; and (3) even if the application matures into a registration, the registration can be canceled by a court or the Board for any reason that would have prevented its issuance in the first place, *id.* § 1064(1); after that, it can be canceled "[a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is

est significance to this case, Section 2(a) prohibits the registration of any mark that "may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." *Id.* § 1052(a). But that prohibition is only one of many found in Section 2.

The court of appeals' opinion in this case confuses the distinguishable concepts of mark validity, on the one hand, and mark registrability, on the other. The court properly acknowledged its past holdings that a determination of unregistrability on the Principal Register does not restrict a mark owner's ability to use that mark in commerce, but its treatment of the issue in this case may improperly suggest the question is an open one: It is not. Likewise, the court of appeals erred in suggesting such a determination necessarily renders an otherwise valid mark wholly ineligible for protection under the Lanham Act and the common law. Finally, although the court of appeals properly held that nonregistrants are disadvantaged in litigation to protect their marks vis-à-vis their registrant counterparts, it understated those disadvantages in certain respects.

---

functional, or has been abandoned, or its registration was obtained fraudulently or contrary to . . . [Section 2(a)-(c)] . . . ." *Id.* § 1064(3).

I. THE UNREGISTRABILITY OF A MARK DOES NOT RESTRICT THE MARK OWNER'S ABILITY TO USE THE MARK IN COMMERCE

Beginning with *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981), the court of appeals and its predecessor, the Court of Customs and Patent Appeals, have long recognized that the ineligibility of a mark for registration does not prevent the mark's use in commerce. *See id.* at 484 ("[I]t is clear that the PTO's refusal to register appellant's mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed."); *see also In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012) ("[A] refusal to register a mark has no bearing on the applicant's ability to use the mark . . . ."). Nevertheless, after citing *McGinley* favorably for this point, the court of appeals immediately noted that "[m]ore than thirty years have passed since the decision in *McGinley*, and in that time both the *McGinley* decision and our reliance on it have been widely criticized." *In re Tam*, 808 F.3d 1321, 1329 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam*, No. 15-1293, 2016 WL 1587871 (U.S. Sept. 29, 2016). This observation could be misread as suggesting that commentators have criticized this particular aspect of *McGinley*, rather than *McGinley*'s ultimate constitutional holding. In fact, as the court of appeals acknowledged later in its opinion, the universally accepted actual rule remains that "a trademark owner may use its mark in commerce even without federal registration . . . ." *Id.* at 1340; *see also Patsy's Italian Rest. v. Banas*, 658 F.3d 254, 267 (2d Cir. 2011) ("[T]he lack

of a federal registration does not prevent [the parties] from expanding as they so desire, so long as they respect each other's existing rights."); Drew Jurgensen, *When All You Have is a Hammer, Everything Looks Like a Nail In Re Tam and the Federal Circuit's Conflation of Federal Trademark Registration and the First Amendment*, 98 J. PAT. & TRADEMARK OFF. SOC'Y 512, 515 (2016) ("[D]enial of federal registration does not prevent a mark owner from using their mark."). Thus, despite the court of appeals' apparent hesitation about the continued viability of the *McGinley* rule, a mark owner whose mark cannot be registered on account of Section 2(a) is not deprived of the ability to use its mark in commerce.

II. ONLY INVALID MARKS ARE BOTH UNREGISTRABLE AND UNPROTECTABLE

Referring to the cause of action available to protect unregistered marks provided by Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (2012), the court of appeals observed that "it is not at all clear that [an applicant denied registration under Section 2(a)] could bring a § 43(a) unfair competition claim." 808 F.3d at 1344 n.11. Indeed, one member of the court of appeals would have gone still further to hold that "§ 43(a) protection is only available for unregistered trademarks *that could have qualified for federal registration*." *In re Tam*, 785 F.3d 567, 576 (Fed. Cir.) (additional views of Moore, J.) (citations omitted), *reh'g en banc granted, opinion vacated*, 600 F. App'x 775 (Fed. Cir. 2015), *rev'd*, 808 F.3d 1321, 1329 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam*, No. 15-

1293, 2016 WL 1587871 (U.S. Sept. 29, 2016). Both propositions are incorrect.

A. The Grounds for Mark Unregistrability and Mark Invalidity are Not Coextensive, and the Mere Absence of a Federal Registration Does Not Unleash the Mark to Public Use

Some grounds for the denial or cancellation of a federal registration of a mark also render the mark ineligible for protection as a mark. For example, if the registration of a mark is canceled because the underlying mark has become generic, the rights to the mark are invalidated along with the registration. *See Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985) ("Generic terms are not registrable, and a registered mark may be canceled at any time on the grounds that it has become generic."); *Del. & Hudson Canal Co. v. Clark*, 80 U.S. 311, 323 (1871) ("Nor can a generic name . . . be employed as a trade-mark and the exclusive use of it be entitled to legal protection."). Moreover, the same is true if the ground for cancellation is that the underlying mark is functional or if it has been abandoned. *See, e.g., Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995) ("The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature."); *Specht v. Google Inc.*, 747 F.3d 929, 934-35 (7th Cir. 2014) (affirming finding of abandonment as a matter of law for mark not used for over a decade).

Nevertheless, a determination that an otherwise valid mark is unregistrable does not in and of itself disqualify that mark for protection under the Lanham Act, the common law, or state law causes of action such as the Uniform Deceptive Trade Practices Act.[6] For example, because federal registration is not a prerequisite for a cause of action under Section 43(a) of the Lanham Act, courts have routinely recognized the eligibility for protection under that statute of certain designations not qualifying for federal registration. Those include trade names, the unregistrability of which is well established, but which, as this Court has recognized, are still protectable against infringement. *See Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) ("Traditional trademark infringement law is a part of the broader law of unfair competition. That law broadly prohibits uses of trademarks, *trade names*, and trade dress that are likely to cause confusion about the source of a product or service." (emphasis added) (citation omitted)).[7] They likewise include the titles of indi-

---

[6] *See, e.g., Eckles v. Atlanta Tech. Grp.*, 485 S.E.2d 22, 24 (Ga. 1997) ("In Georgia, [an unregistrable-in-the-USPTO] trade name is protected by the common law and by several statutes. One of those statutes is the Uniform Deceptive Trade Practices Act (UDTPA) . . . .").

[7] *See also Accuride Int'l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1534 (9th Cir. 1989) ("The major legal distinction between trademarks and trade names is that trade names cannot be registered and are therefore not protected under 15 U.S.C. § 1114. However, analogous actions for trade name infringement can be brought under section 43(a)." (citation omitted)); *Walt-W. Enters. v. Gannett Co.*, 695 F.2d 1050, 1054 n.6 (7th Cir. 1982) ("Although trade names . . . are not registrable under the Lanham Act, an action for trade name infringement is nonetheless proper under [Section 43(a)]." (citation omitted)).

vidual creative works, which are similarly unregistrable but can be protected under Section 43(a).[8] And, as an additional example, they encompass reproductions of the United States flag, which are barred from the Principal Register by Section 2(b) of the Act, 15 U.S.C. § 1052(b), but infringements of which are actionable. *See Bros. of the Wheel M.C. Exec. Council, Inc. v. Mollohan*, 909 F. Supp. 2d 506, 542 (S.D. W. Va. 2012) (noting availability of protection under Section 43(a) for flag design even if design unregistrable).

Moreover, it is well established that the cancellation of an existing registration does not in and of itself invalidate all rights in the underlying mark. 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:3 (4th ed.). As the Tenth Circuit has explained in a case presenting a fraud-based challenge to a registration:

> Unlike the registration of a patent, a trademark registration of itself *does not create the underlying right to exclude.* Nor is a trademark created by registration. While federal

---

[8] *See, e.g., Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1163 n.2 (Fed. Cir. 2002) ("While titles of single works are not registrable, they may be protected under section 43(a) of the Lanham Act upon a showing of secondary meaning."); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999) ("The Trademark Trial and Appeal Board has consistently interpreted [prior authority of the Court of Customs and Patent Appeals] as prohibiting the registration of single book titles as trademarks. The descriptive nature of a literary title does not mean, however, that such a title cannot receive protection under § 43(a).").

> registration triggers certain substantive and procedural rights, *the absence of federal registration does not unleash the mark to public use.* The Lanham Act protects unregistered marks as does the common law.

San Juan Prods., Inc. v. San Juan Pools of Kan., Inc., 849 F.2d 468, 474 (10th Cir. 1988) (emphasis added) (citation omitted).[9] Succinctly put, "[i]f suc-

---

[9] *See also Specialized Seating, Inc. v. Greenwich Indus.*, 616 F.3d 722, 728 (7th Cir. 2010) ("All a finding of fraud does is knock out the mark's 'incontestable' status, and its registration . . . . It does not affect the mark's validity, because a trademark need not be registered to be enforceable."); *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 1391 (Fed. Cir. 2010) ("[C]ancellation of a trademark registration does not necessarily translate into abandonment of common law trademark rights."); *Far Out Prods., Inc. v. Oskar*, 247 F.3d 986, 996 (9th Cir. 2001) ("[E]ven if [the appellees] knowingly submitted a false declaration such that the appellees' federal registration should be canceled, the appellees could (and did) still bring suit alleging common law trademark infringement."); *Santana Prods., Inc. v. Compression Polymers, Inc.*, 8 F.3d 152, 155 (3d Cir. 1993) ("[T]he cancellation of a trademark registration does not extinguish common law rights the registration did not create.") (quoting *Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 819 (1st Cir. 1987) (internal quotation marks omitted)); *Orient Exp. Trading Co. v. Federated Dep't Stores, Inc.*, 842 F.2d 650, 654 (2d Cir. 1988) ("Even if appellants' registered marks are cancelled, however, the use of the [disputed] name . . . could still be protected from unfair competition under section 43(a) of the Lanham Act."); *Cal. Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1454 (9th Cir. 1985) ("[D]eficiencies in registration, such as failure to renew, or even cancellation, do not affect common law trademark rights."); *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 376 (1st Cir. 1980) ("[I]n some cases of cancellation of federal registration the registrant may still be able to establish his common law right to exclusive use . . . .").

cessful, the result of a § 14(3) petition 'is the cancellation of a registration, not the cancellation of a trademark.' Cancellation of registration strips an owner of 'important legal rights and benefits' that accompany federal registration, but it 'does not invalidate underlying common law rights in the trademark.'" *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 714 (4th Cir. 2016) (quoting 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 20:40, 20:68 (4th ed.)).

The theory that otherwise valid marks become unprotectable because they are unregistrable also cannot be reconciled with Section 43(c) of Act, 15 U.S.C. § 1125(c) (2012), which protects the distinctiveness of famous marks against likely dilution. Under that statute, whether or not a mark is registered is merely one of four nonexclusive factors used to determine whether a mark is sufficiently famous to qualify for protection. *See* 15 U.S.C. § 1125(c)(2). The nonexistence of a registration therefore does not preclude actions brought under that statute. *See, e.g., New York City Triathlon, LLC v. NYC Triathlon Club, Inc.*, 704 F. Supp. 2d 305, 321-22 (S.D.N.Y. 2010) (finding unregistered marks famous and likely to be diluted in violation of Section 43(c)).

B. Federal and State Causes of Action are Available to Protect Unregistered, but Otherwise Valid, Marks

Although certain causes of action for the misappropriation of marks are reserved to federal registrants, others are available to protect unregistered, but otherwise valid, marks. This Court therefore

previously has recognized that Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), provides a remedy against the misappropriation of unregistered, but otherwise valid, marks. *See generally Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000). It therefore is "wrong to conflate registrability under §2 with protectability under §43(a) [of the Lanham Act]." Jason Rantanen & Mark P. McKenna, *Guest Post by Prof. McKenna: The Implications of Blackhorse v. Pro-Football, Inc.*, Patentlyo, http://patentlyo.com/patent/2014/06/implications-blackhorse-football.html (June 19, 2014).

Moreover, common-law trademark rights can support infringement and unfair competition claims, as well as challenges to pending trademark applications before, and registrations with, the USPTO. Thus, for example, Section 2(d) of the Lanham Act recognizes a cause of action against a claim of rights in the USPTO to a mark "which so resembles a mark registered in the Patent and Trademark Office, *or* a mark or trade name previously used . . . by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d) (emphasis added). In fact, as the USPTO has noted, there are some circumstances in which common-law rights in a mark may be deemed "stronger than those based on a [federal] registration." U.S. Patent and Trademark Office, *Protecting Your Trademark, Enhancing Your Rights Through Federal Registration*, https://www.uspto.gov/sites/default/files/BasicFacts.pdf (Jan. 2016).

There are other federal causes of action available to the owners of unregistered marks. On this issue, the court of appeals stated that "[w]ithout federal registration, a trademark user cannot stop importation of goods bearing the mark . . . ." 808 F.3d at 1343. In fact, however, and in addition to a Section 43(a) cause of action, the owner of an unregistered mark can file a complaint pursuant to Section 337 of the Tariff Act, 19 U.S.C. § 1337 (2012), before the International Trade Commission ("ITC") to stop the importation of goods bearing the mark that violates those common-law rights. *In re Certain Digital Multimeters, & Prods. With Multimeter Functionality*, Inv. No. 337-TA-588, USITC Pub. 4210, 2010 ITC LEXIS 2867 (Int'l Trade Comm'n Dec. 1, 2010) (issuing general exclusion order to protect unregistered trade dress). The ITC may issue an exclusion order enforcing trademark rights and requiring U.S. Customs and Border Protection to stop the importation of goods bearing infringements of the mark. *See Gamut Trading Co. v. U.S. Int'l Trade Comm'n*, 200 F.3d 775, 783 (Fed. Cir. 1999) ("An exclusion order is the Commission's statutory remedy for trademark infringement.").

Unregistered, but valid, marks may also be protected against cybersquatting under the Anti-Cybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d): "[A] trademark need not be registered to be entitled to protection under the ACPA." *DaimlerChrysler v. Net Inc.*, 388 F.3d 201, 205 (6th Cir. 2004); *see also* 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 25A:49 (4th ed.) ("[T]here is no requirement that the pro-

tected 'mark' be registered: unregistered common law marks are protected by the Act.").

Finally, state law often offers causes of action to the owners of unregistered marks. These include likelihood-of-confusion-based causes of action for infringement, unfair competition, and deceptive trade practices. *See generally* INT'L TRADEMARK ASS'N, STATE TRADEMARK AND UNFAIR COMPETITION LAW, http://applications.inta.org/apps/states/full_report/ (2016) (follow login directions for members) (describing availability of causes of action on state-by-state basis). They also include statutory causes of action to protect the fame and distinctiveness of marks against likely or actual dilution, *see generally id.*, which are extant in more than half the states and most of which do not require federal or state registration as a prerequisite for relief. *See, e.g.*, 765 ILL. COMP. STAT. 1036/6 (no registration requirement for protection against likely dilution). The owners of unregistered but otherwise valid marks therefore have a variety of causes of action available to enforce the rights to their marks.

C. Under Certain Circumstances, Protection Against Unfair Competition is Available to the Owners of Claimed, but Invalid, Marks

If a claimed mark is unregistrable because it is invalid, that circumstance will not necessarily preclude the availability of protection against misleading uses of the claimed mark. This Court previously has recognized that "the common law of trademarks is but a part of the broader law of unfair competi-

tion." *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413 (1916); *accord Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003). It also has held that Section 43(a) of the Lanham Act in particular "goes beyond trademark protection." *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 29 (2003).

A claimant to even an invalid mark therefore can receive protection via Section 43(a) of the Lanham Act, state unfair competition law, or passing off claims against the bad-faith and confusing use of that claimed mark.[10] For example, this Court has required defendants to "use reasonable care to inform the public of the source of its product" so to avoid confusion arising from their use of a claimed mark that had been found generic. *See Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 119 (1938); *accord Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 203-204

---

[10] RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15 (1995) ("Use of a generic term in a manner likely to deceive or mislead a significant number of prospective purchasers as to the source of the goods or services, however, may subject the user to liability under the general rule proscribing misrepresentations of source"); *id.* § 30 ("[U]se of an abandoned designation in a manner likely to deceive or mislead a significant number of prospective purchasers may subject the user to liability to the former owner under the general rule proscribing misrepresentations of source."); *see also Browning King Co. of N.Y. v. Browning King Co.*, 176 F.2d 105, 107 (3d Cir. 1949) (holding anyone is entitled to use an abandoned mark "subject to the highly important qualification that in such use there must not be any deception of the public as to the identity of the merchant with whom customers do business").

(1896).[11] The Court reached similar conclusions in *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232 (1964), and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 238 (1964), holding in both of which the right to copy a unpatented and functional product did not excuse the defendants from taking affirmative steps to reduce mistakes and confusion in the marketplace. Therefore, even unregistrability triggered by the invalidity of a claimed mark does not necessarily foreclose all protection under federal and state unfair competition law.

III. UNREGISTRABILITY ON THE PRINCIPAL REGISTER DEPRIVES A MARK OWNER OF VALUABLE PROCEDURAL AND SUBSTANTIVE ADVANTAGES

Echoing this Court's observation that "[t]he benefits of registration are substantial," *B & B Hard-*

---

[11] *See also Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 97 (2d Cir. 1989) ("We hold that 'Murphy bed' is a generic term, having been appropriated by the public to designate generally a type of bed . . . . [W]e agree with the district court that defendants engaged in unfair competition by passing off beds of their own manufacture as beds of the Murphy Co. Accordingly, we affirm the court's entry of a permanent injunction prohibiting defendants from use of the term Murphy bed."); *Blinded Veterans Ass'n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1043 (D.C. Cir. 1989) ("[I]f an organization's own name is generic, a competitor's subsequent use of that name may give rise to an unfair competition claim if the competitor's failure adequately to identify itself as distinct from the first organization causes confusion or a likelihood of confusion."); *WWP, Inc. v. Wounded Warriors, Inc.*, 566 F. Supp. 2d 970, 977-78 (D. Neb. 2008) (granting preliminary injunction under the Nebraska Deceptive Trade Practices Act against bad-faith imitation of invalid mark).

ware, Inc. v. Hargis Indus., 135 S. Ct. 1293, 1309 (2015), the court of appeals correctly held that "federal trademark registration bestows *truly* significant and financially valuable benefits upon markholders." *Tam*, 808 F.3d at 1240. It may, however, have understated those benefits in the process.

A mark owner denied registration on the Principal Register can suffer significant disadvantages in litigation to protect its mark.[12] Some of those disadvantages are purely procedural in nature. For example, Sections 7(b) and 33(a) of the Lanham Act, 15 U.S.C. §§ 1057(b), 1115(a) (2012), provide that a certificate of registration on the Principal Register constitutes "prima facie" evidence of the validity of the registered mark; if such a registration becomes incontestable under Section 15 of the Act, *id.* § 1065, that evidence becomes "conclusive," subject to certain exceptions identified in Section 33(b) of the Act. *Id.* § 1115(b); *see generally Park 'N Fly*, 469 U.S. at 194-95. In contrast, "[u]nregistered marks have no presumption of validity . . . . Thus, a plaintiff must prove that an unregistered mark is valid and pro-

---

[12] Although the court of appeals and the parties alike have focused on the advantages accruing to registrations on the Principal Register, a registration even on the Supplemental Register (which is unavailable to potentially disparaging marks under Section 2(a) of the Act) creates federal subject-matter jurisdiction over actions to protect the registered mark. *See* 15 U.S.C. § 1121. It also allows the registrant to use the ® symbol, which can be an effective deterrent against infringement. *Id.* § 1111. Finally, it can be the basis of the USPTO's rejection of an application to register another party's confusingly similar mark. *See, e.g., In re Clorox Co.*, 578 F.2d 305, 307 (C.C.P.A. 1978).

tectable." *MNI Mgmt., Inc. v. Wine King, LLC*, 542 F. Supp. 2d 389, 404 (D.N.J. 2008) (citation omitted).

Further advantages are more substantive in nature. The court of appeals recognized a number of these, including the availability of nationwide constructive priority of rights, 15 U.S.C. §§ 1057(c), 1072, "the assistance of U.S. Customs and Border Protection in restricting importation of infringing or counterfeit goods," *Tam*, 808 F.3d at 1329 (citing 15 U.S.C. § 1124; 19 U.S.C. § 1526), the simplified process for obtaining and maintaining registrations under the Madrid Protocol and the Paris Convention, 15 U.S.C. § 1141b, and the complete defense to claims of trademark dilution under state law. *Id.* § 1125(c)(6).

Other advantages accruing to federal registrations (but not identified by the court of appeals) include the availability of particular private causes of action only to registrants on the Principal Register. Thus, for example, nonregistrants are ineligible for the cause of action against counterfeiting[13] created by the intersection of Section 32 of the Lanham Act, 15 U.S.C. § 1114, which is available only to federal registrants,[14] with Section 34, 15 U.S.C. § 1116, and

---

[13] A defendant's mark is "counterfeit" only if it is "identical [to], or substantially indistinguishable from, a *registered* mark." 15 U.S.C. § 1127 (emphasis added); *see also id.* § 1116(d)(1)(b) ("'[C]ounterfeit mark' means . . . a counterfeit of a mark that is *registered* . . . in the . . . Patent and Trademark Office for such goods or services sold, offered for sale, or distributed and that is in use . . . ." (emphasis added)).

[14] *See, e.g., Fin. Inv. Co. (Bermuda) Ltd. v. Geberit AG*, 165 F.3d 526, 531 (7th Cir. 1998) ("Authorities uniformly agree that only

Section 35, *id.* § 1117. Nonregistrants challenging counterfeit imitations of their marks can rely on the unfair competition cause of action under Section 43(a) of the Act, *id.* § 1125(a), but liability under that section does not trigger the heightened remedies set forth in Section 34(d), *id.* § 1116(d), or the availability of statutory damages under Section 35(c), *id.* § 1117(c). Nonregistrants are also ineligible for the private cause of action provided for Section 526(a) of the Tariff Act of 1930, 19 U.S.C. § 1526(a) (2012), which is similarly restricted to the owners of registered marks. Finally, the existence or nonexistence of a registration on the Principal Register is relevant to the inquiry into whether a mark is sufficiently famous to qualify for protection against likely dilution under federal law. 15 U.S.C. § 1125(c)(2). Despite the availability of some causes of action to protect unregistered marks, nonregistrants therefore are disadvantaged vis-à-vis their federal registrant counterparts.

CONCLUSION

The registration system is an integral part of federal trademark law, but a federal registration is not a prerequisite for the use of a mark in commerce. Moreover, the denial of a federal registration does not necessarily eliminate all federal or common-law rights to the underlying mark, and the Court should

---

the trademark's registrant (or her assignee) may sue under § 32(1)."); *Gaia Techs., Inc. v. Reconversion Techs., Inc.*, 93 F.3d 774, 779-80 (Fed. Cir. 1996) (vacating finding of liability under Section 32 in light of plaintiff's failure to demonstrate ownership of registration).

reject any suggestion to the contrary. Nevertheless, the owner of a mark registered on the Principal Register enjoys certain substantive and procedural advantages in litigation to protect its mark that are *not* available to the owners of unregistered marks. Although the ABA does not take a position on the merits of the question presented, it urges the Court to answer that question in a manner not disturbing these basic propositions of United States trademark law.

Respectfully submitted,

Of Counsel:
JONATHAN S. JENNINGS
THEODORE H. DAVIS JR.
THOMAS L. STOLL
JACQUELYN R. MCPEAK

LINDA A. KLEIN
Counsel of Record
AMERICAN BAR ASSOCIATION
321 North Clark Street
Chicago, Illinois 60654
(312) 988-5000
abapresident@americanbar.org

RECORD
AND
BRIEF

Supreme Court, U.S.
FILED
DEC 7 - 2016
OFFICE OF THE CLERK

No. 15-1293

In The
Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

AMICUS BRIEF OF THE AMERICAN CENTER FOR LAW AND JUSTICE IN SUPPORT OF RESPONDENT

JAY ALAN SEKULOW
Counsel of Record
STUART J. ROTH
COLBY M. MAY
WALTER M. WEBER
AMERICAN CENTER FOR
LAW & JUSTICE
201 Maryland Ave., N.E.
Washington, DC 20002
(202) 546-8890
sekulow@aclj.org
Counsel for Amicus Curiae

TABLE OF CONTENTS

TABLE OF AUTHORITIES iii

INTEREST OF AMICUS 1

SUMMARY OF ARGUMENT 1

ARGUMENT 2

I. THE GOVERNMENT SPEECH DOCTRINE DOES NOT ENCOMPASS A REGISTRY OF PRIVATE SPEECH OR IDENTITIES 3

A. Scope and Inapplicability of Government Speech Doctrine 4

B. Negative Consequences of Expanding the Government Speech Doctrine to Cover Government Registries 5

C. Inadequacy of the "Government Program" Argument 7

D. Inapplicability of *Walker v. Texas Division* 8

II. REGISTERING A TRADEMARK IS NOT A SUBSIDY 11

A. Scope and Inapplicability of Government Subsidy Doctrine 11

B. Limiting *CLS v. Martinez* 13

III. TRADEMARKS ARE NOT COMMERCIAL SPEECH 16

IV. A PROHIBITION ON REGISTERING DISPARAGING SPEECH IS VIEWPOINT-BASED 17

CONCLUSION 21

TABLE OF AUTHORITIES

Cases **Page**

Agency for Int'l Development v. Alliance for Open Soc'y Int'l, Ltd.[*AID v. AOSI*], 133 S. Ct. 2321 (2013) 12, 13, 15, 16

Board of Educ. v. Mergens, 496 U.S. 226 (1990) . 10

Boos v. Barry, 485 U.S. 312 (1988) 18

Chaplinsky v. New Hampshire, 315 U.S. 568 (1942) 19

Chiras v. Miller, 432 F.3d 606 (5th Cir. 2005) 5

Christian Legal Society v. Martinez, 561 U.S. 661 (2010) 13-16

Cohen v. California, 403 U.S. 15 (1971) 9

Cornelius v. NAACP Legal Defense & Educ. Fund, 473 U.S. 788 (1985) 8

Democratic Senatorial Comm. v. FEC, 660 F.2d 773 (D.C. Cir. 1980) 12

FCC v. League of Women Voters of Cal., 468 U.S. 364 (1984) 12

Friedman v. Rogers, 440 U.S. 1 (1979) 17

Good News Club v. Milford Central School,
533 U.S. 98 (2001) 8, 10

Lamb's Chapel v. Center Moriches Union Free Sch. Dist., 508 U.S. 384 (1983) . 1, 7, 8, 10

Legal Servs. Corp. v. Velazquez,
531 U.S. 533 (2001) 12

National Endowment for the Arts v. Finley,
524 U.S. 569 (1998) 5, 11

Parker v. Levy, 417 U.S. 733 (1974) 20

Perry Educ. Ass'n v. Perry Local Educators' Ass'n, 460 U.S. 37 (1983) 8

Pleasant Grove City v. Summum,
555 U.S. 460 (2009) 1, 4-7

PruneYard Shopping Center v. Robins,
447 U.S. 74 (1980) 10

R.A.V. v. City of St. Paul, 505 U.S. 377 (1992) 18-20

Reed v. Town of Gilbert, 135 S. Ct. 2218 (2015) . 17

Rosenberger v. Rector and Visitors of Univ. of Va., 515 U.S. 819 (1995) 8, 17

Rumsfeld v. FAIR, 547 U.S. 47 (2006) 12

South Dakota v. Dole, 483 U.S. 203 (1987) 13

Thornburgh v. Abbott, 490 U.S. 401 (1989) 8

United States v. Alvarez, 132 S. Ct. 2537 (2012) . 21

United States v. Grace, 461 U.S. 171 (1983) 10

Walker v. Texas Div., Sons of Confederate Veterans, 135 S. Ct. 2239 (2015) 1, 8, 9

West Va. Bd. of Educ. v. Barnette, 319 U.S. 624 (1943) 13

Widmar v. Vincent, 454 U.S. 263 (1981) 8, 10

Constitutional Provisions

U.S. Const. amend. I . . . . . 1, *passim*

U.S. Const. art. I, § 9, cl. 8 6

Other Authorities

EO Select, Internal Revenue Service 5

Physician Compare, Medicare.gov 5

David Smith, "He's the real thing: how Shakespeare influenced the American ad industry," *The Guardian* (Apr. 7, 2016) 17

Kellie Woodhouse, "University of Michigan commencement speeches through the years," *The Ann Arbor News* (May 4, 2013) 4

INTEREST OF AMICUS[1]

The American Center for Law and Justice (ACLJ) is an organization dedicated to the defense of constitutional liberties secured by law. ACLJ attorneys often appear before this Court as counsel either for a party, *e.g.*, *Pleasant Grove City v. Summum*, 555 U.S. 460 (2009), or for amicus, *e.g.*, *Walker v. Texas Div., Sons of Confederate Veterans*, 135 S. Ct. 2239 (2015), addressing a variety of issues of constitutional law. The ACLJ is dedicated, *inter alia*, to freedom of speech, including the right of religious speakers to equal access to government fora. ACLJ attorneys have been heavily involved in a number of this Court's equal access cases, notably including *Lamb's Chapel v. Center Moriches Union Free Sch. Dist.*, 508 U.S. 384 (1983). The government's arguments in this case pose a serious threat to current First Amendment doctrine, including the principles of equal access.

SUMMARY OF ARGUMENT

Saying disparaging things about persons, institutions, beliefs, or national symbols may well be uncharitable. The First Amendment, however, does not permit the federal government to be the arbiter of taste in public or private discourse. The government nevertheless attempts to justify such a role under the

---

[1] The parties in this case have consented to the filing of this brief. Copies of the blanket consent letters of the parties are on file with this Court. No counsel for any party authored this brief in whole or in part. No person or entity aside from the ACLJ, its members, or its counsel made a monetary contribution intended to fund the preparation or submission of this brief.

federal trademark statute. The government's arguments, however, represent a distortion of several strands of free speech jurisprudence, namely those governing government speech, government subsidies, commercial speech, and viewpoint discrimination. The government's arguments threaten disarray in free speech case law and in particular bid to undermine established equal access precedents. This Court should reject the government's arguments and affirm the judgment of the en banc Federal Circuit.

ARGUMENT

There are many ways to penalize speech the government does not like. Prohibition is the most obvious, but relegation of certain otherwise protected content or viewpoints to second-class status likewise infringes the First Amendment, at least absent a showing that the government is pursuing a compelling interest by narrowly tailored means. For example, the government could not constitutionally declare that any car bearing "disparaging" bumper stickers or signs may not use HOV or express lanes on federal highways or park in the lots of federal libraries, offices, or museums. The inconvenience to disfavored speakers may be fairly mild, but the hostility to the speech of particular content or viewpoints would be blatant.

What the government argues for in this case is the power to blackball messages the government deems unacceptable. "You can say that," the government acknowledges, "but you thereby forfeit government services such as listing your trademark on a registry." Such official "shunning" should be an obvious First Amendment concern; yet the government here argues, with a straight face, an interest precisely in distancing

itself from disfavored speech, as if it would somehow taint the government to list arguably ugly or mean trademarks in its official register (alongside, it should be noted, countless other trademarks of widely varying degrees of taste).

En route to this position, the government stretches beyond all recognition the government speech, government subsidy, commercial speech, and viewpoint neutrality doctrines. These doctrinal distortions threaten mischief in a host of contexts, notably this Court's important equal access cases. This Court should reject the government's destructive arguments and affirm the judgment below.

I. THE GOVERNMENT SPEECH DOCTRINE DOES NOT ENCOMPASS A REGISTRY OF PRIVATE SPEECH OR IDENTITIES.

Just as the names of the multitudinous entities listed in a phone book are not the speech of the publisher of the directory, so the government's recordation of the trademarks of private businesses does not make the government a speaker of those trademarks. Trademark registration does not entail a contest for the best names, a plea for inclusion in a selective display or collection, or a proposal that the government adopt monikers as its own. The government speech doctrine therefore provides no warrant for the refusal of the government here to register those names it deems tasteless, offensive, or otherwise beneath the government's standards of civility.

A. Scope and Inapplicability of Government Speech Doctrine

"The Free Speech Clause restricts government regulation of private speech; it does not regulate government speech." *Pleasant Grove City v. Summum*, 555 U.S. 460, 467 (2009). Attaching the label "government speech" to expression is thus fatal to any private free speech claims. It is absolutely vital, therefore, that the distinction between private and government speech be drawn correctly.

When the government *selects* things for inclusion on a discretionary menu – which monuments to display in a park, which art to fund or place in a museum, which curriculum to use in government-run schools, which speakers to address a graduation ceremony – that selection process is expressive of the message the government wishes to convey. The government's "selective receptivity," *Pleasant Grove*, 555 U.S. at 471, is government speech,[2] and no

---

[2]The items selected, however, remain the speech of their respective authors. Hence, the message which the particular included item itself conveys is not government speech. When selecting something for inclusion, "a government entity does not necessarily endorse the specific meaning that any particular" item, or viewer of that item, might attribute to it. *Pleasant Grove*, 555 U.S. at 476-77. The government thus does not itself necessarily celebrate the Nativity by including in its museum a masterpiece depicting that scene, for example, or embrace the Communist Manifesto by including it in a library, or adopt the speech of the wide spectrum of guest speakers at the commencement ceremonies of a state university, *e.g.*, Kellie Woodhouse, "University of Michigan commencement speeches through the years," *The Ann Arbor News* (May 4, 2013) ("U-M has hosted a wide range of people as commencement speakers, including jurists Thurgood Marshall and Sandra Day O'Connor

proponent of a competing monument, artistic project, or curriculum can assert a First Amendment right to insert a different message. *E.g.*, *Pleasant Grove* (monuments); *National Endowment for the Arts v. Finley*, 524 U.S. 569 (1998) (arts funding); *see also Chiras v. Miller*, 432 F.3d 606 (5th Cir. 2005) (textbooks for state-approved curriculum).

Here, the trademarks at issue are obviously private speech. The government is not compiling a list of its favorite, or the most interesting, or the most esthetically pleasing trademarks. Rather, it is simply *registering* names generated entirely by private sources. The trademark registry is thus akin to copyright registration, or the federal database of tax exempt organizations, EO Select Check, Internal Revenue Service,[3] or the federal database of Medicare physicians, Physician Compare, Medicare.gov.[4] Such catalogs of private identities or utterances are meant to be comprehensive lists, not government-edited or government-selected pronouncements.

B. Negative Consequences of Expanding the Government Speech Doctrine to Cover Government Registries

Adoption of the federal government's dramatically expanded understanding of government speech would

---

and political figures such as Hilary [sic] Clinton and George H. W. Bush").

[3]https://www.irs.gov/charities-non-profits/exempt-organizations-select-check.

[4]https://www.medicare.gov/physiciancompare/search.html

both increase government power and correspondingly shrink freedom of speech. This censorial power by its nature would not be limited to disfavoring "disparaging" speech; once the "government speech" label applies, First Amendment protections evaporate entirely, and the government is then permitted to impose *any* standards it wishes,[5] even viewpoint discrimination, *Pleasant Grove*, 555 U.S. at 467-68. Consider: The government could refuse to register trademarks that reflect critically on government policies (*compare* "Government is Beautiful," Serial No.[6] 87045555, *with* "Government by Gunpoint," Serial No. 86455666), or that mention religion ("Mormon Tabernacle Choir," Serial No. 76505493), or that take a position on abortion that the government disfavors (*compare* "Abortion Must End Now," Serial No. 77720117, *with* "Religious Coalition for Abortion Rights," Serial No. 73610092).

Nor would the mischief be limited to trademark registration. There are other contexts where government bodies proffer lists – of permitted users of parks, of internal employee groups and their meetings, of student organizations, etc. If the mere fact that the government assembles and publishes such a list means that the government has the power, under the government speech doctrine, to distance itself from disfavored names or messages, then a public school

---

[5]Of course, the government speech would still be subject to *other*, independent constitutional provision, such as the Titles of Nobility Clause or the Establishment Clause. *Pleasant Grove*, 555 U.S. at 468.

[6]All serial numbers herein are taken from results obtained at the trademark search site, tmsearch.uspto.gov.

could refuse to register or list religious users of after-school property, flying in the face of *Lamb's Chapel* and other equal access rights cases.[7] A government employer could likewise refuse to register for space or list on internal notices any employee group it disfavored, whether religious, political, civic, etc. And a state university could refuse to recognize student groups whose names suggest departure from the university's preferred policies.[8] *See also infra* § II(B).

C. Inadequacy of the "Government Program" Argument

The government seeks a different rule, proposing that speech is "government speech" if it takes place

---

[7]The government tries to quell this concern by contending that "this case . . . does not raise any public-forum issues." Pet. Br. at 40. However, none of the government's arguments turn on the absence of a public forum. Government speech, for example, is government speech even if it takes place in a public forum like a park, *e.g.*, *Pleasant Grove*. Ditto for the issues of government subsidies, commercial speech, and viewpoint neutrality. None of these matters turn on forum questions. Hence, embrace of the government's arguments in the present context would set the rule for the gamut.

[8]The University of Central Florida, for example, one of the largest public universities in the nation, lists numerous "registered student organizations," some of which could have missions that run counter to a given administrations' interests or policies on various fronts: the Body of Animal Rights Campaign, College Democrats, College Republicans, Dream Defenders, Gun Club, NORML@UCF, Progressive Action at UCF, VOX: Voices for Planned Parenthood, and Young Americans for Freedom. *See* Student Organizations, http://osi.ucf.edu/student-orgs/ (click on "See List of RSOs").

within the scope of a government program. Pet. Br. at 15. This is plainly wrong. The private entities seeking contributions from government employees (*Cornelius v. NAACP Legal Defense & Educ. Fund*, 473 U.S. 788 (1985)) or access to teachers (*Perry Educ. Ass'n v. Perry Local Educators' Ass'n*, 460 U.S. 37 (1983)) spoke within the scope of government programs (the Combined Federal Campaign and the school's internal mail system, respectively). All communications to and from prisoners take place within the scope of state penal programs. *Thornburgh v. Abbott*, 490 U.S. 401 (1989). The private speakers in this Court's "equal access" cases spoke within the scope of some facilities use program (*Widmar v. Vincent*, 454 U.S. 263 (1981); *Lambs Chapel v. Center Moriches Union Free School Dist.*, 508 U.S. 384 (1993); *Good News Club v. Milford Central School*, 533 U.S. 98 (2001)) or educational program (*Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819 (1995)). Yet in none of these cases did this Court apply the government speech doctrine, which would have left the restricted speech devoid of First Amendment protection.

Practically everything the government does can be characterized as a "government program." If that were enough to label all speech therein "government speech," then the government would possess plenary censorship power over the private speakers in public parks, schools and universities, work spaces, and any enterprise that receives a drop of government funding.

D. Inapplicability of *Walker v. Texas Division*

The government analogizes the present case to this Court's recent license plate decision, *Walker v. Texas*

Div., Sons of Confederate Veterans, 135 S. Ct. 2239 (2015), to support its contention that the government cannot be forced to utter or associate with messages it considers repugnant. Pet. Br. at 37-41.[9] But the *Walker* Court's holding, that the specialty plates at issue there were government speech, turned on a long list of factors inapplicable here, such as government ownership and editorial control of the message, selectivity of the messages accepted for specialty plates, and the historic use of the specialty license plates as government identification and promotional devices, 135 S. Ct. at 2247-50. By contrast, the federal government does not edit trademarks, there is no selectivity – the government registers all otherwise eligible comers (aside from the haphazardly applied tastefulness limits at issue here) – and trademarks are not IDs or marketing channels *for the government*.

---

[9]There are several problems with the government's repeated invocation of the prospect of registering the "most repellant" slurs and "demeaning" or "crude" messages, Pet. Br. at 28. First, it is difficult to take seriously the government's asserted interest, when the government already registers numerous trademarks expressly referring to "porn," "slut," and various crude excretory and anatomical terms. *See* tmsearch.uspto.gov. Second, there will be a natural disincentive for trademark owners to use, much less register, the most repugnant names, as this would risk alienating potential customers or supporters. *Cf.* Amici Br. of Certain Members of Congress in Support of Neither Party § III (conceding slurs make "poor trademarks"). Market forces therefore already target the asserted evil, reducing any need for the government to inject its own force to "encourage" (Pet. Br. at 11, 16) civility in trademarks. And third, resort to theoretical extreme abuses proves too much: that argument could be used against *any* free speech (or other rights) claim. *Cf. Cohen v. California*, 403 U.S. 15 (1971).

True, the asserted interest in disassociating from a message is common to this case and *Walker*, but that interest does not itself convert private speech into government speech. Third-party speech on the grounds of a shopping mall does not become the speech of the mall owners just because the owners might object to being associated with the message. *PruneYard Shopping Center v. Robins*, 447 U.S. 74, 85-88 (1980). A protest on government property does not become government speech just because the government fears being associated with the message. *United States v. Grace*, 461 U.S. 171 (1983). And the desire of a public school or university to distance itself, for anti-establishment purposes, from the religious message of private users, as in *Widmar*, *Lambs Chapel*, *Good News Club*, etc., does not morph the private speech into government speech. Merely *allowing* private speech does not make it government speech: "The proposition that [government bodies] do not endorse everything they fail to censor is not complicated." *Board of Educ. v. Mergens*, 496 U.S. 226, 250 (1990) (plurality). Likewise, merely *recognizing* (by registering) private speech does not convert that speech into the government's own speech. The government's desire to disassociate itself from a private message goes to the asserted *justification* for the restriction on private speech, not the nature of the speech itself.

Indeed, the government's argument that the government speech doctrine applies "when communication takes place over a government platform," Pet. Br. at 42, aims a dagger at the heart of free speech. Public parks and sidewalks are "government platforms." A government-sponsored event like a graduation or a panel on climate change

can literally provide a "government platform." After-school facilities and university meeting rooms are "government platforms." This does not mean any speaker in such a context utters "government speech" subject to unlimited government censorship.

II. REGISTERING A TRADEMARK IS NOT A SUBSIDY.

The government relies upon this Court's government subsidy cases. That reliance is ill-founded. There is no subsidy here that would warrant giving the federal government censorship powers over its listing of trademarks. And even if there were a subsidy here, government may not "leverage . . . subsidies . . . into a penalty on disfavored viewpoints," *NEA v. Finley*, 524 U.S. at 587.

A. Scope and Inapplicability of Government Subsidy Doctrine

The treatment of discretionary government subsidies under the First Amendment is akin to the government speech doctrine. Basically, just as the government gets to say what it wants (assuming no independent constitutional violation), the government gets to direct its discretionary funding so as to further its program goals, including shaping any messages that are part of that program goal. "Government may allocate competitive funding according to criteria that would be impermissible were direct regulation of speech or a criminal penalty at stake." *NEA v. Finley*, 524 U.S. at 587-88.

The government subsidy doctrine does *not* apply where the government is providing some standard

service or benefit (e.g., flood relief, interstate highway passage, taxpayer information and assistance, adjudication of legal claims). Certainly those government programs, like all government actions, entail the expenditure of funds. But that is not enough to nullify First Amendment concerns. The government cannot willy-nilly use the carrot of taxpayer funding to obtain the forfeiture of constitutional rights. While he who "pays the piper" generally gets to "call the tune," *Democratic Senatorial Comm. v. FEC*, 660 F.2d 773, 781 (D.C. Cir. 1980) (per curiam opinion of Wright and GINSBURG, JJ.), this Court has repeatedly "recognize[d] a limit on Congress' ability to place conditions on the receipt of funds," *Rumsfeld v. FAIR*, 547 U.S. 47, 59 (2006). In particular, "the Government may not deny a benefit to a person on a basis that infringes his constitutionally protected . . . freedom of speech even if he has no entitlement to that benefit." *Agency for Int'l Development v. Alliance for Open Soc'y Int'l, Ltd.* [*AID v. AOSI*], 133 S. Ct. 2321, 2328 (2013) (internal quotation marks and citations omitted). A number of this Court's cases exemplify this "unconstitutional conditions" doctrine. *E.g.*, *AID v. AOSI*; *FCC v. League of Women Voters of Cal.*, 468 U.S. 364 (1984); *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533 (2001). Where the government denies generally available public benefits or services because the target declines to adopt a particular policy – e.g., no welfare benefits to those who do not profess support for reducing the federal budget, or no Library of Congress research services for those who refuse to support gun control – this blatantly infringes upon the First Amendment right to free speech (and freedom of thought as well). The government cannot make ideological conformity the price of the incidents of

citizenship. "Authority here is to be controlled by public opinion, not public opinion by authority." *West Va. Bd. of Educ. v. Barnette*, 319 U.S. 624, 641 (1943). "If there is any fixed star in our constitutional constellation, it is that no official, high or petty, can prescribe what shall be orthodox in politics, nationalism, religion, or other matters of opinion or force citizens to confess by word or act their faith therein." *Id.*

Here the government is essentially attempting to shun those entities with politically disfavored names. "You can call yourself that," the government says, "but if you do, you can't get the same trademark registration as everyone else." That violates not just the First Amendment, but limits on federal power to condition funding: funding conditions must at a minimum be related to the legitimate government interests that the program is intended to further. *South Dakota v. Dole*, 483 U.S. 203, 207-08 (1987). Excluding entities from federal funding programs just because, in the government's view, they espouse or reflect a particular undesirable viewpoint, regardless of the lack of a connection to the purposes of the particular program at issue, would fail this threshold test and thus unconstitutionally penalize those entities for their speech (or refusal to speak).

B. Limiting *CLS v. Martinez*

One fairly recent decision of this Court is in some tension with these crucial principles – *Christian Legal Society v. Martinez*, 561 U.S. 661 (2010) – but that case should not control the analysis going forward, either because it should be limited to its facts or because it should be repudiated (or ignored, as in *AID v. AOSI*).

In *CLS*, a government entity imposed the requirement that, as a condition of the benefits available to student clubs, every club must adopt a policy of indifferentism regarding religion and sexual behavior. *Id.* at 670-73. In other words, student groups were relegated to second-class status unless they in effect professed that a member's religious beliefs were irrelevant to the identity and effectiveness of a religious club, and that one's departure from traditional Christian sexual norms – and the consequent scandal – was irrelevant to the mission integrity of a Christian group.

Contrary to the principles described above, the policy requirement in *CLS* was not limited to participation in a particular, discretionary government program – e.g., a student work camp project aimed at helping AIDS victims. Nor was the requirement limited to a small subset of the population for whom the policy might arguably represent a job qualification, e.g., those applying for an assistantship position in the "diversity office" or campus chaplaincy. Instead, the rule was imposed upon the entire relevant universe – all students attending the state law school – as a condition of a standard, generally available benefit – forming a recognized club. Furthermore, the requirement was not directly linked to the program at issue: a policy on religion or sexual behavior generally has nothing to do with student club activities, and where such a policy might be relevant, it could as easily be completely counterproductive, indeed nonsensical – e.g., forcing a Jewish club to allow Muslim or Christian officers.

To the extent that *CLS* stands for the proposition that the government may impose ideological strings on benefits, it should be overruled as inconsistent with

this Court's First Amendment and unconstitutional conditions cases. To the extent that *CLS* says a government body – in that case, a law school, but by parity of reasoning also a municipality, a state, or the federal government – can extract a pledge of submission to the currently regnant ideology or else impose second-class status upon the population it governs, the *CLS* decision is deeply and fundamentally inconsistent with liberty in general and free speech in particular, and should be overruled.

At a minimum, *CLS* must be read as limited to its peculiar facts. The *CLS* Court observed that, while a Christian group bizarrely had to agree that its officers need not be Christian and need not profess to follow Christian norms, such a group could nevertheless adopt "generally applicable membership requirements unrelated to status or beliefs." *Id.* at 671 n.2 (internal quotation marks omitted). If these permissible "good-behavior," "attendance, [and] skill measurements" requirements, *id.*, allow a club to maintain its identity and integrity – e.g., by treating profound ignorance or disregard of the club's Christianity-derived norms as a disqualifier – then *CLS* would stand only for the dangerous, but more narrow, proposition that clubs must *profess* indifference to their identity but may nevertheless *maintain* group mission coherence through conduct and skill requirements.

In sum, if *CLS* were taken at face value, a government body could relegate to second-class status, by refusal to register (or fund, *contra AID v. AOSI*), those groups which do not profess adherence to a deeply controversial policy position, even in the context of access to a speech forum. *A fortiori*, a government body could relegate to second-class status, by a refusal to register, those trademarks that do not comport with

the government's current ideological position. But because *CLS* is so profoundly inconsistent with broader, preexisting First Amendment principles – principles *CLS* did not purport to overturn – this Court should not rely upon *CLS* here, but rather should disavow its pernicious holding.[10]

III. TRADEMARKS ARE NOT COMMERCIAL SPEECH.

The government's contention that the trademarks it registers are "commercial speech" and therefore subject to lesser First Amendment scrutiny, Pet. Br. at 48, is plainly incorrect. Trademarks are names, not sales pitches. One need not be commercial to have a trademark. For example, the following are all registered trademarks: American Civil Liberties Union (Serial No. 74459922), NAACP (Serial No. 73213726), PETA (Serial No. 74166556), American Jewish Congress (Serial No. 85148742), Catholic Charities USA (Serial No. 85343169), Jewish Women International (Serial No. 76485716), NEA (Serial No. 85118805), Institute for Justice (Serial No. 77618391), and National Federation of the Blind (Serial No. 86403086). That commercial entities have trademarked names no more makes such names commercial speech than does the fact that donor-

---

[10]It is perhaps reflective of the outlier status of *CLS* that, since its issuance, this Court has *not once* cited the case for its merits holding (even in a case like *AID v. AOSI*, where it was obviously relevant), and neither petitioner nor its supporting amici cite the case at all, despite its plain relevance to the questions of viewpoint neutrality, government benefits, and First Amendment claims in the context of a government program.

supported nonprofits have trademarked names make such trademarks "solicitations."[11]

IV. A PROHIBITION ON REGISTERING DISPARAGING SPEECH IS VIEWPOINT-BASED.

The government takes the position that a ban on "disparaging" speech is not viewpoint-based.[12] This is untenable. A law that prohibited "disparaging" public office holders, for example, would most assuredly be viewpoint-based, as it would eliminate only *critical* speech, not praise. Likewise, a law that denied tax exemption to any religious group that "disparages" any other religious beliefs would be viewpoint-based – the

---

[11]Of course a trademark can be *used* in a solicitation or in commercial speech (*e.g.*, *Friedman v. Rogers*, 440 U.S. 1, 11 (1979)), just like a phrase from Shakespeare can be used in a solicitation or in commercial speech (*see* David Smith, "He's the real thing: how Shakespeare influenced the American ad industry," *The Guardian* (Apr. 7, 2016)). Such *use* no more makes a trademark itself commercial or a solicitation than would analogous use alter the nature of Shakespeare's lines themselves.

[12]The question whether the challenged provision is viewpoint-based can sometimes be result-determinative, as in nonpublic forum cases, where content restrictions are permissible but viewpoint limits are not, *Rosenberger*, 515 U.S. at 829-30. In other contexts, however, content restrictions trigger strict scrutiny, regardless of viewpoint neutrality. *E.g.*, *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2229-30 (2015). The government does not dispute that the bar on "disparaging" trademarks is content-based. To the extent that fact suffices to warrant strict scrutiny, the question whether the restriction is also viewpoint-based is, as to this case, academic. That is all the more reason for this Court not to embrace an argument – the government's – that would impair First Amendment jurisprudence going forward.

group's members could laud, but not point out the baselessness or incoherence of, any other competing religious claims, even when done with charity and intellectual rigor.

The cases cited by the government and the court below do not support the contention that a restriction on "disparaging" speech is viewpoint-neutral.

In *Boos v. Barry*, 485 U.S. 312 (1988), this Court reviewed a First Amendment challenge to a law that banned, within a certain distance of embassies, speech that tends to "bring into public disrepute" any foreign government or officer thereof, *id.* at 316 (quoting statute). The lead opinion states that this provision is "not directly viewpoint-based", *id.* at 319 (plurality of O'Connor, J., joined by Stevens & Scalia, JJ.). However, (1) this was a plurality opinion, not a majority; (2) the statement was dicta, as the Court in any event struck the provision down as a content-based restriction that failed strict scrutiny, *id.* at 319-29; and, (3) the plurality's rationale – the provision is viewpoint neutral because it "determines *which viewpoint is acceptable* in a neutral fashion," *id.* at 319 (emphasis added) – itself concedes the viewpoint focus of the law and thus is internally incoherent.

In *R.A.V. v. City of St. Paul*, 505 U.S. 377 (1992), the Court reviewed a First Amendment challenge to a hate crimes ordinance. The government points out that the *R.A.V.* Court observed that "[d]isplays containing some words – odious racial epithets, for example – would be prohibited to proponents of all views," *id.* at 391; the government reads that *description* as a *holding* that a ban on "odious" epithets would be viewpoint neutral. But this badly misreads *R.A.V.* First of all, the ordinance at issue had been construed only to apply to "fighting words," *id.* at 391. Hence, any speech the

ordinance reached already fell outside the protection of the First Amendment. *Chaplinsky v. New Hampshire*, 315 U.S. 568 (1942). So the reference to "odious racial epithets" must be understood as connoting only unprotected fighting words. Here, by contrast, there is no question that the name for which respondent sought a registered trademark is protected speech. Second, the Court *nevertheless found the ordinance impermissibly viewpoint-based*. To illustrate this, the Court explained that the fighting words in question were not prohibited in a viewpoint-neutral fashion:

> Displays containing some words – odious racial epithets, for example – would be prohibited to proponents of all views. But **"fighting words" that do not themselves invoke race, color, creed, religion, or gender** – aspersions upon a person's mother, for example – **would seemingly be usable** *ad libitum* **in the placards of those arguing in favor** of racial, color, etc., tolerance and equality, **but** could **not** be used by **those speakers' opponents**. One could hold up a sign saying, for example, that all "anti-Catholic bigots" are misbegotten; but not that all "papists" are, for that would insult and provoke violence "on the basis of religion."

R.A.V., 505 U.S. at 391-92. In the present case, disparaging persons, institutions, and beliefs precludes registration, but disparaging other things – certain music, foods, sports, etc. – does not. Moreover, extolling those same persons, institutions, or beliefs does not preclude registration. The challenged trademark provision is therefore viewpoint-based

precisely under the holding of *R.A.V.* – and more so, since the speech at issue here is not a First Amendment outsider like "fighting words."[13]

* * *

The government asserts the power to refuse to register any such trademark just because a government agent or agency deems the name to disparage some person, institution, or belief. The boundless subjectivity of such government oversight is plain: a government trademark official or reviewing board conceivably could, for example, disallow the following current trademarks: Association for Retarded Citizens (Serial No. 77207396) (disparaging to the intellectually disabled?), Ecolocaust (Serial No. 85860627) (disparaging to Holocaust victims by equating their harm with environmental degradation?), Abortion Must End Now (Serial No. 77720117) (disparaging to abortionists or post-abortion women?), or Animals Are Not Ours to Eat, Wear, Experiment on or Use for Entertainment (Serial No. 76538386) (disparaging to non-vegetarians, fur clothing purchasers, lab researchers, and circus performers?). Thankfully, the First Amendment no more permits a Ministry of Civility than it permits a

---

[13] *Parker v. Levy*, 417 U.S. 733 (1974) (upholding, against vagueness and overbreadth challenges, in special context of military, a conviction for disloyal speech deemed "conduct unbecoming an officer and a gentleman") is inapposite. The present case does not involve the "different character of the military community and of the military mission" which necessitate "different application of First Amendment doctrines," *id.* at 758.

Ministry of Truth, *United States v. Alvarez*, 132 S. Ct. 2537, 2547 (2012).

CONCLUSION

This Court should affirm the judgment of the en banc Federal Circuit.

Respectfully submitted,

Jay Alan Sekulow
Counsel of Record
Stuart J. Roth
Colby M. May
Walter M. Weber
American Center for
Law & Justice
201 Maryland Ave., N.E.
Washington, DC 20002
(202) 546-8890
sekulow@aclj.org

Dec. 7, 2016

No. 15-1293

FILED
DEC 15 2015

IN THE

Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR,
UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

—v.—

SIMON SHIAO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF *AMICI CURIAE* OF THE AMERICAN CIVIL LIBERTIES UNION, THE ACLU OF THE NATION'S CAPITAL, THE ACLU FOUNDATION OF OREGON, THE ASIAN AMERICAN LEGAL DEFENSE AND EDUCATION FUND, THE ASIAN PACIFIC AMERICAN NETWORK OF OREGON, THE CHINESE AMERICAN CITIZENS ALLIANCE, PORTLAND LODGE, THE PORTLAND JAPANESE AMERICAN CITIZENS LEAGUE, AND THE OREGON COMMISSION ON ASIAN AND PACIFIC ISLANDER AFFAIRS, IN SUPPORT OF RESPONDENT

Mathew W. dos Santos
AMERICAN CIVIL LIBERTIES UNION FOUNDATION OF OREGON
P.O. Box 40585
Portland, OR 97240

Lee Rowland
Counsel of Record
Esha Bhandari
Vera Eidelman
AMERICAN CIVIL LIBERTIES UNION FOUNDATION
125 Broad Street
New York, NY 10004
(212) 549-2500
lrowland@aclu.org

(*Counsel continued on inside cover*)

Arthur B. Spitzer
Scott Michelman
AMERICAN CIVIL LIBERTIES UNION
OF THE NATION'S CAPITAL
4301 Connecticut Avenue
Washington, D.C. 20008

David Cole
AMERICAN CIVIL LIBERTIES
UNION FOUNDATION
915 15th St., NW
Washington, D.C. 20005

TABLE OF CONTENTS

TABLE OF AUTHORITIES ii

INTEREST OF *AMICI CURIAE* 1

ARGUMENT 8

I. SECTION 2(A) OF THE LANHAM ACT REGULATES PRIVATE SPEECH ON THE BASIS OF VIEWPOINT 8

II. SECTION 2(A) OF THE LANHAM ACT PLACES AN UNCONSTITUTIONAL CONDITION ON THE RECEIPT OF VALUABLE GOVERNMENT BENEFITS 14

A. The Government May Not Discriminate On The Basis Of Viewpoint In Allocating Government Benefits To Private Speech. 15

B. Section 2(a)'s Viewpoint Discrimination Is Not Permissible As A Form Of Government Speech Or Because It Regulates A Government Program. 17

III. SECTION 2(A) IS UNCONSTITUTIONALLY VAGUE AND LEADS TO ARBITRARY TRADEMARK DETERMINATIONS. 20

IV. HOLDING THAT SECTION 2(A) IS FACIALLY UNCONSTITUTIONAL WOULD NOT SIGNIFICANTLY ALTER THE LANDSCAPE OF TRADEMARK LAW AND WOULD BRING TRADEMARK IN LINE WITH COPYRIGHT. 25

CONCLUSION 27

TABLE OF AUTHORITIES

CASES

Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc., 133 S. Ct. 2321 (2013) 16

Belcher v. Tarbox, 486 F.2d 1087 (9th Cir. 1973) 25

Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903) 26

Coates v. Cincinnati, 402 U.S. 611 (1971) 10

Davenport v. Washington Educ. Ass'n, 551 U.S. 177 (2007) 16

Ex parte Murphy, 200 U.S.P.Q. (BNA) 801 (1977) .. 25

Forsyth Cty., Ga. v. Nationalist Movement, 505 U.S. 123 (1992) 19

Good News Club v. Milford Cent. Sch., 533 U.S. 98 (2001) 9, 15

Grayned v. City of Rockford, 408 U.S. 104 (1972) 20

Hannegan v. Esquire, Inc., 327 U.S. 146 (1946) 6, 19

In re Heeb Media, LLC, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008) 11

In re Old Glory Condom Corp., 26 U.S.P.Q.2d 1216 (1993) 18

In re Riverbank Canning Co., 95 F.2d 327 (C.C.P.A. 1938) 22

In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L., 159 U.S.P.Q. 275 (T.T.A.B. 1968). 23

Keyishian v. Bd. of Regents, 385 U.S. 589 (1967) 20

Lamb's Chapel v. Center Moriches Union Free School District, 508 U.S. 384 (1993) 5

Legal Servs. Corp. v. Velazquez, 531 U.S. 533 (2001) 5, 15

Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252 (4th Cir. 2007) 9

Mitchell Bros. Film Grp. v. Cinema Adult Theater, 604 F.2d 852 (5th Cir. 1979) 25, 26

Radiance Foundation, Inc., v. NAACP, 786 F.3d 316 (4th Cir. 2015) 10

Regan v. Taxation With Representation of Washington, 461 U.S. 540 (1983) 16, 20

Reno v. American Civil Liberties Union, 521 U.S. 844 (1997) 20

Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989) 9

Rosenberger v. Rectors and Visitors of Univ. of Virginia, 515 U.S. 819 (1995) .....*passim*

Rubin v. Coors Brewing Co., 514 U.S. 476 (1995) ... 20

Rust v. Sullivan, 500 U.S. 173 (1991) 17

Shuttlesworth v. City of Birmingham, 394 U.S. 147 (1969) 1

Speiser v. Randall, 357 U.S. 513 (1958) 16

Texas v. Johnson, 491 U.S. 397 (1989) 5, 10, 14

Thomas v. Union Carbide Agric. Products Co., 473 U.S. 568 (1985) 21

Walker v. Texas Div., Sons of Confederate Veterans, Inc., 135 S. Ct. 2239 (2015) 18, 19

Ysursa v. Pocatello Educ. Ass'n,
555 U.S. 353 (2009) 16

CONSTITUTION & STATUTES

U.S. Const. amend. I ..... *passim*

Lanham Act, 15 U.S.C. § 1052(a) ..... *passim*

15 U.S.C. § 1125(c)(3) 12

OTHER AUTHORITIES

Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark Law After* Lawrence v. Texas, 9 Marq. Intell. Prop. L. Rev. 187 (2005) ... 11

United States Patent and Trademark Office, Trademark Manual of Examining Procedure (TMEP) (Oct. 2016) 21, 24

INTEREST OF *AMICI CURIAE*[1]

The **American Civil Liberties Union** ("ACLU") is a nationwide, nonprofit, nonpartisan organization with approximately 500,000 members dedicated to the principles of liberty and equality embodied in our nation's Constitution and civil rights laws. Since its founding in 1920, the ACLU has vigorously defended both free speech and racial justice. In specific instances, tensions arise between these two principles. However, nearly a century of experience has convinced the ACLU that a strong First Amendment is not only compatible with equality but essential to its pursuit. Many of the landmark civil rights decisions of the 1950s and 1960s arose out of free speech controversies, *see, e.g.*, *Shuttlesworth v. City of Birmingham*, 394 U.S. 147 (1969), freedom of speech and association have long been important tools for disadvantaged minorities to seek equal treatment, and efforts to suppress particular viewpoints are often aimed at racial and ethnic minorities.

To preserve the principle of viewpoint neutrality, the ACLU and its affiliates have appeared in countless cases throughout the country. The ACLU participated as *amicus* and presented oral argument in this case to the *en banc* Court of Appeals. Accordingly, the proper resolution of this case is a matter of substantial interest to the ACLU

---

[1] All parties have given blanket consent to the filing of *amicus* briefs in this case. No party has authored this brief in whole or in part, and no one other than *amici*, their members, and their counsel have paid for the preparation or submission of this brief.

and its members. The **American Civil Liberties Union of Oregon** is a state affiliate of the national ACLU. The **American Civil Liberties Union of the Nation's Capital** is the Washington, D.C. affiliate of the national ACLU.

The **Asian American Legal Defense and Education Fund** ("AALDEF"), founded in 1974, is a national organization that protects and promotes the civil rights of Asian Americans. AALDEF recognizes the harmful impacts of racial slurs and hateful speech on Asian Americans and opposes stereotypes that stigmatize the Asian American community. At the same time, AALDEF believes that Section 2(a) of the Lanham Act violates the First Amendment. The Act grants unbridled discretionary power to the United States Patent and Trademark Office ("PTO") to determine what may "disparage" Asians Americans and other racial and ethnic groups. This broad authority should not be used to disadvantage groups in political disfavor with the government and minorities seeking to challenge and reclaim racist language.

The **Asian Pacific American Network of Oregon** ("APANO") is a statewide, grassroots organization, uniting Asians and Pacific Islanders to achieve social justice. APANO envisions a just and equitable world where Asians and Pacific Islanders are fully engaged in the social, economic, and political issues that affect the community. APANO has worked for 20 years engaging Asian and Pacific Islander citizens in the electoral process, providing language access, and increasing opportunities for civic participation. Protecting free speech and self-expression is essential to building an equitable

society in which all members can fully participate as citizens. The PTO has placed undue burdens on historically marginalized communities whose voices are disproportionately suppressed through their actions. APANO aims to encourage messages of racial justice without concerns of government misinterpretation or abridgement of rights.

The **Chinese American Citizens Alliance, Portland Lodge** is a social fraternal organization providing community service, promoting civil engagement, and developing youth leadership through scholarships, education and recreational programming. Since its inception in 1895, the Chinese American Citizens Alliance ("C.A.C.A.") has stepped forward to promote citizenship, better the community, and combat ongoing anti-Chinese sentiment. Among the C.A.C.A.'s most important and enduring missions is the defense of civil rights and immigration rights of Chinese and Chinese-Americans, and the struggle against stereotyping, ethnic discrimination, and racial profiling. The Portland Lodge is the Portland chapter of the C.A.C.A.

The **Portland Japanese American Citizens League** strives to promote diversity and social justice, and monitors and responds to issues that threaten the civil and human rights of all Americans. The Japanese American Citizens League ("JACL"), founded in 1929, is the oldest and largest Asian American civil rights organization in the United States. The Portland JACL is a 501 (c)3 affiliate of the national JACL in Washington, D.C., and serves members in the Portland and southwest Washington areas. The events of September 11, 2001 created a

worldwide climate of insecurity and new threats to civil liberties. The Portland JACL has reached out to Muslim Americans and other targeted communities to offer partnership, supported the LGBTQ community's efforts to obtain equal rights in marriage and public accommodations, and objected to a line of Adidas shoes featuring a buck-toothed slant-eyed character with a bowl haircut. The Portland JACL protested when the city of Gresham proposed honoring a former mayor who advocated for the removal of Japanese Americans from the west coast and a constitutional amendment to revoke their citizenship. The Portland JACL supports Respondent Simon Tam's wish to obtain a trademark for his band, The Slants. The band's intention is to take ownership of a disparaging term and to exercise its First Amendment right of free speech. The Portland JACL is concerned that government attempts to determine "offensiveness" have disparate impacts on communities and individuals of color.

The **Oregon Commission on Asian and Pacific Islander Affairs** ("OCAPIA") is an eleven-member advisory group of nine community leaders appointed by the Governor and two Oregon legislators appointed by the President of the Senate and the Speaker of the House for the purpose of advising on policy issues that affect the success of the Asian and Pacific Islander community statewide, including lowering barriers and assuring equity in policy matters. OCAPIA has known and worked with Respondent Simon Tam around his efforts regarding the name "The Slants" for a number of years as an emerging trademark issue, through the appeal with the PTO, and now as a broader issue of the rights of minority and ethnic communities to reclaim use of

words that define, in part, their self-identification in American society. During this period, OCAPIA has received regular reports from Mr. Tam about his case with the PTO, has written to the PTO requesting an equitable review of Mr. Tam's appeal, and now joins as *amicus* in support of his case.

SUMMARY OF ARGUMENT

Few principles of constitutional law are as settled as the First Amendment's prohibition against government regulation of private speech based on viewpoint. The First Amendment precludes the government from discriminating on the basis of viewpoint whether it is imposing direct punishments, *Texas v. Johnson*, 491 U.S. 397, 414 (1989); regulating access to a public or even a nonpublic forum, *Lamb's Chapel v. Center Moriches Union Free School District*, 508 U.S. 384, 393–94 (1993); or allocating subsidies for private expression, *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 547–49 (2001). This rule holds no less true in the context of intellectual property. Just as the First Amendment would not tolerate the granting of copyrights only to works that convey views a government censor approves, so it cannot tolerate the selective registration of trademarks on that basis.

The Lanham Act, 15 U.S.C. § 1052(a) (hereinafter "Section 2(a)"), facially discriminates on the basis of viewpoint in the registration of trademarks. It denies registration to marks that the PTO interprets to "comprise[ ] immoral . . . or scandalous" matter or matter that "may disparage . . . persons, living or dead, institutions, beliefs, or national symbols," while permitting registration of

marks that celebrate those same persons, institutions, beliefs, or national symbols. Section 2(a) casts government officials in the impermissible role of language police, directing them to benefit favored viewpoints while denying the same benefits to disfavored viewpoints on the same subject.

Registration provides substantial benefits to the trademark holder, and trademarks are often intended and understood to convey a message or idea. Indeed, it is precisely because Respondent Simon Tam's trademark expresses what the United States Patent and Trademark Office ("PTO") considers a politically unacceptable idea that it was denied registration. This Court has held that the government may not distribute benefits to private speech based on approval or disapproval of its viewpoint. Just as it would be an impermissible "power of censorship" to deny mailing privileges to a magazine because its content was deemed morally "good" or "bad," *Hannegan v. Esquire, Inc.*, 327 U.S. 146, 151 (1946), so, too, it is impermissible for the PTO to deny registration to marks that it considers "disparaging."

Petitioner contends that it can discriminate in this manner because the denial of trademark registration does not restrict speech, but merely denies a benefit. But the prohibition on viewpoint discrimination applies equally to the distribution of benefits to private speech as to the imposition of penalties. And the system for registering trademarks, like that for registering copyrights, is manifestly designed to promote and support a diversity of private expression, and not to express a government message. Here, as in copyright and all

other government regulation of private speech, the government must remain viewpoint-neutral.

A system of government benefits distributed based on assessments of whether private speech disparages individuals, institutions, beliefs, or national symbols will inevitably reflect the subjective judgments of the government officials involved. As demonstrated by this case, such judgments may hinder members of racial minorities from attempting to use and change the meaning of language, and may treat trademarks differently depending on the identity of the speaker. The PTO denied registration here in part because the applicant is Asian-American, and in part because the PTO did not appreciate the applicant's attempt to reappropriate the term "slants" as a political act.

The constitutional harms caused by Section 2(a) are magnified by its vague and subjective terms. A prohibition on disparaging persons, institutions, beliefs, or national symbols provides no meaningful notice to speakers as to what speech the government will find acceptable. The vague standards of Section 2(a) have produced arbitrary and irreconcilable results, with the same mark being accepted for some applicants but rejected for others in similar contexts. Such results are a telltale sign that Section 2(a) cannot pass constitutional muster. The chilling effect of Section 2(a) is greatly exacerbated by the fact that its strictures are subject to continual reconsideration. The provision allows the PTO to find a mark disparaging at any point in time, even if it was not deemed disparaging at the time of registration. Thus, a trademark applicant must guess not only at what a PTO official might find disparaging today, but at

what some future official may find disparaging years from now.

In denying Respondent the benefit of registering The Slants' mark because of the PTO's conclusion that the band's name expresses a disparaging viewpoint, the government violated the First Amendment. The Court should end this system of viewpoint discrimination by striking down Section 2(a)'s prohibition on the registration of "disparag[ing]" marks.[2]

ARGUMENT

I. SECTION 2(A) OF THE LANHAM ACT REGULATES PRIVATE SPEECH ON THE BASIS OF VIEWPOINT.

The Lanham Act discriminates against private viewpoints protected by the First Amendment by prohibiting the registration of trademarks that the government deems immoral, scandalous, or disparaging. Section 2(a) distributes government

---

[2] Although the constitutionality of Section 2(a)'s disparagement clause is the only question before the Court, the portion of Section 2(a) that bars registration of marks comprising "immoral" or "scandalous" matter, *see* 15 U.S.C. § 1052(a), suffers from the same constitutional infirmities because it is a viewpoint-based, vague regulation of speech. In a separate case pending before the U.S. Court of Appeals for the Federal Circuit, the government took the position that "in view of the totality of the [Court of Appeals'] reasoning" in holding the disparagement clause facially unconstitutional in *In re Tam*, there was no "reasonable basis . . . for treating [the "immoral" and "scandalous" portion] differently." *See* Letter from Appellee Lee Responding to Court Order of December 22, 2015 at 1–2, *In re Brunetti*, No. 15-1109 (Fed. Cir. Jan. 1, 2016).

benefits only after a government official has assessed the message communicated by a putative trademark and determined that it does not express an unacceptable viewpoint. If a trademark celebrates a person, institution, belief, or national symbol, it may be registered, but a trademark that expresses a "disparaging" view about the same subject matter will be denied registration. It is axiomatic that the government may not regulate private expression based on its viewpoint; viewpoint discrimination triggers strict scrutiny and is presumptively invalid. *Good News Club v. Milford Cent. Sch.*, 533 U.S. 98 (2001); *Rosenberger v. Rectors and Visitors of Univ. of Virginia*, 515 U.S. 819 (1995), 828–29. By mandating viewpoint-based discrimination, Section 2(a) violates the First Amendment.

Trademark applicants often propose marks explicitly intended to define a group identity,[3] engage in parody,[4] convey artistic ideas,[5] or (as here) express a political opinion. Accordingly, the registration of trademarks must comport with traditional First

---

[3] For example, "American Civil Liberties Union" and "ACLU" are federally registered trademarks that, among other things, convey a message about the values and identity of one of the *amici curiae* filing this brief.

[4] *See Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007) (concluding that the trademark for "Chewy Vuitton" dog toys was "a comment on the rich and famous, on the LOUIS VUITTON name and related marks, and on conspicuous consumption in general").

[5] *Cf. Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) (noting that film titles are "of a hybrid nature, combining artistic expression and commercial promotion").

Amendment protections. *See, e.g., Radiance Foundation, Inc., v. NAACP*, 786 F.3d 316, 321–22 (4th Cir. 2015).

The plain language of Section 2(a) requires viewpoint discrimination. Its prohibition on registration for "immoral," "scandalous," or "disparag[ing]" trademarks is aimed at avoiding controversy—any determination under the section explicitly turns on whether a government official believes that the public (or some fraction of it) would consider a mark offensive. In effect, Section 2(a) codifies a preemptive heckler's veto. But this Court has held that "the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." *Johnson*, 491 U.S. at 414; *see also Coates v. Cincinnati*, 402 U.S. 611, 615 (1971) ("public intolerance or animosity cannot be the basis for abridgment of these constitutional freedoms"). In denying registration of any mark that "disparages" any group or institution, but not those that praise them, Section 2(a) engages in classic viewpoint discrimination.

This case exemplifies the expressive nature of trademarks denied registration under Section 2(a) of the Lanham Act—and the power of the viewpoints they can express. While some use the word "slant" to degrade, others—such as Respondent Simon Tam and his band—use the term as a means of empowerment. Reappropriation of terms often used negatively is a powerful tool employed by numerous social justice movements to neutralize offensive words and take ownership of their own stories and

language. [6] Reappropriation by its very nature involves strategic use of a disparaging word in the hope that, over time, the word may lose its negative power, at least in certain contexts. A robust debate may exist within the very community that is the target of a disparaging term over whether reappropriation is possible, desirable, or effective, and individuals who attempt such reappropriation may find themselves holding a minority viewpoint within their own community. *See* Brief for Asian Americans Advancing Justice et al. as *Amici Curiae* In Support of Neither Party ("AAJC Brief") at 13 (arguing that "'reclamation' only makes sense because 'slants' has a disparaging meaning in reference to Asian Americans *now*"). The affected community, or society at large, may eventually come to accept that certain uses of disparaging terms are socially acceptable, but that acceptability can rest on

---

[6] *See* Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark Law After* Lawrence v. Texas, 9 Marq. Intell. Prop. L. Rev. 187, 191 n.18 (2005) ("Although 'queer' has historically denigrated homosexuals, it has evolved . . . to reflect the recent renunciation of its negative uses and the reclamation of the term by sexual minorities.") (citation omitted). Reappropriation is a process that the PTO has itself recognized in certain instances, albeit inconsistently. *See, e.g.*, DYKES ON BIKES, Registration No. 3323803 (initially rejected on the ground that the term "dyke" was considered vulgar, offensive, or disparaging but later accepted for registration after the trademark holder submitted evidence that the term "dyke" can be used as a source of pride and identity for the LGBT community). *But see In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008) (rejecting the proposed trademark "Heeb" as used for a magazine that focuses on Jewish culture and is marketed to young Jewish people).

complex distinctions including the identity of the speaker, the intent of the speech, and the context in which it is made.[7]

---

[7] The brief of *amici curiae* Asian Americans Advancing Justice et al., argues that "the Lanham Act is not pro-speech," and that "[b]y expanding the exclusive nature of a trademark, federal registration of marks actually inhibits speech by *precluding* their use by anyone else." AAJC Brief at 11; *see also* Brief of Amanda Blackhorse et al., as *Amici Curiae* In Support of Petitioner at 9–12. *Amici* recognize that the Lanham Act is itself a restriction on speech, and that exclusive intellectual property rights may prevent others from using expressive marks in certain circumstances. But it does not follow that viewpoint discrimination creates no constitutional problem because a denial leaves more speakers free to use the mark. As the government points out, denial of registration *does not* leave others free to use the mark. *See* Pet'r's Br. 19–21. But even if it did, benefits to other speakers do not justify viewpoint discrimination against disfavored speakers. *See Rosenberger*, 515 U.S. at 835 (explaining that scarcity of funds to allocate among speakers did not excuse viewpoint discrimination in the allocation).

Nor should trademark registration "freez[e] pejorative meanings in place and remov[e] derogatory terms from communal debate and actual control by the groups targeted by a disparaging mark," even if the registration is granted to an entity that is not a member of the disparaged group. AAJC Brief at 11. A person with a registered mark may not prevent others from engaging in criticism or political advocacy related to the mark, including a boycott of the marked product. Furthermore, trademark law contains protections that ensure registration does not serve as a stranglehold on critical speech *containing* registered marks. The Lanham Act provides a fair use defense to dilution liability for marks that serve as parody, criticism, or commentary, for news reporting and commentary, and for noncommercial use of marks. 15 U.S.C. § 1125(c)(3). The cure for the pressures that an intellectual property regime places on speech lies in protecting ample breathing room for the

It cannot be the government's role to distribute official benefits on the basis of evaluations of such highly subjective inquiries as whether a trademark applicant's intended use of a particular mark adequately eliminates its offensiveness. Indeed, attempts to determine whether an applicant has "successfully" reappropriated a word raise the specter of speaker-based discrimination, in which the government allocates the benefits of trademark registration on the basis of the speaker's perceived identity or status within a particular community.

In this case, the PTO predicated its rejection of Respondent's trademark in part on the mark's relation to Mr. Tam's race. *See* J.A. 36 ("the association of the term SLANTS with those of Asian descent is evidenced by how the applicant uses the mark—as the name of an all Asian-American band"). At the same time, the PTO has registered many other marks using "slant" or variations thereof. *See, e.g.*, "Slant," Registration No. 3,437,230 (serving-ware for food); and former Registration Nos. 2,163,769 (art and graphic design services); 2,081,228 (education services); 1,511,492 (insecticides) (all later cancelled for reasons unrelated to disparagement). Here, the speaker's identity was an explicit factor used by the PTO in determining the registrability of the mark. Like viewpoint discrimination, this form of speaker-based

---

fair use of registered trademarks. The cure is not—and cannot be—a free-floating rule that mandates the provision of substantial government benefits only to those who hold right-thinking viewpoints or use government-approved words.

discrimination is impermissible under the First Amendment. *See Rosenberger*, 515 U.S. at 828 ("In the realm of private speech or expression, government regulation may not favor one speaker over another.").

The government offers virtually no support for its contention that the ban on "disparaging" marks is viewpoint-neutral. Pet'r's Br. 43–48. It suggests that laws against "libel, threats, or 'fighting words' likewise distinguish in a general way between speech that is critical or hostile and speech that is complimentary or conciliatory." *Id.* at 44–45. But these are categories of *unprotected* speech; they hardly stand for the proposition that the government can regulate *protected* speech on the basis of whether it offends. *See Johnson*, 491 U.S. at 416–17 (striking down conviction for flag desecration, defined as an act that would "seriously offend" observers). If the refusal to fund "religious activity" is viewpoint discrimination because it singles out religious perspectives, *Rosenberger*, 515 U.S. at 832, then surely a refusal to register marks that "disparage" particular individuals, institutions, beliefs, or national symbols also discriminates on the basis of viewpoint.

II. SECTION 2(A) OF THE LANHAM ACT PLACES AN UNCONSTITUTIONAL CONDITION ON THE RECEIPT OF VALUABLE GOVERNMENT BENEFITS.

The government's principal defense of Section 2(a) is that it does not restrict speech because it merely denies a government benefit, and leaves Respondent free to use the term "Slants" without the

protections trademark registration provides. This argument fails, however, because the prohibition on viewpoint discrimination extends not only to the direct prohibition of speech, but also to conditions on the distribution of government benefits. The only exception to this rule is when the government itself is speaking, and the Lanham Act is a regulation of private speech, not a form of government speech.

A. The Government May Not Discriminate On The Basis Of Viewpoint In Allocating Government Benefits To Private Speech.

The Court has long recognized that the government cannot violate speech rights through the discriminatory allocation of government support. Viewpoint discrimination is prohibited not only when the government punishes speech outright, but also when it distributes benefits to private speech, *Velazquez*, 531 U.S. at 547–49, or regulates access to a public or nonpublic forum, *Good News Club*, 533 U.S. at 107.

For this reason, a public university may not discriminate in allocating funds to student groups on the basis of a group's viewpoint. *See Rosenberger*, 515 U.S. at 835. And on similar grounds, the Court invalidated a restriction on government-funded legal services lawyers that imposed a viewpoint restriction, barring funded lawyers from challenging the constitutionality of welfare legislation. *See Velazquez*, 531 U.S. at 548–49.

The Court has long rejected the argument that when the government is merely distributing benefits

rather than imposing criminal penalties, it is free to discriminate on the basis of private speakers' viewpoints. *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2330–32 (2013) (invalidating condition on private speech attached to federal funding of AIDS prevention); *Speiser v. Randall*, 357 U.S. 513, 518 (1958) ("[t]o deny [a benefit] to claimants who engage in certain forms of speech is in effect to penalize them for such speech"). In particular, the government may not use a subsidy to seek to control private expression by discriminating against disfavored viewpoints.

Indeed, the cases the government relies on underscore the point. The government cites *Regan v. Taxation With Representation of Washington*, 461 U.S. 540 (1983), in which the Court upheld a federal statute that limited certain tax benefits to the non-lobbying activities of charitable organizations. As the Court later explained in *Rosenberger*, 515 U.S. at 834, the validity of that program turned on the fact that it was viewpoint-neutral. There can be little doubt that if the statute had barred tax benefits to lobbyists whose views the IRS found "disparaging," it would have been unconstitutional. Similarly, had the payroll-deduction mechanisms upheld in *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177 (2007), and *Ysursa v. Pocatello Educ. Ass'n*, 555 U.S. 353 (2009), limited unions' use of dues for political activities only when a state official deemed those activities "non-disparaging" of any "person, institution, belief, or national symbol," they, too, would have been invalid as viewpoint discrimination. The government's examples only underscore the critical mandate of viewpoint neutrality, one that Section 2(a) contravenes on its face.

Thus, the government's oft-repeated assertion that it is simply distributing benefits, and not restricting speech, Pet'r's Br. *passim*, is unavailing where, as here, it discriminates on the basis of viewpoint in supporting private speech. If that argument were sufficient to uphold this scheme, then the First Amendment would also permit the government to distribute copyright protections based on a government official's assessment of whether the work in question was "disparaging," "immoral," or "scandalous." It does not; trademark is the only intellectual property regime where such viewpoint-discriminatory rules persist.

B. Section 2(a)'s Viewpoint Discrimination Is Not Permissible As A Form Of Government Speech Or Because It Regulates A Government Program.

The only exception to the rule against viewpoint discrimination in support of speech concerns programs where the government funds private parties to spread its own message. In *Rust v. Sullivan*, the government was permitted to condition eligibility for Title X funds on recipients agreeing not to use those funds to advocate abortion because the program was a government speech program. 500 U.S. 173, 193 (1991). As the Court later explained in *Rosenberger*, in the Title X program at issue in *Rust*, "the government did not create a program to encourage private speech but instead used private speakers to transmit specific information pertaining to its own program." 515 U.S. at 833. The Court further noted that "when the government appropriates public funds to promote a particular

policy of its own it is entitled to say what it wishes." *Id.*

The government relies on these governnment speech cases to defend the Lanham Act. *See* Resp't's Br. 31–35. But Section 2(a) governs purely private speech, and in no way constitutes a government speech program. Trademarks are private speech, not government speech. This Court has set forth a test for determining whether speech belongs to a private speaker or the government; by every metric of that test, trademarks constitute private expression. *See Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2248–50 (2015). First, the government has never purported to convey a message through a trademark. *See In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 at *5 n.3 (1993) (rejecting the notion that registration constitutes the government's endorsement of the mark or the product to which it is affixed). Second, as any consumer who has purchased plastic bricks from Legos,[8] tissues from Kleenex,[9] or chocolate bars from Hershey's [10] can vouch, the public identifies trademarks with the mark-holder or its product, and not with the government. Finally, the trademark registrant maintains final control over the mark's design or use; the PTO has no design role whatsoever, and plays no role in the mark's use for expressive purposes. Under no meaning of the term can "The Slants" be deemed government speech.

---

[8] Registration No. 4,395,578.

[9] Registration No. 4,715,059.

[10] Registration No. 4,529,672

Thus, Section 2(a) does not constitute the use of government funds for the purpose of furthering *government* speech, but instead grants benefits to private speakers who express viewpoints that government officials deem unobjectionable.

Nor does the fact that the government administers the registration program or publishes the Principal Register change the analysis. As the court below correctly found, the appropriate analogy for the Principal Register is not to the government-issued license plates at issue in *Walker*, 135 S. Ct. at 2239, but to government-issued parade permits or copyrights. In the latter contexts, the government's administrative actions do not give it leeway to discriminate against private speech. A holding otherwise would open the door to a flood of unconstitutional censorship in the name of avoiding government involvement with disfavored private speech.

The government's argument that any time it expends resources to administer a program it can impose viewpoint-based eligibility requirements would eviscerate existing First Amendment protections. *See* Pet'r's Br. 9. It would permit cities and towns to deny parade permits to groups whose messages they deem "disparaging" or otherwise offensive. *But see Forsyth Cty., Ga. v. Nationalist Movement*, 505 U.S. 123, 134–35 (1992) (striking down ordinance tying cost of protecting protestors to permit fee and thereby enabling city to charge controversial speakers more). It would authorize the Postmaster General to deny mailing privileges to "immoral" magazines. *But see Hannegan*, 327 U.S. at 159. It would allow government to mandate or

prohibit speech on any product it regulates, circumventing the tailoring rules of commercial speech doctrine. *But see Rubin v. Coors Brewing Co.*, 514 U.S. 476, 485 (1995) (regulation of alcohol labels by Bureau of Alcohol, Tobacco and Firearms did not permit government to prohibit truthful advertising on labels, despite the "social harm" caused thereby). And it would permit the IRS to deny tax benefits to those who lobby for politically unacceptable views. *But see Rosenberger*, 515 U.S. at 834 (explaining that limit on tax benefits for lobbying in *Regan* turned on its viewpoint neutrality). The government's administrative operation of a program does not permit it to regulate private speech on the basis of viewpoint.

III. SECTION 2(A) IS UNCONSTITUTIONALLY VAGUE AND LEADS TO ARBITRARY TRADEMARK DETERMINATIONS.

The invalidity of Section 2(a)'s viewpoint discriminatory standards is exacerbated by their vagueness. Where a content-based law is also vague, it creates an "obvious chilling effect." *Reno v. American Civil Liberties Union*, 521 U.S. 844, 871–72 (1997).[11]

---

[11] This Court has examined statutes that vest unbridled discretion to regulate speech under both the First Amendment and the Due Process Clause. "It is a basic principle of due process that an enactment is void for vagueness if its prohibitions are not clearly defined." *Grayned v. City of Rockford*, 408 U.S. 104, 108 (1972). The requirement of clarity is especially stringent when a law interferes with First Amendment rights. *See Keyishian v. Bd. of Regents*, 385 U.S. 589, 604 (1967). The Constitution requires the government to

Section 2(a) provides little guidance to the PTO as to the meaning of "disparaging," "scandalous," or "immoral," leading to a long line of arbitrary and contradictory decisions. The Trademark Manual of Examining Procedure ("TMEP") states that in evaluating whether a mark is disparaging, trademark examiners should consider the potential offensiveness of a mark to a "substantial composite" of the potentially offended group. TMEP § 1203.03(b). But the manual offers no further guidance as to how to identify such a "substantial composite," or how to determine whether that "substantial composite" considers the mark disparaging. It effectively requires the examiner first to hypothesize an audience and then to guess at the hypothetical audience's reaction to a particular term. The legislative history of the Lanham Act provides no further explanation. While it is sometimes the case that "[a] term that appears vague on its face may derive much meaningful content from the purpose of the Act, its factual background, and the statutory context," *Thomas v. Union Carbide Agric. Products Co.*, 473 U.S. 568, 593 (1985) (citation omitted), no such purpose, background, or context helps to clarify Section 2(a).

The lack of clear standards is exemplified by the PTO's long history of bizarre and contradictory decisions: The very same terms have been granted registration in one case and denied in another with no seeming continuity of logic. For example:

---

define restrictions on speech with clarity *both* to ensure procedural fairness and to avoid chilling speech.

- The PTO rejected "Wanker" for use on clothing,[12] but registered it for use on beer.[13]
- The PTO rejected "Titmouse" for use on computer cursor control devices, [14] but "TitmouseInc." is a registered mark used for animation production services.[15]
- The PTO rejected "Madonna" as a trademark for wine as scandalous, [16] but accepted a different "Madonna"—also for the sale of wine.[17]
- The PTO rejected "Pussy Power" as a mark for entertainment services, [18] but accepted "PussyPowerRevolution" for use on clothing.[19]
- The PTO rejected "Cocaine," for use on soft drinks,[20] but accepted it for use on clothing.[21]

---

[12] U.S. Trademark Application Serial No. 78,610,369 (filed Apr. 16, 2005). All of these examples were deemed barred by Section 2(a)'s prohibition on "immoral," "scandalous," or "disparaging" viewpoints.

[13] Registration No. 2,036,108.

[14] U.S. Trademark Application Serial No. 78,954,967 (filed Aug. 18, 2006).

[15] Registration No. 4,624,689.

[16] *In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938).

[17] Registration No. 3,545,635.

[18] U.S. Trademark Application Serial No. 77,387,209 (filed Feb. 2, 2008).

[19] Registration No. 4,507,246.

- The PTO rejected "The Complete A**hole's Guide To . . ." as a trademark for a series of books providing information relating to advice, counseling, self-help, and humor, [22] but it deemed acceptable "Managing Your Inner A**hole," for books on the development of emotional intelligence.[23]

- The PTO rejected "Messias" for wine and brandy, [24] but granted registration to "Il Messia" for wine.[25]

In light of this decisional patchwork, no trademark applicant can ever be on notice as to what words or ideas will trigger PTO rejection—much less revocation decades later. The PTO's sole limiting principle in applying Section 2(a) requires an examining attorney who believes a pending trademark is scandalous or immoral to "consult with his or her supervisor" if she believes, "for whatever reason, that a mark may be considered to comprise such matter," in order to "ensure consistency in examination with respect to immoral or scandalous

---

[20] U.S. Trademark Application Serial No. 78,829,207 (filed March 3, 2006).

[21] Registration No. 1,340,874.

[22] U.S. Trademark Application Serial No. 76,351,811 (filed December 21, 2001).

[23] U.S. Trademark Application Serial No. 85,711,056 (filed August 23, 2012) (not registered on other grounds).

[24] *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. 275 (T.T.A.B. 1968).

[25] Registration No. 4,093,035.

matter." TMEP § 1203.01. The disparagement clause lacks even this regulatory attempt at consistency. And this procedural step ultimately fails to ensure that the PTO applies Section 2(a)'s standards consistently, as the examples cited above demonstrate. The only consistent result of the application of the disparagement clause is inconsistency.

Furthermore, the PTO's perpetual ability to revisit the offensiveness of existing trademarks greatly exacerbates the problems of insufficient notice and chilling effect. Applicants not only have to guess what the PTO may find scandalous, immoral, or disparaging today, but also what it may find objectionable years from now—long after substantial resources have been invested in establishing a recognizable mark. Those who wish to register an expressive mark must therefore make their best guess about how to survive the timeless gauntlet of Section 2(a)'s moral judgment—by self-censoring.

What may be deemed acceptable today may become disparaging tomorrow, depending on the PTO's perception of changing social mores, or indeed based on a change in the government's viewpoint itself. As such, Section 2(a) is impermissibly vague and grants government power to regulate without sufficient guidance, resulting in inconsistent and unconstitutional administrative action.

IV. HOLDING THAT SECTION 2(A) IS FACIALLY UNCONSTITUTIONAL WOULD NOT SIGNIFICANTLY ALTER THE LANDSCAPE OF TRADEMARK LAW AND WOULD BRING TRADEMARK IN LINE WITH COPYRIGHT.

A finding of unconstitutionality in this case requires only a narrow remedy that will not create upheaval in existing trademark law. In fact, striking down the disparagement clause will bring trademark law more closely in line with copyright and patent law, both of which secure intellectual property rights without making *ad hoc* moral judgments about the acceptability of viewpoints that private speakers express.

As the copyright regime demonstrates, offensive ideas promulgated by private individuals are not incompatible with a sound system of regulating intellectual property. To the contrary, other intellectual property regimes rightly refuse to draw viewpoint- or content-based distinctions. "Congress has enacted two statutory copyright restrictions that were arguably content based, but afterwards repealed them." *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 855 n.4 (5th Cir. 1979); *see also, e.g., Ex parte Murphy*, 200 U.S.P.Q. (BNA) 801, 802–03 (1977) (reversing the morality-based rejection of a patent for a slot machine). "The gravity and immensity of the problems, theological, philosophical, economic and scientific, that would confront a court" asked to determine whether or not a given expression is worthy of copyright protection would be "staggering to contemplate." *Belcher v. Tarbox*, 486 F.2d 1087, 1088 (9th Cir. 1973). In

requiring government officers to make necessarily subjective judgments about the acceptability of private viewpoints. Section 2(a)'s regulation of trademarks is a clear outlier. *See Mitchell Bros.*, 604 F.2d at 855 n.4; *Belcher*, 486 F.2d at 1088.

While many copyrighted works are undoubtedly offensive or disparaging to some subset of society, the government wisely refrains from selectively offering the benefit of copyright protection based on viewpoint, and instead leaves such judgments to the marketplace of ideas. *See Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (Holmes, J.) (declining to become the "final judges of the worth of" any particular expressions, instead entrusting that decision to the public marketplace).

Trademark registration should be treated the same way. Instead of wading into what society does or does not deem acceptable at a given moment in history, the government should allow movements led by artists and activists like The Slants to run their course, and for those who disagree with a trademark's message—whether of disparagement or attempted reappropriation—to express that disagreement through protected expression of their own.

CONCLUSION

For the reasons stated above, this Court should hold that the portion of Section 2(a) barring the registration of disparaging marks is unconstitutional.

Respectfully submitted,

Lee Rowland
Counsel of Record
Esha Bhandari
Vera Eidelman
AMERICAN CIVIL LIBERTIES UNION FOUNDATION
125 Broad Street
New York, NY 10004
(212) 549-2500
lrowland@aclu.org

David Cole
AMERICAN CIVIL LIBERTIES UNION FOUNDATION
915 15th St., NW
Washington, DC 20005

Arthur B. Spitzer
Scott Michelman
AMERICAN CIVIL LIBERTIES UNION OF THE NATION'S CAPITAL
4301 Connecticut Avenue
Washington, D.C. 20008

Mathew W. dos Santos
AMERICAN CIVIL LIBERTIES
UNION FOUNDATION OF
OREGON
P.O. Box 40585
Portland, OR 97240

Dated: December 16, 2016

RECORD AND BRIEFS

FILED
NOV 18 2016
OFFICE OF THE CLERK

No. 15-1293

IN THE
Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,
Petitioner,

v.

SIMON SHIAO TAM,
Respondent.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

BRIEF FOR AMICUS CURIAE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION SUPPORTING NEITHER PARTY

MARK L. WHITAKER
PRESIDENT
AMERICAN
INTELLECTUAL
PROPERTY LAW
ASSOCIATION
241 18th Street South
Suite 700
Arlington, VA 22202
(703) 415-0780

PAUL M. SMITH
Counsel of Record
JENNER & BLOCK LLP
1099 New York Ave., NW
Suite 900
Washington, DC 20001
(202) 639-6000
psmith@jenner.com

Counsel for Amicus Curiae

TABLE OF CONTENTS

TABLE OF AUTHORITIES ii

INTEREST OF AMICUS 1

SUMMARY OF ARGUMENT 2

ARGUMENT 4

I. Federal Registration Provides Important Procedural and Substantive Benefits Affecting the Enforceability and Geographic Scope of Trademarks. 4

II. The Anti-Disparagement Rule is Unconstitutionally Vague. 7

III. The Anti-Disparagement Rule Is Unconstitutional as Applied to Trademarks That, Like the One at Issue Here, Are Intended to Convey Political Messages. 12

CONCLUSION 16

TABLE OF AUTHORITIES

CASES

Agency for International Development v. Alliance for Open Society International, Inc., 133 S. Ct. 2321 (2013) 5

B&B Hardware, Inc. v. Hargis Industries, Inc., 135 S. Ct. 1293 (2015) 5, 6

Dombrowski v. Pfister, 380 U.S. 479 (1965) 9

Dudley v. HealthSource Chiropractic Inc., 883 F. Supp. 2d 377 (W.D.N.Y. 2012) 6

FCC v. Fox Television Stations, Inc., 132 S. Ct. 2307 (2012) 7, 8

In re Geller, 751 F.3d 1355 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 944 (2015) 11

Grayned v. City of Rockford, 408 U.S. 104 (1972) 8

In re Heeb Media, LLC, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008) 11

In re In Over Our Heads Inc., 16 U.S.P.Q.2d 1653 (T.T.A.B. 1990) 9

Legal Services Corp. v. Velazquez, 531 U.S. 533 (2001) 5

Perry v. Sindermann, 408 U.S. 593 (1972) 4-5

Reno v. ACLU, 521 U.S. 844 (1997) 7

In re Squaw Valley Development Co., 80 U.S.P.Q.2d 1264 (T.T.A.B. 2006) 11

Texas v. Johnson, 491 U.S. 397 (1989) 14

Thrifty Rent-A-Car System, Inc. v. Thrift Cars, Inc., 831 F.2d 1177 (1st Cir. 1987) 6

Tinker v. Des Moines Independent Community School District, 393 U.S. 503 (1969) 15

Value House v. Phillips Mercantile Co., 523 F.2d 424 (10th Cir. 1975) 6

Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc., 455 U.S. 489 (1982) 7-8

STATUTES

15 U.S.C. § 1052(a) 2, 4, 8

OTHER AUTHORITIES

Trademark Clearinghouse at http://www.trademark-clearinghouse.com 6

Trademark Manual of Examining Procedure § 1203.03(b)(i) (Oct. 2016 ed.) 10

Uniform Domain-Name Dispute Resolution Policy at https://www.icann.org/resources/pages/policy-2012-02-25-en 6

INTEREST OF AMICUS

The American Intellectual Property Law Association ("AIPLA") is a national bar association of approximately 14,000 members who are primarily lawyers engaged in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property, and our mission includes providing courts with objective analysis to promote an intellectual property system that stimulates and rewards invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.[1]

---

[1] In accordance with Supreme Court Rule 37.6, amicus curiae states that this brief was not authored, in whole or in part, by counsel to a party, and that no monetary contribution to the preparation or submission of this brief was made by any person or entity other than the amicus curiae or its counsel. Specifically, after reasonable investigation, AIPLA believes that (i) no member of its Board or Amicus Committee who voted to file this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation in this matter, (ii) no representative of any party to this litigation participated in the authorship of this brief, and (iii) no one other than AIPLA, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

AIPLA has no stake in any of the parties to this litigation or in the result of this case other than its interest in seeking the correct and consistent interpretation of the law as it relates to intellectual property issues.[2]

SUMMARY OF ARGUMENT

The United States Patent and Trademark Office (PTO) interpreted Section 2(a) of the Lanham Act as barring registration of respondent's trademark "The Slants" for a rock band, concluding that the mark "may disparage ... persons, living or dead, institutions, beliefs, or national symbols." under 15 U.S.C. § 1052(a). The language of this statutory provision is demonstrably unconstitutional as vague under the 5th Amendment, and its application in this case also ran afoul of the First Amendment. Although a denial of registration is not a form of direct censorship, it still constitutes the denial of an important benefit conferring valuable rights. A rule barring access to that benefit based on the message conveyed by a given trademark requires heightened constitutional scrutiny. The government cannot show that the burden imposed here on respondent's speech passes the requisite scrutiny.

First, as to vagueness, when a regulation impinges on free speech, the usual due process requirements of

---

[2] In accordance with Supreme Court Rule 37.3(a), both Petitioner and Respondent have filed letters with the Clerk consenting to the filing of all amicus briefs.

clarity in the law are applied with extra stringency. Here, Section 2(a) provides would-be registrants with very little concrete guidance about which trademarks the PTO will register and which it will refuse to register. The PTO has acknowledged this, attempting to provide trademark examiners with more guidance in the manual governing their work. But that effort only serves to create more confusion.

In some situations, a vague law can become sufficiently clear through case-by-case adjudications. But here, a review of prior decisions by the PTO only serves to confirm that the anti-disparagement rule is extremely vague. A long list of contradictory rulings make clear that the officials called upon to administer this rule have no more idea than anyone else about what constitutes a trademark that "may disparage." Such a law cannot continue to be used to regulate speech absent some substantial new clarification.

Second, even if this Court were to conclude that the anti-disparagement rule is sufficiently clear, the application of that rule in this case violated the First Amendment. As Judge Dyk noted in his concurrence below, respondent clearly chose to call his band "The Slants" in order to make a statement about racism against Asian Americans and to "reclaim" a derogatory term. That kind of usage of a trademark constitutes core protected speech under the First Amendment. And it is well-established that the government has no right to penalize that kind of speech based on a determination that it "may disparage." To the contrary, offensive and controversial speech is often the most effective way for a person to participate in a

political dialogue. Thus, although there may be some types of disparaging marks that can be denied registration without running afoul of the First Amendment, this is not such a case.

ARGUMENT

I. Federal Registration Provides Important Procedural and Substantive Benefits Affecting the Enforceability and Geographic Scope of Trademarks.

Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), provides that the PTO must refuse registration of trademarks that "may disparage ... persons, living or dead, institutions, beliefs, or national symbols." In so doing, the Act does not prevent anyone from using such a mark. But it does deny the benefits of trademark registration, which are considerable.

This is, therefore, not a case about direct censorship of speech. However, that is not the end of the First Amendment analysis. As this Court has made clear in numerous cases, the unconstitutional conditions doctrine limits the ability of the law to condition an important governmental benefit on the recipient's willingness to give up the exercise of a constitutional right. "For if the government could deny a benefit to a person because of his constitutionally protected speech or associations, his exercise of those freedoms would in effect be penalized and inhibited." *Perry v.*

Sindermann, 408 U.S. 593, 597 (1972); *see Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 545 (2001).[3]

The anti-disparagement rule in the Lanham Act does just that by depriving a business that selects a "disparaging" trademark of the important benefit of registration. Thus, although the government does not seek to prohibit the use of "disparaging" marks directly, the Act creates an incentive for private parties to conform their speech to the government's preferred standards.

That incentive is a powerful one. As this Court noted in *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 1310 (2015), the "benefits of [trademark] registration are substantial." The Court explained:

> The Lanham Act confers "important legal rights and benefits" on trademark owners who register their marks. 3 McCarthy § 19:3, at 19-21 see also *id.*, § 19:9, at 19-34 (listing seven of the

---

[3] To be sure, this Court has said that the government may impose "conditions that define the limits of the [g]overnment spending program [and] those that specify the activities Congress wants to subsidize[.]" *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2323 (2013). But it has distinguished that situation from conditions that seek to use the power of a conditional benefit to "regulate speech outside the contours of the federal program itself." *Id.* The government attempts to wedge this case into the former category, Pet. 16-19, but that effort is unpersuasive. There can be little doubt that the effects of the rule at issue here go beyond defining the limits of a government program by creating powerful incentives to use trademarks that meet the government's standards of propriety.

> "procedural and substantive legal advantages" of registration). Registration, for instance, serves as "constructive notice of the registrant's claim of ownership" of the mark. 15 U.S.C. § 1072. It also is "prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate." § 1057(b). And once a mark has been registered for five years, it can become "incontestable." §§ 1065, 1115(b).

Id. at 1300; *see also* Pet. App. 4a-5a (Federal Circuit majority's discussion of the many valuable rights associated with registration). A federal registration is also a threshold requirement for using the UDRP and Trademark Clearinghouse tools to thwart infringing domain names.[4] Without the benefits of federal trademark registration, owners of unregistered marks may be unable to challenge others' use of confusingly similar marks in a different geographic area. *See, e.g., Thrifty Rent-A-Car Sys., Inc. v. Thrift Cars, Inc.*, 831 F.2d 1177 (1st Cir. 1987); *Value House v. Phillips Mercantile Co.*, 523 F.2d 424 (10th Cir. 1975); *Dudley v. HealthSource Chiropractic Inc.*, 883 F. Supp. 2d 377 (W.D.N.Y. 2012).

---

[4] *See* Uniform Domain-Name Dispute Resolution Policy at https://www.icann.org/resources/pages/policy-2012-02-25-en, and Trademark Clearinghouse at http://www.trademark-clearinghouse.com.

For these reasons and others, the PTO's refusal to register a trademark can be very harmful commercially. That potential for harm provides a powerful incentive for businesses to avoid selecting marks that they cannot register. Put differently, a content-based restriction on registration of trademarks can have a substantial coercive effect, pushing businesses to avoid trademarks that have even the potential for being denied registration. Accordingly, any such restriction must be clearly stated and uniformly applied.

II. The Anti-Disparagement Rule is Unconstitutionally Vague.

As Judge O'Malley laid out in her concurrence below, Pet. App. 68a-80a, the anti-disparagement rule in Section 2(a) is unconstitutionally vague in violation of the Due Process Clause of the Fifth Amendment.

This Court has previously recognized that "[the] requirement of clarity in regulation is essential to the protections provided by the Due Process Clause of the Fifth Amendment[,]" which "requires the invalidation of laws that are impermissibly vague." *FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012). When, as in this case, content-based restrictions on speech are involved, "vagueness ... raises special First Amendment concerns because of its obvious chilling effect on free speech." *Reno v. ACLU*, 521 U.S. 844, 871-72 (1997). If the vagueness of such a statute or regulation "threatens to inhibit the exercise of constitutionally protected rights ... a more stringent vagueness test should apply." *Village of Hoffman*

Estates v. Flipside, Hoffman Estates, Inc., 455 U.S. 489, 499 (1982).

A statute or regulation is impermissibly vague when it "fails to provide a person of ordinary intelligence fair notice of what is prohibited, or is so standardless that it authorizes or encourages seriously discriminatory enforcement." *FCC*, 132 S. Ct. at 2317 (quoting *United States v. Williams*, 553 U.S. 285, 304 (2008)); *see also Grayned v. City of Rockford*, 408 U.S. 104, 108-09 (1972) (to survive a vagueness challenge, a statute must "give the person of ordinary intelligence a reasonable opportunity to know what is prohibited" and "provide explicit standards for those who apply [it]" to prevent "arbitrary and discriminatory enforcement").

The anti-disparagement rule in Section 2(a) has both of these flaws. Its provisions are unclear and require subjective interpretation, and its application is often inconsistent.[5]

Section 2(a) provides that an applicant for trademark protection shall be denied the benefits of registration if the mark "[c]onsists of or comprises ... matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute[.]" 15 U.S.C. § 1052(a). The text of the statute provides little guidance to applicants or the PTO as to the meaning of the term "disparage."

---

[5] To be clear, AIPLA's argument that Section 2(a) is unconstitutionally vague extends only to the portion of the statute dealing with denial of registration to disparaging marks, and the associated PTO interpretations of that provision.

And an additional layer of uncertainty is added by the fact that Congress said it was enough if the mark "may" disparage someone. The PTO itself has admitted that the guidelines for determining whether a mark is disparaging are "somewhat vague" and "necessarily ... highly subjective[.]" *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d 1653, 1654 (T.T.A.B. 1990) (quotation marks omitted).

The inherent subjectivity required to implement Section 2(a) results in a high degree of uncertainty for both applicants and the PTO, hampering the development and implementation of a consistently applicable standard. The ambiguous text of Section 2(a) fails a vagueness test of any standard, stringent or otherwise.

When the language of a statute lacks the necessary clarity to satisfy the requirements of due process, "[t]he area of proscribed conduct will be adequately defined and the deterrent effect of the statute contained within constitutional limits only by authoritative constructions sufficiently illuminating the contours of an otherwise vague prohibition." *Dombrowski v. Pfister*, 380 U.S. 479, 490–91 (1965). The PTO has attempted to assist examiners in applying Section 2(a) by setting forth in the Trademark Manual of Examining Procedure a two-part test for determining whether a mark is unregistrable because it is disparaging:

> (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other

> elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
>
> (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

Trademark Manual of Exam. Proc. ("TMEP") §1203.03(b)(i) (Oct. 2016 ed.) (citing, *inter alia*, *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 944 (2015); *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705, 1740-41 (T.T.A.B. 1999)).

But this two-part test, even if it were set forth in an authoritative interpretive regulation rather than a manual for examiners, would fail to add clarity to the statute's provisions; rather, by introducing additional vague and subjective terms, the PTO has exacerbated the existing ambiguity of Section 2(a). For example, the term "substantial composite" has never been clearly defined by the PTO, other than a declaration that it is "not necessarily a majority" — a definition that provides little guidance to applicants and examiners. TMEP §1203.03(b)(i) (Oct. 2016 ed.).

As for interpretations in adjudications, the PTO has said, for example, that a mark is disparaging under Section 2(a) when it "dishonor[s] by comparison with what is inferior, slight[s], deprecate[s], degrade[s], or affect[s] or injure[s] by unjust comparison." Pet. App. 70a (O'Malley, J., concurring) (brackets in original)

(quoting *Pro–Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 124 (D.D.C. 2003), which in turn quoted *Harjo v. Pro-Football, Inc.*, 50 U.S.PQ. 2d 1705, 1737 n.98 (T.T.A.B. 1999)). But such descriptions of the rule leave open a wide range of doubt about how the rule applies in a given case.

Moreover, as noted by the majority below, the PTO's record of grants and denials of trademark protection "often appears arbitrary and is rife with inconsistency[.]" Pet. App. 33a n.7. The vagueness inherent in the statutory language is further underscored by the numerous examples of inconsistent and contradictory application of Section 2(a)'s disparagement provision. The PTO, for example, denied registration to the mark HAVE YOU HEARD SATAN IS A REPUBLICAN but registered the mark THE DEVIL IS A DEMOCRAT. Pet. App. 71a & n.1 (O'Malley, J., concurring). In 2014, the PTO denied registration to the mark STOP THE ISLAMIZATION OF AMERICA for use in "[p]roviding information regarding understanding and preventing terrorism," *In re Geller*, 751 F.3d 1355, 1357 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 944 (2015), but in 2015, registration was granted to the mark STOP ISLAMIZATION OF AMERICA, Registration Serial No. 86857969, for the same purpose.[6]

---

[6] Additional examples of inconsistent application of Section 2(a)'s disparagement standard are numerous. *See, e.g., In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264 (T.T.A.B. 2006) (denying registration of marks "SQUAW" and "SQUAW ONE" for clothing and retail services, but accepting registration for ski equipment); *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008)

Results like these suggest that the outcome of a disparagement analysis under Section 2(a) is extremely unpredictable. The statute, PTO guidelines, and previous decisions by the T.T.A.B. all fail to provide the general public with the required notice of what marks are barred from registration for disparagement under Section 2(a), and, as shown above, have led to repeated instances of arbitrary and inconsistent enforcement.

The vague rule at issue here may not be as constitutionally serious as a vague criminal prohibition. But the requirement of precision in the regulation of speech should apply in this context as well, where an important commercial and expressive right is at stake.

III. The Anti-Disparagement Rule Is Unconstitutional as Applied to Trademarks That, Like the One at Issue Here, Are Intended to Convey Political Messages.

Even if the Court were to conclude that the anti-disparagement rule is sufficiently clear to pass constitutional muster, there is a second constitutional problem here. Because of the nature of the speech and message involved, this application of the anti-disparagement rule is a clear violation of the First Amendment, as Judge Dyk reasoned in his concurrence below, Pet. App. 80a-90a. It may well be that there are some applications of the rule that are valid under the First Amendment, particularly where the trademark at issue is purely commercial in nature and is using a racist or similarly disparaging term simply to help sell a

---

(denying registration to the mark "HEEB" for clothing, despite 2004 registration of same mark for magazines).

product. But as applied to The Slants, the anti-disparagement rule punishes core protected speech based on its content.

As the Federal Circuit recognized, respondent Tam "named his band The Slants to 'reclaim' and 'take ownership' of Asian stereotypes.... With their lyrics, performances, and band name, Mr. Tam and his band weigh in on cultural and political discussions about race and society that are within the heartland of speech protected by the First Amendment." Pet. App. 10a.

The government in its Petition for Certiorari disputes this characterization, arguing that the "trademark-registration program operates exclusively in the sphere of commercial speech." Pet. 20. But the facts of this case are a powerful refutation of that claim. Far from being just a commercial identifier like Chevrolet or Chrysler, the name of respondent's band makes a clear statement about the racism experienced by Asian-Americans and about the band's determination to overcome stereotypical assumptions. Indeed, it is the sad history of people using the word "slant" to disparage Asians — the very history that motivated the Patent and Trademark Office to deny registration — that simultaneously animates the political message the band is seeking to communicate. Put differently, this case is a prime example of the principle articulated by Judge Dyk in his concurrence — that when you are dealing with core political speech, it is often speech that some would deem highly offensive that is the most effective and important. Pet. App. 82a-83a (citing *Texas v. Johnson*, 491 U.S. 397,

408-09 (1989), which recognized that flag burning is protected expression).

Where, as here, the government sets up a system for drawing distinctions among various forms of expression based on their content, it cannot justify a given *application* of the system that burdens core First Amendment expression by arguing that most of the rest of the applications involve only purely commercial speech. An as-applied challenge remains available to test whether the particular application of the law meets First Amendment standards.[7]

In *Texas v. Johnson*, for example, the Court noted that the government had every right to regulate the proper treatment and disposal of the American flag. But it held that the First Amendment provided protection in those cases where a law is applied to punish flag desecration undertaken for expressive purposes. *Texas v. Johnson*, 491 U.S. 397, 418 (1989) ("To say that the government has an interest in encouraging proper treatment of the flag, however, is

---

[7] The rule is different when the government is regulating a form of *conduct* that, in a given instance, has been undertaken for an expressive purpose. In that context, only lenient First Amendment scrutiny applies if the government can show that its reasons for regulating the conduct are "unrelated to the suppression of free expression." *Texas v. Johnson*, 491 U.S. 397, 407 (1989) (quoting *United States v. O'Brien*, 391 U.S. 367, 377 (1968)). But here, where the government is selectively benefiting and penalizing pure speech based on its content, that more lenient standard would not apply to an as-applied challenge, regardless of whether the majority of other applications of the law are or are not constitutional.

not to say that it may criminally punish a person for burning a flag as a means of political protest.")

Similarly, while public school administrators have considerable leeway to regulate the clothing students wear to school, such regulations may not avoid constitutional scrutiny when facially neutral clothing rules punish students for wearing clothing, like an arm band, intended to convey a political message. *See Tinker v. Des Moines Indep. Cmty. Sch. Dist.*, 393 U.S. 503 (1969).

Given that the anti-disparagement rule has been applied in this case to punish core protected speech, strict constitutional scrutiny should apply. That means that the application of the rule at issue cannot be upheld unless the government can show that it is serving a compelling governmental interest in the least restrictive way. That standard clearly is not met in this case. To the contrary, whatever legitimacy the anti-disparagement rule may have when applied to purely commercial speech, there is no government interest that is legitimate, let alone compelling, in refusing to provide an important government benefit to the politically expressive trademark at issue here.

CONCLUSION

The Court should affirm the judgment below, ruling either that Section 2(a)'s non-disparagement requirement is unconstitutionally vague, or that it was unconstitutionally applied here.

Respectfully submitted,

MARK L. WHITAKER
PRESIDENT
AMERICAN
INTELLECTUAL
PROPERTY LAW
ASSOCIATION
241 18th Street South
Suite 700
Arlington, VA 22202
(703) 415-0780

PAUL M. SMITH
Counsel of Record
JENNER & BLOCK LLP
1099 New York Ave., NW
Suite 900
Washington, DC 20001
(202) 639-6000
psmith@jenner.com

RECORD AND BRIEF

FILED
DEC 16 2016

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR,
UNITED STATES PATENT AND TRADEMARK OFFICE,
PETITIONER

v.

SIMON SHIAO TAM

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF FOR THE AMERICAN JEWISH COMMITTEE AS AMICUS CURIAE SUPPORTING RESPONDENT

KANNON K. SHANMUGAM
Counsel of Record
ALLISON JONES RUSHING
WILLIAM T. MARKS
WILLIAMS & CONNOLLY LLP
725 Twelfth Street, N.W.
Washington, DC 20005
(202) 434-5000
kshanmugam@wc.com

TABLE OF CONTENTS

Page

Interest of amicus curiae 1

Summary of argument 2

Argument 5

The disparagement clause of Section 2(a) of the Lanham Act is subject to strict scrutiny 5

A. The government's interest in 'disassociating itself' from objectionable speech does not exempt Section 2(a)'s disparagement clause from strict scrutiny 5

1. Unless it is speaking, the government cannot discriminate against disfavored speech 6

2. The government does not speak through the trademark-registration regime 8

B. The government-subsidy exception does not exempt Section 2(a)'s disparagement clause from strict scrutiny 14

1. Trademark registration is not a 'subsidy' 15

2. A government subsidy cannot target disfavored viewpoints 17

3. Section 2(a)'s disparagement clause does not serve the goals of the Lanham Act 20

Conclusion 22

TABLE OF AUTHORITIES

Cases:

Abood v. *Detroit Board of Education*, 431 U.S. 209 (1977) 20

Agency for International Development v. *Alliance for Open Society International, Inc.*, 133 S. Ct. 2321 (2013) 5

Autor v. *Pritzker*, 740 F.3d 176 (D.C. Cir. 2014) 15

Brandenburg v. *Ohio*, 395 U.S. 444 (1969) 6

Page

Cases—continued:

Cornelius v. *NAACP Legal Defense & Educational Fund, Inc.*, 473 U.S. 788 (1985) 2
Davenport v. *Washington Education Ass'n*, 551 U.S. 177 (2007) 15, 16, 17, 20
ECCS, Inc., In re, 94 F.3d 1578 (Fed. Cir. 1996) 10
Good News Club v. *Milford Central School*, 533 U.S. 98 (2001) 7, 6
Harris v. *Quinn*, 134 S. Ct. 2618 (2014) 20
Hurley v. *Irish-American Gay, Lesbian, and Bisexual Group of Boston*, 515 U.S. 557 (1995) 16
Johanns v. *Livestock Marketing Ass'n*, 544 U.S. 550 (2005) 12
Kidd v. *Johnson*, 100 U.S. (10 Otto) 617 (1880) 9
Knox v. *Service Employees*, 132 S. Ct. 2277 (2012) 17
McCreary County v. *ACLU of Kentucky*, 545 U.S. 844 (2005) 7
Leathers v. *Medlock*, 499 U.S. 439 (1991) 18
Legal Services Corp. v. *Velazquez*, 531 U.S. 533 (2001) ..... *passim*
Lehnert v. *Ferris Faculty Ass'n*, 500 U.S. 507 (1991) 20
Moose Lodge No. 107 v. *Irvis*, 407 U.S. 163 (1972) 14
National Endowment for the Arts v. *Finley*, 524 U.S. 569 (1998) 15, 17, 18
National Socialist Party of America v. *Village of Skokie*, 432 U.S. 43 (1977) 6
Old Glory Condom Corp., In re, 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993) 11
Palazzolo v. *Rhode Island*, 533 U.S. 606 (2001) 16
Pleasant Grove City v. *Summum*, 555 U.S. 460 (2009) 2, 8, 13
Police Department of Chicago v. *Mosley*, 408 U.S. 92 (1972) 6
Reed v. *Town of Gilbert*, 135 S. Ct. 2218 (2015) 5
Regan v. *Taxation With Representation of Washington*, 461 U.S. 540 (1983) ..... *passim*

Page

Cases—continued:

Rosenberger v. *Rector & Visitors of University of Virginia*, 515 U.S. 819 (1995) 2, 7, 8, 13
Rust v. *Sullivan*, 500 U.S. 173 (1991) .....*passim*
Santa Fe Independent School District v. *Doe*, 530 U.S. 290 (2000) 7
Speiser v. *Randall*, 357 U.S. 513 (1958) 18
Texas v. *Johnson*, 491 U.S. 397 (1989) 6
Trade-Mark Cases, 100 U.S. (10 Otto) 82 (1879) 9, 15
United States v. *American Library Ass'n*, 539 U.S. 194 (2003) 17
United States v. *Stevens*, 559 U.S. 460 (2010) 6
Walker v. *Texas Division, Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015) .....*passim*
Widmar v. *Vincent*, 454 U.S. 263 (1981) 7
Ysursa v. *Pocatello Education Ass'n*, 555 U.S. 353 (2009) 15, 16, 17, 20

Constitution, statutes, and rule:

U.S. Const. Amend. I .....*passim*
Lanham Act, 15 U.S.C. 1051-1141n .....*passim*
15 U.S.C. 1051 15
15 U.S.C. 1051(a) 9
15 U.S.C. 1052(a) .....*passim*
15 U.S.C. 1057(b) 9
15 U.S.C. 1111 11
15 U.S.C. 1127 .....*passim*
17 U.S.C. 408 13
17 U.S.C. 409 13
17 U.S.C. 410 13
17 U.S.C. 410(a) 13
17 U.S.C. 411 13
17 U.S.C. 412 13
26 U.S.C. 501(c)(3) 20
S. Ct. R. 37.6 1

Page

Miscellaneous:

Randall P. Bezanson & William G. Buss, *The Many Faces of Government Speech*, 86 Iowa L. Rev. 1377 (2001) 13

General Inter-American Convention for Trade Mark and Commercial Protection, Feb. 20, 1929, 46 Stat. 2907, T.S. No. 833 21

Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents, 76th Cong., 1st Sess. (1939) 10

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th ed. 1996) 9, 10, 15

Paris Convention for the Protection of Intellectual Property, 25 Stat. 1372, Mar. 20, 1883 21

S. Rep. No. 1333, 79th Cong., 2d Sess. (1946) 10, 16

In the Supreme Court of the United States

No. 15-1293

MICHELLE K. LEE, DIRECTOR,
UNITED STATES PATENT AND TRADEMARK OFFICE,
PETITIONER

v.

SIMON SHIAO TAM

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF FOR THE AMERICAN JEWISH COMMITTEE AS AMICUS CURIAE SUPPORTING RESPONDENT

INTEREST OF AMICUS CURIAE

The American Jewish Committee (AJC) is a nonpartisan, nonprofit organization established in 1906 to protect the civil and religious rights of the Jewish people.[1]

[1] Pursuant to Rule 37.6, AJC affirms that no counsel for a party authored this brief in whole or in part; no such counsel or a party made a monetary contribution to fund its preparation or submission; and no person other than AJC, its members, or its counsel made such a monetary contribution. The parties have consented to the filing of this brief, and copies of their letters of consent are on file with the Clerk's Office.

More than 100 years later, AJC now has roughly 170,000 members and supporters, and 32 regional offices and representatives, spread across the Nation and throughout the world.

AJC's mission is to enhance the well-being of the Jewish people and to advance human rights and democratic values for all. AJC has a longstanding commitment to free speech, which it views as a basic human right. Accordingly, AJC has participated as an amicus curiae in many free speech cases before this Court. See, *e.g.*, *Pleasant Grove City* v. *Summum*, 555 U.S. 460 (2009); *Rosenberger* v. *Rector & Visitors of University of Virginia*, 515 U.S. 819 (1995); *Cornelius* v. *NAACP Legal Defense & Educational Fund, Inc.*, 473 U.S. 788 (1985). Through its Jacob Blaustein Institute for the Advancement of Human Rights, AJC has championed free speech in the United States, at the United Nations, and around the globe.

To ensure that speech can freely flourish in our Nation, AJC believes that courts must rigorously subject viewpoint- and content-based laws to strict scrutiny. At the same time, the government must have leeway to express its own viewpoints and to direct government subsidies in ways that further the government's policy goals. AJC submits this brief to help ensure that the proper balance is struck between those competing and important interests.

SUMMARY OF ARGUMENT

AJC agrees with respondent that this Court should apply strict scrutiny in determining whether the disparagement clause of Section 2(a) of the Lanham Act violates the First Amendment. That clause discriminates against speech based on viewpoint, which automatically triggers strict scrutiny. Petitioner contends that a re-

laxed standard of review is warranted because the government has an interest in distancing itself from offensive trademarks and because trademark registration amounts to a discretionary government subsidy. Petitioner is wrong on both counts.

A. The First Amendment contains no general exception that applies whenever the government wants to disassociate itself from offensive speech. The only time this Court has credited that interest is when the government itself was speaking. But the government does not speak through trademarks, trademark registrations, or published notices of registered marks.

Trademarks themselves constitute private speech, and registration does not alter that fact. The act of registration is not itself government speech, and Congress did not enact the Lanham Act to promote a government message about disparagement. What is more, the public does not associate registered trademarks with the government, nor could it reasonably do so: the Patent and Trademark Office has expressly disclaimed approval of the content of registered trademarks, and it registers countless marks that no reasonable person would think the government was endorsing. The government also has little control over the content of trademarks, aside from its initial decision whether or not to register the mark.

Petitioner errs in suggesting that government speech is at issue merely because, incident to trademark registration, the government will have to include a registered mark in various official documents. This Court has never expanded the government-speech doctrine to cases in which the government was acting in an administrative capacity, rather than as a contributor of a distinctive viewpoint to the marketplace of ideas. Nor should the Court do so. If the eventual reporting of a government

action related to private speech could transform the action itself into government speech, virtually all regulation of private speech would constitute government speech and would thus be exempt from First Amendment scrutiny altogether. And for those government actions that would not otherwise constitute government speech, the government need only add a reporting requirement, which would function as a trump card to any First Amendment challenge. That should not be, and is not, the law.

B. This Court has applied relaxed scrutiny when reviewing content-based conditions on the receipt of government subsidies. But the Court has never applied that doctrine outside the context of cash subsidies or their functional equivalent. That is an important limitation, because it ensures that the government-subsidy exception does not swallow the First Amendment whole. And even if trademark registration were to qualify as a "subsidy," strict scrutiny would still apply. The government-subsidy exception does not authorize the government to target disfavored viewpoints, but that is exactly what Section 2(a)'s disparagement clause does. In addition, unlike the laws at issue in other government-subsidy cases, the disparagement clause does not serve the goals of the broader statute: here, to protect mark holders from unfair competition and to prevent market confusion.

Because this case involves neither government speech nor a government subsidy, the Court should review Section 2(a)'s disparagement clause under strict scrutiny. And under strict scrutiny, the judgment of the court of appeals should be affirmed.

ARGUMENT

THE DISPARAGEMENT CLAUSE OF SECTION 2(a) OF THE LANHAM ACT IS SUBJECT TO STRICT SCRUTINY

Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a), excludes from the benefits of federal registration trademarks that "disparage * * * persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." But the First Amendment prevents Congress from "restrict[ing] expression because of its message, its ideas, its subject matter, or its content." *Reed* v. *Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015). The question presented here is whether Section 2(a)'s disparagement clause violates the First Amendment.

In the decision below, the court of appeals held that Section 2(a)'s disparagement clause discriminates based on viewpoint and therefore must undergo strict scrutiny. Pet. App. 16a-27a; see Resp. Br. 15-19. In response, petitioner contends that lower scrutiny is warranted because, *inter alia*, the government has an interest in "disassociat[ing] itself from offensive communications," Pet. Br. 39, and because trademark registration is a discretionary government subsidy, see *id.* at 14-19, 28-31. Neither rationale exempts Section 2(a) from strict scrutiny.

A. The Government's Interest In 'Disassociating Itself' From Objectionable Speech Does Not Exempt Section 2(a)'s Disparagement Clause From Strict Scrutiny

It is a familiar principle that the First Amendment requires the government to satisfy strict scrutiny if it discriminates against a private speaker whose viewpoint it disfavors. See, *e.g.*, *Reed*, 135 S. Ct. at 2227, 2230. But if the government itself is the speaker, the First Amendment does not apply at all. See *Walker* v. *Texas Division, Sons of Confederate Veterans, Inc.*, 135 S. Ct.

2239, 2245-2246 (2015). In that case, the government is free to craft the content of its own speech—including refusing to communicate a message it finds objectionable. See *id.* at 2252-2253.

Petitioner contends that Section 2(a)'s disparagement clause is exempt from strict scrutiny because the government has an interest in distancing itself from offensive speech. See Pet. Br. 37-41. But the government does not speak through trademarks, trademark registrations, or published notices of registered marks. The government-speech doctrine thus does not apply, which means that strict scrutiny does.

1. Unless It Is Speaking, The Government Cannot Discriminate Against Disfavored Speech

a. It should go without saying that the First Amendment contains no general exception for speech the government finds objectionable. See, *e.g.*, *United States* v. *Stevens*, 559 U.S. 460, 464-465 (2010) (depictions of animal cruelty); *Texas* v. *Johnson*, 491 U.S. 397, 400 (1989) (flag burning); *National Socialist Party of America* v. *Village of Skokie*, 432 U.S. 43, 43-44 (1977) (per curiam) (Nazi parade); *Brandenburg* v. *Ohio*, 395 U.S. 444, 444-447 (1969) (per curiam) (Ku Klux Klan rally). The First Amendment likewise contains no general exception that applies whenever the government wants to "disassociate itself from offensive communications." Pet. Br. 39. After all, the entire public-forum doctrine rests on the notion that the government, even in a forum it controls, has limited discretion to decide "which issues are worth discussing" and which "views" may be "express[ed]." *Police Department of Chicago* v. *Mosley*, 408 U.S. 92, 96 (1972). The government has never been able to defend viewpoint discrimination simply on the ground that the public might associate a controversial viewpoint with the gov-

ernment. See, *e.g.*, *Good News Club* v. *Milford Central School*, 533 U.S. 98, 113-114 (2001); *Rosenberger* v. *Rector & Visitors of University of Virginia*, 515 U.S. 819, 829 (1995); *Widmar* v. *Vincent*, 454 U.S. 263, 274 (1981).

b. This Court has exempted viewpoint discrimination from strict scrutiny only when the government itself was speaking. Viewpoint discrimination poses no problem in the context of government speech, because the Free Speech Clause does not prevent the government from "determining the content of what it says." *Walker*, 135 S. Ct. at 2245.[2] As long as it is speaking, the government can refuse to espouse viewpoints with which it does not wish to be associated.

Walker illustrates the point. That case involved a program run by the State of Texas that allowed nonprofit organizations to submit license-plate designs for state approval. See 135 S. Ct. at 2244-2245. Under that program, the Sons of Confederate Veterans submitted a license-plate design that displayed the Confederate battle flag. See *id.* at 2245. The State refused to approve the design, voicing a concern that "many members of the general public [would] find the design offensive." *Ibid.* The Court permitted that viewpoint-based rejection without applying strict scrutiny. See *id.* at 2249-2250. The State could refuse to approve the design, the Court explained, because messages on its license plates constituted government speech. See *id.* at 2250.

---

[2] This Court has held that the Establishment Clause can limit the government's ability to espouse religious viewpoints in certain circumstances. See, *e.g.*, *McCreary County* v. *ACLU of Kentucky*, 545 U.S. 844, 867-873 (2005); *Santa Fe Independent School District* v. *Doe*, 530 U.S. 290, 301-309 (2000). That line of cases is not implicated here.

Rust v. *Sullivan*, 500 U.S. 173 (1991), is to the same effect. At issue there was a federal funding program that provided grants to medical clinics for preventative family-planning services. See *id.* at 178-179. As a condition of the funding, Congress prohibited recipients from discussing abortion as a method of family planning. See *ibid.* The Court upheld the condition under the First Amendment without applying strict scrutiny. See *id.* at 192-195. As the Court later explained, the condition was permissible because government speech was at issue. See *Legal Services Corp.* v. *Velazquez*, 531 U.S. 533, 540-541 (2001); *Rosenberger*, 515 U.S. at 833. Although the government was not directly the speaker, it was using private grantees to convey a message to the public—namely, that abortion is not "an appropriate method of family planning." *Rust*, 500 U.S. at 180; see *Velazquez*, 531 U.S. at 540-541. Because the government was speaking to the public, albeit indirectly, it could disassociate itself from contrary views.

2. *The Government Does Not Speak Through The Trademark-Registration Regime*

This Court has identified three factors for determining whether the government-speech doctrine applies. First, has the government traditionally used the relevant medium to "speak to the public"? *Pleasant Grove City* v. *Summum*, 555 U.S. 460, 470 (2009). Second, would the public "routinely—and reasonably—interpret [the medium] as conveying some message on the [government]'s behalf"? *Id.* at 471. Third, does the government "maintain[] direct control over the messages conveyed" in the medium? *Walker*, 135 S. Ct. at 2249.

When those factors are applied here, it is clear that the government does not speak through the trademark-registration regime. The disparagement clause of Sec-

tion 2(a) of the Lanham Act should therefore be subject to strict scrutiny.

a. To begin with, the government does not "speak to the public" through registered trademarks themselves. *Summum*, 555 U.S. at 470. As defined by the Lanham Act, a trademark is "any word, name, symbol, or device" used "to identify and distinguish" goods and "to indicate the source of the goods." 15 U.S.C. 1127. A trademark is quintessential private speech: the "primary object" of a trademark is to transmit a message from a vendor to a consumer about "the origin of the article to which it is affixed." *Kidd* v. *Johnson*, 100 U.S. (10 Otto) 617, 620 (1880).

Federal registration does not transform a trademark from private speech into government speech. The act of registration involves listing the trademark in the "principal register." 15 U.S.C. 1051(a). Although "not entirely clear" from the statutory definition, the principal register is essentially an internal set of government files that simply list registered marks. Pet. App. 45a. Registration thus amounts to little more than an administrative action; the government does not "convey[] a government message" to anyone during that process, much less to the public at large. *Summum*, 555 U.S. at 470, 472.

Notably, registration does not give the government any control over the use of the trademark. "When a trademark is registered," the mark holder's "common law rights continue." 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 19:3, at 19-23 (4th ed. 1996) (McCarthy). Those rights include the right to use the mark exclusively. See *Trade-Mark Cases*, 100 U.S. (10 Otto) 82, 92 (1879). Registration merely confers certain additional benefits on a mark holder, such as a presumption of validity. See 15 U.S.C. 1057(b).

After registration, then, a trademark remains private speech, with the mark holder continuing to use the mark to transmit a message to consumers.

Congress, moreover, did not enact the Lanham Act to communicate any broad "programmatic message" about the use of disparaging words or images. *Velazquez*, 531 U.S. at 548. The Lanham Act is regulatory in nature. It aims to prevent the use of "deceptive and misleading" marks in interstate commerce; to "protect registered marks" from "interference by [local] legislation"; to prevent "unfair competition"; to stop "fraud and deception" through the improper use of registered marks; and to ensure compliance with certain "treaties and conventions." 15 U.S.C. 1127; see S. Rep. No. 1333, 79th Cong., 2d Sess. 3-5 (1946). There is no evidence that Congress passed the Act to make a statement about disparagement. To the contrary, the legislative history surrounding Section 2(a)'s disparagement clause suggests that Congress adopted it to protect the names of respected figures and institutions, not to communicate a message about disparagement. See *Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the H. Comm. on Patents*, 76th Cong., 1st Sess. 19-21 (1939) (citing "Abraham Lincoln gin," "George Washington coffee," the "New York Athletic Club," and "Harvard University").

b. In addition, the public is unlikely to attribute the message embodied in registered trademarks to the government. At the time of registration, the public already associates the mark with the mark holder. The Lanham Act "provides only for registration of existing marks," *In re ECCS, Inc.*, 94 F.3d 1578, 1579 (Fed. Cir. 1996), and "it is use of a mark in the marketplace that creates a trademark" in the first place, 3 McCarthy § 19:8, at 19-33. Registration does permit the mark-holder to use the

® symbol with the mark. See 15 U.S.C. 1111. But it is farfetched to think the public would consider a trademark a government message merely by virtue of that symbol.

It would be similarly unreasonable for the public to view the act of trademark registration as government speech approving of the message communicated in a registered mark. The Patent and Trademark Office has made clear that "the act of registration is not a government imprimatur or pronouncement that the mark is a 'good' one in an aesthetic, or any analogous, sense." *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1219 n.3 (T.T.A.B. 1993). Consistent with that view, the Office has registered countless trademarks that no reasonable person would think the government endorses. See, *e.g.*, Pet. App. 43a (listing marks such as GANJA UNIVERSITY and MURDER 4 HIRE); Pro-Football Cert. Br. 11 (listing numerous offensive marks).

c. The government also does not "maintain[] direct control over the messages conveyed" through trademarks. *Walker*, 135 S. Ct. at 2249. A mark's design comes entirely from the mark holder's imagination. The government has no editorial say as to a mark's content; it can only choose either to register or not to register the mark. The mark holder is also free to use its mark as it sees fit after registration. That means a mark holder could incorporate its mark in advertisements containing any variety of objectionable speech—including "crude references to women," "racial slurs and white-supremacist slogans," and "demeaning illustrations of * * * religious figures," Pet. Br. 28—without any oversight from the Patent and Trademark Office. This is not a situation, therefore, where the government "retains absolute veto power over the [relevant] content,

right down to the wording." *Johanns* v. *Livestock Marketing Ass'n*, 544 U.S. 550, 563 (2005).

d. In response, petitioner points out that "the federal government, in administering the trademark-registration program, issues certificates of registration, publishes registered marks, and transmits registration information to foreign countries." Pet. Br. 37. Petitioner argues that the government must be permitted to exclude disparaging marks from those "official communications" without being subject to strict scrutiny. *Ibid.*

Petitioner's position has superficial appeal, but it ultimately proves too much. In essence, the government is claiming that, without the ability to discriminate based on viewpoint, it may have to issue a report that contains objectionable speech. But if the mere act of reporting a government action related to private speech could transform the action itself into government speech, then almost all regulation of private speech would constitute government speech. And for regulation that does not, the government could simply add a reporting requirement to avoid First Amendment scrutiny. As the court of appeals recognized:

> The government could record recipients of parade permits in an official database or publish them weekly, thus insulating content-based grants of these permits from judicial review. Governmental agencies could assign TV and radio licenses and [S]tates could refuse to license medical doctors with no First Amendment oversight by "registering" these licenses in an online database, or by allowing licensees to display a mark by their name.

Pet. App. 45a-46a.

Not surprisingly, this Court's cases applying the government-speech doctrine do not support petitioner's po-

sition. In each of those cases, the government had consciously used a certain medium to advance to the public "its own message" or viewpoint on a particular matter. *Rosenberger*, 515 U.S. at 833. *Walker* involved license plates, which the State used "to urge action, to promote tourism, and to tout local industries." See 135 S. Ct. at 2248. *Summum* involved monuments on public land, which a local government used to "present[] the image of the City that it wishe[d] to project." 555 U.S. at 473. And as discussed above, *Rust* involved the use of a grant program conveying the government's viewpoint that abortion is not "an appropriate method of family planning." 500 U.S. at 180.

This case is quite different. Here, the government is claiming to "speak" not in the communication of its viewpoint to the public, but rather "in the exercise of its managerial or regulatory responsibilities." Randall P. Bezanson & William G. Buss, *The Many Faces of Government Speech*, 86 Iowa L. Rev. 1377, 1408, 1428-1432 (2001). This Court has never expanded the government-speech doctrine that far, and it should not do so here. Such a decision "would have potentially vast and limitless consequences." *Id.* at 1408.

To cite just one example, petitioner's expansive view of the government-speech doctrine would apply to copyrights just as it does to trademarks. As in trademark law, a copyright holder can secure certain rights and benefits by registering the copyright with the government. See 17 U.S.C. 408-412. And as in trademark law, the government issues a certificate of registration to a successful applicant. See 17 U.S.C. 410(a). If that alone is sufficient to transform the copyrighted content into government speech, the government can deny registra-

tion for, and thus deter the creation of, otherwise copyrightable content it finds objectionable.[3]

The First Amendment would not permit such blatant censorship in that context, and it does not do so here. The government does not speak through trademarks, trademark registrations, or published notices of registered marks. The government's purported interest in disassociating itself from objectionable trademarks therefore does not exempt Section 2(a)'s disparagement clause from strict scrutiny.

B. The Government-Subsidy Exception Does Not Exempt Section 2(a)'s Disparagement Clause From Strict Scrutiny

In a line of related cases, this Court has also refused to apply strict scrutiny to content-based conditions placed on the receipt of government subsidies. For example, in *Regan* v. *Taxation With Representation of Washington*, 461 U.S. 540 (1983), the Court applied a relaxed standard of review in upholding tax breaks offered to certain charitable entities as long as they did not engage in substantial lobbying activities. *Id.* at 543-544. In cases involving government subsidies, the Court has explained, "the [g]overnment is not denying a benefit to anyone, but is instead simply insisting that public funds be spent for the purposes for which they were authorized." *Rust*, 500 U.S. at 196.

At the same time, however, the government "cannot recast a condition on funding as a mere definition of its

---

[3] A holding that administrative actions by the government qualify as government speech may also cast doubt on some of this Court's state-action decisions. See, *e.g.*, *Moose Lodge No. 107* v. *Irvis*, 407 U.S. 163, 176-177 (1972) (holding that the issuance of a liquor license does not constitute state action under the Fourteenth Amendment).

program in every case, lest the First Amendment be reduced to a simple semantic exercise." *Velazquez*, 531 U.S. at 547. The Court accordingly has kept the government-subsidy exception within certain bounds, three of which are relevant here. First, the Court has never applied the exception beyond cash subsidies or their functional equivalent. Second, the Court has never permitted the government to target disfavored viewpoints. And third, the Court has typically approved only conditions that further the core purpose of the underlying program. As we will now explain, applying the government-subsidy exception in this case would transgress each of those bounds.

1. Trademark Registration Is Not A 'Subsidy'

a. Every one of this Court's speech cases applying the government-subsidy doctrine has involved a cash payment or its functional equivalent. See, *e.g.*, *Agency for International Development* v. *Alliance for Open Society International, Inc.*, 133 S. Ct. 2321, 2324 (2013); *Ysursa* v. *Pocatello Education Ass'n*, 555 U.S. 353, 355 (2009); *Davenport* v. *Washington Education Ass'n*, 551 U.S. 177, 181-182 (2007); *Velazquez*, 531 U.S. at 536-537; *National Endowment for the Arts* v. *Finley*, 524 U.S. 569, 573 (1998); *Regan*, 461 U.S. at 544. The Court "has never extended" the government-subsidy exception to "situations not involving financial benefits." *Autor* v. *Pritzker*, 740 F.3d 176, 183 (D.C. Cir. 2014).

This case does not involve a cash payment or its functional equivalent. Congress enacted the Lanham Act pursuant to its authority under the Commerce Clause, not the Spending Clause. See 15 U.S.C. 1051, 1127; see 1 McCarthy § 6:2, at 6-3 to 6-5 (discussing the *Trade-Mark Cases*, *supra*). And the trademark-registration regime serves a quintessentially regulatory function,

governing the relationship between a mark holder and a potential infringer. See 15 U.S.C. 1127; S. Rep. No. 1333, 79th Cong., 2d Sess. 3-5 (1946). A mark holder whose mark is registered may receive a benefit, but it does not receive any government funding.

It is important for the Court to maintain the cash-payment limitation on what qualifies as a "subsidy" under the government-subsidy exception. Absent such a limiting principle, the government-subsidy exception would swallow the First Amendment whole. All "[p]roperty rights are created by the State," *Palazzolo* v. *Rhode Island*, 533 U.S. 606, 626 (2001); under an expansive definition of "subsidy," any such right could be considered a government benefit. Incidental government support for speech could also qualify, such as the closing of roads for parades, see *Hurley* v. *Irish-American Gay, Lesbian, and Bisexual Group of Boston*, 515 U.S. 557, 561 (1995), or a school's operation of a public forum, see *Good News Club*, 533 U.S. at 106-107. If unmoored from any reasonable limitation, the government-subsidy exception would bestow an enormous power on the government to regulate speech, subject only to rational-basis review. Applying the exception only to cash payments or their functional equivalents confines the exception within reasonable bounds.

b. Contrary to petitioner's suggestion, see Pet. Br. 41, this Court's decisions in *Davenport* and *Ysursa* fit comfortably within the cash-payment limitation. In each case, the Court addressed a law limiting the ability of public-sector unions to use agency-shop fees on electioneering activity. See *Ysursa*, 555 U.S. at 356; *Davenport*, 551 U.S. at 181-182. The fees amounted to cash subsidies: the government provided the unions with an entitlement to receive cash, albeit from the employees' paychecks rather than the general public coffers. As a

result, what the unions ultimately received from the government was a direct financial benefit.

What is more, *Davenport* and *Ysursa* implicated concerns about compelled speech not at issue here. In *Knox* v. *Service Employees*, 132 S. Ct. 2277 (2012), this Court recognized the "general rule" that "individuals should not be compelled to subsidize private groups or private speech." *Id.* at 2295. It makes sense that the government may have more leeway to enact content-based restrictions in cases raising concerns about forcing non-union employees to fund union electioneering activities. In all events, this case plainly does not involve a cash payment or its functional equivalent, and the government-subsidy exception is thus inapplicable.

2. *A Government Subsidy Cannot Target Disfavored Viewpoints*

Even if trademark registration somehow constituted a government subsidy, strict scrutiny would still be warranted. Congress has targeted certain ideas through the disparagement provision in Section 2(a), and that is not permitted by the government-subsidy exception.

a. Virtually all of this Court's decisions upholding conditions on government funding have involved content-based restrictions. See *Ysursa*, 555 U.S. at 356 (limitation on spending funds for electioneering activity); *Davenport*, 551 U.S. at 181-182 (same); *United States* v. *American Library Ass'n*, 539 U.S. 194, 199 (2003) (requirement that libraries receiving federal funds "block images that constitute obscenity or child pornography, and to prevent minors from obtaining access to material that is harmful to them"); *Finley*, 524 U.S. at 572 (requirement that the National Council for the Arts consider "general standards of decency and respect for the diverse beliefs and values of the American public" when

providing grants); *Regan*, 461 U.S. at 542 (requirement that charitable nonprofit organizations not engage in lobbying activities as a condition of receiving a tax break). *Rust* stands out as the obvious exception: the Court there did permit viewpoint discrimination, upholding a requirement that grant recipients could not promote abortions as a method of family planning. See 500 U.S. at 178-180.

Rust, however, does not stand for the general proposition that the government can discriminate on the basis of viewpoint in the provision of subsidies. The Court has long held that the "discriminatory denial of a tax exemption" "frankly aimed at the suppression of dangerous ideas" is a "limitation on free speech." *Speiser* v. *Randall*, 357 U.S. 513, 518-519 (1958). Time and again, the Court has reiterated that warning in the context of government subsidies. See, *e.g.*, *Finley*, 524 U.S. at 587 (stating that, "[i]f the [National Endowment for the Arts] were to leverage its power to award subsidies on the basis of subjective criteria into a penalty on disfavored viewpoints, then we would confront a different case"); *Regan*, 461 U.S. at 548 (noting that "[t]he case would be different if Congress were to discriminate invidiously in its subsidies in such a way as to 'ai[m] at the suppression of dangerous ideas'" (second alteration in original; citation omitted)); cf. *Leathers* v. *Medlock*, 499 U.S. 439, 447 (1991) (stating that "differential taxation of First Amendment speakers is constitutionally suspect when it threatens to suppress the expression of particular ideas or viewpoints").

Moreover, as this Court explained in its subsequent decision in *Velaquez*, *Rust* is unique because it is best understood as a government-speech case (notwithstanding the presence of government funding). *Velazquez* involved a restriction on federal grants to legal-aid pro-

grams forbidding attorneys from challenging the validity of existing welfare laws. See 531 U.S. at 537. The Court invalidated that restriction as violating the First Amendment. See *id.* at 540-549. In so doing, the Court noted that it had sustained "viewpoint-based funding decisions" when "the government is itself the speaker" or when "the government used private speakers to transmit specific information pertaining to its own program." *Id.* at 541 (internal quotation marks and citations omitted). But when the government program "was designed to facilitate private speech," the Court continued, the First Amendment prohibited viewpoint discrimination. *Id.* at 542. To demonstrate the distinction, the Court contrasted the case at hand with *Rust*: there was a "programmatic message" in *Rust*, permitting a viewpoint-based condition, but there was no such message in *Velazquez*, so the viewpoint-based condition violated the First Amendment. *Id.* at 547-548.

b. As the foregoing cases demonstrate, even if trademark registration somehow constituted a government subsidy, the disparagement clause in Section 2(a) of the Lanham Act would be subject to strict scrutiny. That clause expressly targets any trademark that "disparage[s] * * * persons, living or dead, institutions, beliefs, or national symbols, or bring[s] them into contempt, or disrepute." 15 U.S.C. 1052(a). By any measure, that is a viewpoint-based restriction. See Pet. App. 16a-27a; Resp. Br. 15-19. And as discussed above, the Lanham Act does not involve government speech; it exists to promote the use of trademarks, a form of private speech. See p. 10, *supra*. The disparagement clause is therefore subject to strict scrutiny regardless of whether trademark registration is a subsidy.

3. *Section 2(a)'s Disparagement Clause Does Not Serve The Goals Of The Lanham Act*

When this Court has applied relaxed scrutiny to speech-related funding conditions, that is generally because the condition serves the program's central goals. In *Rust*, for example, Congress designed its spending program to "encourage family planning," not provide for "prenatal care." 500 U.S. at 193. The limitation on discussing abortions at issue there made good sense, as abortions by definition occur after conception. See *id.* at 193-194. In *Regan*, the tax provision at issue eliminated the tax burden on certain charitable entities. See 26 U.S.C. 501(c)(3). A restriction on lobbying activities sensibly ensured that those entities did not "use tax-deductible contributions to lobby to promote the private interests of their members." 461 U.S. at 550. And in *Davenport* and *Ysursa*, the agency-shop fees at issue were designed to prevent unaffiliated employees from free-riding on the benefits unions provide in collective bargaining. See *Harris* v. *Quinn*, 134 S. Ct. 2618, 2627 (2014). A restriction on using those fees for electioneering activities ensured that the fees actually paid for activities "germane" to collective bargaining. *Lehnert* v. *Ferris Faculty Ass'n*, 500 U.S. 507, 519 (1991); see *Abood* v. *Detroit Board of Education*, 431 U.S. 209, 233-236 (1977).

A ban on the registration of disparaging trademarks does not further the Lanham Act's goals in even a remotely comparable fashion. Such a ban does not prevent the use of "deceptive and misleading" marks in interstate commerce; "protect registered marks" from "interference by [local] legislation"; prevent "unfair competition"; or stop "fraud and deception" through the improper use of registered marks. 15 U.S.C. 1127.

To be sure, Congress also enacted the Lanham Act to bring the United States into compliance with certain treaties and conventions. See 15 U.S.C. 1127. But neither of the relevant treaties *required* signatories to refuse to register disparaging marks; they simply permitted the practice at the signatories' discretion. See General Inter-American Convention for Trade Mark and Commercial Protection, Art. 3, §§ 3-4, 46 Stat. 2916, 2914-2916, Feb. 20, 1929, T.S. No. 833; Paris Convention for the Protection of Industrial Property, Art. 6, 25 Stat. 1372, 1376, Mar. 20, 1883. And if anything, in enacting the disparagement clause, Congress seemed most concerned with the protection of respected American public figures and institutions, not adherence to international norms. See p. 10, *supra*.

* * * * *

In the end, the disparagement clause of Section 2(a) of the Lanham Act must survive strict scrutiny in order to avoid invalidation. That is the normal standard of review for laws that discriminate on the basis of viewpoint. The government's purported interest in disassociating itself from offensive speech does not warrant a lower standard of review, because this case does not involve government speech. Nor does the government-subsidy exception apply. Trademark registration is not a subsidy, and the disparagement clause targets a disfavored viewpoint and does not further the Lanham Act's goals. The court of appeals correctly applied strict scrutiny to Section 2(a)'s disparagement clause, and its judgment should be affirmed.

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted.

KANNON K. SHANMUGAM
ALLISON JONES RUSHING
WILLIAM T. MARKS
WILLIAMS & CONNOLLY LLP
725 Twelfth Street, N.W.
Washington, DC 20005
(202) 434-5000
kshanmugam@wc.com

DECEMBER 2016

ECORD
AND
BRIEFS

No. 15-1293

Supreme Court, U.S.
FILED
NOV 16 2016
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR ASIAN AMERICANS ADVANCING JUSTICE | AAJC AND OTHER CIVIL RIGHTS AND ADVOCACY GROUPS AS *AMICI CURIAE* IN SUPPORT OF NEITHER PARTY

CECELIA CHANG
ASIAN AMERICANS ADVANCING JUSTICE | AAJC
1620 L Street, Suite 1050
Washington, DC 20036
(202) 296-2300

DANIEL J. KORNSTEIN
Counsel of Record
ALANNA SMALL
EMERY CELLI BRINCKERHOFF & ABADY LLP
600 Fifth Avenue, 10th Floor
New York, New York 10020
(212) 763-5000
dkornstein@ecbalaw.com

Counsel for Amici Curiae

269128

TABLE OF CONTENTS

Page

TABLE OF CONTENTS i

TABLE OF CITED AUTHORITIES iii

INTEREST OF *AMICI CURIAE* AND SUMMARY OF ARGUMENT 1

ARGUMENT 4

I. PROTECTING RECLAMATION EFFORTS DOES NOT JUSTIFY FACIALLY INVALIDATING THE LANHAM ACT'S DISPARAGEMENT PROVISION 4

A. The Lanham Act and Federal Registration of Trademarks Are Designed to Facilitate Commerce, Not Protect or Promote Private Expression 5

B. Opening the Property-Based Benefits of Federal Registration to Slurs and Derogatory Marks Impairs Reclamation Efforts by Minority Communities 8

II. VOIDING SECTION 2(a) IS COUNTERPRODUCTIVE WHEN EXPRESSIVE CONCERNS CAN BE WEIGHED UNDER A BALANCED DISPARAGEMENT ANALYSIS 13

Table of Contents

Page

A. The Compelling Interests at Stake Call for a Balanced Remedy. 13

B. A More Nuanced Approach 15

1. Whether the Mark Is Part of Reclamation Efforts. 17

2. The history and potential harmful effects of the term 20

3. The expressive context of the mark and requested use 26

CONCLUSION 28

APPENDIX 1a

TABLE OF CITED AUTHORITIES

Page

CASES

Ariz. State Legislature v. Ariz. Independent Redistricting Comm'n, 135 S. Ct. 2652 (2015) 16

Ballew v. Georgia, 435 U.S. 223 (1978) 21

Bolger v. Youngs Drug Prods. Corp., 463 U.S. 60 (1983) 14

Brown v. Board of Educ., 347 U.S. 483 (1954) 21

Cantwell v. Connecticut, 310 U.S. 296 (1940) 4

Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y., 447 U.S. 557 (1980) 27

Crowell v. Benson, 285 U.S. 22 (1932) 16

Dennis v. United States, 341 U.S. 494 (1951) 17

Gratz v. Bollinger, 539 U.S. 244 (2003) 21

Cited Authorities

Page

In re Heeb Media, LLC,
89 U.S.P.Q.2d (BNA) 1071 (T.T.A.B. 2008) 27

In re Trade-Mark Cases,
100 U.S. 82 (1879) 5, 6

Jones v. Alfred H. Mayer Co.,
392 U.S. 409 (1968) 21

McDermott v.
S.F. Women's Motorcycle Contingent,
240 F. App'x 865 (Fed. Cir. 2007) 11

New Kids on the Block v. News Am. Publ'g, Inc.,
971 F.2d 302 (9th Cir. 1992) 6, 16, 17

Radiance Found., Inc. v. NAACP,
786 F.3d 316 (4th Cir. 2015) 16

Rogers v. Grimaldi,
875 F.2d 994 (1989) 16

S.F. Arts & Athletics v. U.S. Olympic Comm.,
483 U.S. 522 (1987) 8, 15

STATUTES AND OTHER AUTHORITIES

First Amendment to the U.S. Constitution . . . . . *passim*

15 U.S.C. § 1051(b)(1) 7

Cited Authorities

Page

15 U.S.C. § 1112 26

15 U.S.C. § 1117 7

15 U.S.C. § 1121 7

15 U.S.C. § 1127 6

15 U.S.C. § 1702 7

S. Ct. R. 37 1

Adam D. Galinsky, Kurt Hugenberg, Carla Groom, Galen Bodenhausen, *The Reappropriation of Stigmatizing Labels: Implications for Social Identity*, 5 Research on Managing Groups and Teams 221 (2003) 10

Colorado Research in Linguistics 1 (2004) 10

Douglas Harper, *Online Etymology Dictionary*: "Yankee." (2013) 9

Gilbert C. Gee, Annie Ro, Salma Shariff-Marco, David Chae, *Racial Discrimination and Health Among Asian Americans: Evidence, Assessment, and Directions for Future Research*, 31(1) Epidemiological Reviews 130 (2009) 23

Page

Hyung Chol Yoo, Gilbert C. Gee, D. Takeuchi, *Discrimination and health among Asian American immigrants: Disentangling racial from language discrimination.* 68(4) Soc. Sci. Med. 726 (2008).....21, 25

Jason Silverstein, *How Racism is Bad for Our Bodies,* The Atlantic (Mar. 12, 2013).....22

Jennifer Wang, John Oliver Siy, Sapna Cheryan, *Racial Discrimination and Mental Health Among Asian American Youth,* in Asian American and Pacific Islander Children and Mental Health Volume 1 219 (Frederick T.L. Leong, Linda Juang, Desiree Baolian Qin & Hiram E. Fitzgerald eds., 2013)..... 23, 25

Jessica M. Kiser, *How Dykes on Bikes Got It Right,* 46 U.S.F. L. Rev. 1 (2011-2012).....19

Jonathan Long, *Welcome to the New Era of Viral Shock Marketing,* Huffington Post (Oct. 25, 2013).....20

Jordan Tidwell, *FBI Investigates Graffiti Vandalism at Two Fort Smith Mosques* (Oct. 20, 2016).....25

Liam Stack, *Hate Crime Inquiry Opened Into Vandalism of Sikh Temple in California,* N.Y. Times (Dec. 9, 2015).....25

Cited Authorities

Page

Louise Liu, *Asian-Americans share stories of racism after a New York Times editor was told to 'go back to China,'* Business Insider (Oct. 11, 2016) 24

Melissa Eddy and James Kanter, *German E.U. Official Is in Trouble Over Remarks About Chinese*, N.Y. Times (Oct. 31, 2016) 24

Michael Luo, *'Go Back to China': Readers Respond to Racist Insults Shouted at a New York Times Editor*, N.Y. Times (Oct. 10, 2016).....24

Michael Luo, *An Open Letter to the Woman Who Told My Family to Go Back to China*, N.Y. Times (Oct. 9, 2016) 23

Oliver Wendell Holmes, Jr., *The Common Law 15* (Paulo J.S. Pereira & Diego M. Beltran eds., University of Toronto Law School Typographic Society 2011)(1881) 15

Renee Jorgenson Bolinger, *The Pragmatics of Slurs*, 49(1) Noûs, 1 (2015).....9, 10

Robin Brontesema, *A Queer Revolution: Reconceptualizing the Debate Over Linguistic Reclamation* (2004) 10

Sonia Y. Katyal, *Trademark Intersectionality*, 57 UCLA L. Rev. 1689 (2009-2010).....12

Cited Authorities

Page

Tim Padgett, *Another South Florida Mosque Vandalized, Anti-Muslim Hate Crimes Rising* (Nov. 3, 2016) 25

Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(A) for the Lanham Act*, 106 Colum. L. Rev. 388 (Mar. 2006).....18

U.S. Dep't of Health and Human Servs. (2001). Mental Health: Culture, Race and Ethnicity—A Supplement to Mental Health: A Report of the Surgeon General. (2001) 22

Woman – or Suffragette? Oxford Dictionaries Blog 9

Zachary Zane, *6 Reasons You Need to Use the Word Queer*, Pride (Aug. 4, 2015).....10

INTEREST OF *AMICI CURIAE* AND SUMMARY OF ARGUMENT

Amici are a coalition of civil rights and advocacy groups that represent communities historically targeted—and still attacked today—by degrading racial, ethnic, and religious slurs.[1] A full list of amici is provided in Appendix A.

Many *amici* are also fans of respondent Simon Tam and his band The Slants. *Amici* support efforts to reclaim and reappropriate derogatory terms, but believe that socially progressive reclamation movements are not an excuse to open federal trademark registration to vile epithets and hateful marks.

Amici submit this brief to counter the rote and overly simplistic arguments about reclamation accepted by the court of appeals below. The First Amendment principles at stake in this case are complex and require balancing. Trademark rights are primarily rights of ownership and exclusion. As a result, federal registration of a mark functionally removes registered words and terms from collective use nationwide. Thus, registration can be a powerful tool to block and skew debate, and it can impair or slow reclamation efforts by minority communities by restricting the ability of non-trademark owners to use and redefine disparaging words and terms.

---

1. No party or its counsel wrote or helped write this brief, or gave money intended to fund its writing or submission, *see* S. Ct. R. 37. Blanket permission to write briefs is filed with the Court.

Tam acknowledges that the point of his federal trademark registration is to "deter other bands from calling themselves The Slants" regardless of their message or counter-message in ongoing debates about Asian stereotypes or the meaning of "slants."[2] Likewise, in related litigation over the Washington REDSKINS trademark, a professional football team is fighting to keep exclusive ownership and control over a term that many Native American groups and individuals view as dehumanizing. Because REDSKINS is federally registered, the team can threaten a federal lawsuit and invoke federal law to prevent a Native American band from calling itself the "The Redskins" even if the band is attempting to challenge stereotypes and reclaim the slur.

As these examples illustrate, the Lanham Act does not operate neutrally with respect to expression or reclamation efforts. Instead, it vests nationwide property rights—and the right to *reappropriate* terms—in the first registrant. For that reason, facial invalidation of the Lanham Act's disparagement clause is overbroad. It invites and incentivizes commercial appropriation of derogatory slurs without counterbalancing statutory protection for reclamation by minority and oppressed communities.

While First Amendment concerns about reclamation suffuse this case, genuine concern for free expression requires a more tailored remedy. *Amici* submit this brief to explain two key points and to propose a more nuanced solution than either side or the courts below have offered.

---

2. Brief for the Respondent in Opposition to the Petition for Certiorari ("Br. in Opp.") at 23.

First, the complexities of First Amendment analysis make it easy to overlook the foundational purpose of the Lanham Act. The Lanham Act was enacted to facilitate commerce, not to promote or protect expression. This makes federal registration of trademarks a double-edged sword: depending on circumstance and context, registration is just as likely to hinder speech—particularly speech reclaiming disparaging marks—as promote it.

Second, there is room within the existing statutory framework to consider expressive interests and recognize reclamation when determining whether a proposed mark is, in fact, disparaging. But any analysis must also recognize that reclamation is a collective effort, rather than a unilateral one. Changing the meaning of slurs and other derogatory terms with entrenched historical and cultural connotations requires collective action and community acceptance—a reality that counsels against uncritical deference to any single individual's claim to be "reclaiming" a hateful and discriminatory term. The painful collateral damage of encouraging the widespread commercial use of offensive and derogatory terms must also be considered.

Amici recognize that "The Slants" is not the same as the "Redskins." Tam may well qualify for registration if he provides additional information under a more comprehensive and nuanced disparagement analysis that considers both the expressive interest in reclamation and the potential harmful effects of the proposed mark. Providing Tam with *individual* relief, however, does not require, nor support, wholesale invalidation of the Lanham Act's disparagement provision.

Amici are united in warning the Court about the harms of the court of appeals' overbroad holding. While *amici* take differing positions with respect to Tam's personal entitlement to registration, all *amici* urge the Court to adopt a narrower holding. Completely removing the federal bar on registration of disparaging marks does not empower minority communities by aiding reclamation; it only threatens vast social harm by opening the federal registration system to misuse and the benefits of registration to "epithets" and terms of "personal abuse," speech this Court declined to shield and safeguard under the Constitution.[3]

Amici urge the Court to adopt a narrower holding. Rather than a judicial sledgehammer, this case calls for a sharper judicial scalpel to balance the interests of free speech and the strong public policy against prejudice, discrimination, and aiding in the commercial appropriation of slurs and disparaging terms.

ARGUMENT

I. PROTECTING RECLAMATION EFFORTS DOES NOT JUSTIFY FACIALLY INVALIDATING THE LANHAM ACT'S DISPARAGEMENT PROVISION

Hard cases make bad law. The decision below is an example of that axiom—prompted in part by the circuit court's and Tam's focus on trademarks being used to reclaim and reappropriate derogatory terms. The focus on reclamation as the turning point for constitutional analysis is misleading. It fails to examine the relationship between Tam's personal goals and the statutory scheme at issue.

---

3. *Cantwell v. Connecticut*, 310 U.S. 296, 309-310 (1940).

The Lanham Act as a whole, and the disparagement provision in particular, were not designed to accommodate Tam's individual mission—and with good reason. The Lanham Act is primarily concerned with facilitating national trade and commerce, not expression, and certainly not with efforts to reclaim degrading slurs. Understood in its statutory context, the Lanham Act's disparagement provision has a neutral and utilitarian purpose: to deny the privileges of federal registration to derogatory marks that do not advance Congress's functional trade-based goals.

A. The Lanham Act and Federal Registration of Trademarks Are Designed to Facilitate Commerce, Not Protect or Promote Private Expression

The controversy over federal registration in this case obscures how the Lanham Act operates in the area of trademark protection. Federal law does not create trademarks or trademark rights. Both arise under common law through the actual use of a mark in commerce.[4] Here, for example, Tam used "The Slants" as his band's name for five years before seeking federal trademark registration. From the founding of his band, Tam was—and still is—able to invoke common-law protection for "The Slants" without the additional step of federal registration under the Lanham Act.

The foundational common-law protections for trademarks are grounded in the value of marks for product identification, not expression. The barebones requirements for marks reflect the narrow basis for their recognition:

---

4. *See In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879).

marks are not required to have (nor expected to include) any message or expressive component; they only have to be used in actual trade and be associated with a product or service.[5] Trademark law treats marks as a form of private property, not a form of expression, granting markholders the exclusive right to "own" marks and prevent others using the mark for commercial purposes.

The actual impact of recognizing property rights in trademarks is not to purposefully foster expression, debate, or commentary, but rather to sanction "the removal of words" from "our [collective] language" by vesting ownership and control of those words in the trademark holder.[6] The common law accepts this "cost" because trademarks enhance the commercial marketplace and advance the related goals of protecting consumers from deception and protecting the mark holder from misappropriation.

Federal registration under the Lanham Act supplements common-law trademark rights, and is offered to spur and encourage nationwide commerce and business investment.[7] By registering, mark owners get additional benefits conferred by federal law that extend beyond the common-law rights earned through actual use of the mark. For example, federal registration provides nationwide constructive notice of the use and ownership of a claimed

---

5. *Id.* at 94 (explaining that trademark protection "does [not] depend upon novelty, invention, discovery, or any work of the brain" and "requires no fancy or imagination, no genius").

6. *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992).

7. 15 U.S.C. § 1127.

mark.[8] While common law limits trademark rights to only those geographic areas where a mark has actually been used, the Lanham Act gives federal registrants exclusive rights to use a mark *across the United States*—even in areas where the registrant conducts no business or trade.[9] The Lanham Act broadens the scope of exclusivity still further. Trademarks cannot be reserved in advance under common-law, but the Lanham Act permits registrants to pre-register marks not yet in actual use, so long as the registrant attests to having *bona fide* intent to use the mark in the future.[10]

The Lanham Act also arms federal registrants with powerful nationwide tools to shield and control their mark, including the ability to bring infringement suits in federal court and to recover treble damages and attorney's fees.[11] These procedural tools enhance the registrant's exclusive control over the claimed mark—providing a statutory incentive for parties to expand their businesses and conduct interstate trade.

The framework for the Lanham Act helps explain the function of the disparagement provision. Like other provisions of the Act, it is not concerned with expression.[12] The disparagement provision can be viewed

---

8. *Id.* § 1702.

9. *Id.*

10. *Id.* § 1051(b)(1).

11. *Id.* §§ 1117, 1121.

12. This can be seen not only in the statutory provisions that Congress enacted, but also in the provisions left out of the Lanham

instead as a limitation that protects the statutory *quid quo pro*. For those purposes of spurring trade and protecting consumers, enhancing private property rights to disparaging marks—and assisting in their use and appropriation nationwide—makes little sense. At a minimum, Congress could reasonably conclude that aiding in the dissemination of disparaging marks is "disruptive to commerce,"[13] and, as a result, there was no compensating public benefit or valid federal interest in providing the federal benefits of registration to disparaging marks.[14]

B. Opening the Property-Based Benefits of Federal Registration to Slurs and Derogatory Marks Impairs Reclamation Efforts by Minority Communities

Relying on Tam's claimed goal of reclamation, the court of appeals facially invalidated the Lanham

---

Act. Unlike federal copyright law, for example, which is concerned with expression, the Lanham Act includes no statutory defenses for fair or nominal use for ordinary trademarks—an absence that confirms the Lanham Act's exclusive focus on commerce.

Courts have crafted judicial exceptions for nominal use and parody involving registered trademarks, but these exceptions are piecemeal and under certain limitations on the Lanham's Act expanded protections for federally registered marks.

13. Pet. App. 119a.

14. *See S.F. Arts & Athletics v. U.S. Olympic Comm.*, 483 U.S. 522, 540 (1987) (confirming that Congress can reasonably draw broad category-based conclusions about whether use of certain marks is likely to be confusing or antithetical to the purposes of federal trademark laws—despite claims about individual political or expressive use).

Act's disparagement provision—making the provision inapplicable to all marks, including undeniably derogatory and disparaging marks designed to insult and "harm[] members of oft-stigmatized communities."[15] But relying on the progressive tradition of reclamation to invalidate the disparagement provision is backwards.

Reclamation is the process of taking a word that was previously considered pejorative, and bringing it back into accepted usage. Reclamation is not a new phenomenon—examples of reclaimed words include some as timeworn as "suffragette" (originally a term of derision to describe members of London's Women's Social and Political Union)[16] and "Yankee" (originally a derogatory term used against Dutch American settlers).[17]

Successful reclamation occurs in stages and is based on "undermining the signal strength of the slurring term."[18] First, "a group of speakers who reject the derogation of the target use the slur defiantly."[19] Second, "[a]s this group grows, the likelihood that a user of the term holds derogatory attitudes falls," causing the

---

15. Pet. App. 2a.

16. *Woman – or Suffragette?* Oxford Dictionaries Blog, http://blog.oxforddictionaries.com /2013/05/woman-or-suffragette/.

17. Douglas Harper, *Online Etymology Dictionary*: "Yankee." (2013), http://www.et ymonline.com/index.php?search=yankee.

18. Renee Jorgenson Bolinger, *The Pragmatics of Slurs*, 49(1) Noûs, 1, 1-24 (2015), http://philpapers.org/archive/BOLTPO-7.pdf.

19. *Id.*

perjorative connotation of the slur to "degrade"[20] Third, reclamation succeeds when the disparaging meaning of the slur "has been so diluted as to carry no information: the term is at least as likely to be used positively as it is to be used by those who hold objectionable attitudes."[21] At that point, it is possible to support use of a prior slur "without by default licensing rational offense."[22]

The last twenty to thirty years have witnessed the successful reclamation of several words previously considered pejorative to minority groups. For example, the word "queer" was reclaimed by the gay and lesbian communities in the 1990s.[23] "By refusing to perceive 'queer' as demeaning, in-group members make it more difficult for out-group members to gain recognition for their own display of superiority, thereby undermining one of the functions of prejudice."[24] Though the reclamation has not been without controversy, the term is now embraced and used by many of the groups and individuals it originally targeted.[25] Similarly, the word "dyke" has been

---

20. *Id.*

21. *Id.*

22. *Id.*

23. Robin Brontesema, *A Queer Revolution: Reconceptualizing the Debate Over Linguistic Reclamation* (2004), 17(1) Colorado Research in Linguistics 1, 1-17 (2004).

24. Adam D. Galinsky, Kurt Hugenberg, Carla Groom, Galen Bodenhausen, *The Reappropriation of Stigmatizing Labels: Implications for Social Identity,* 5 Research on Managing Groups and Teams 221, 231-232 (2003).

25. *See, e.g.*, Zachary Zane, *6 Reasons You Need to Use the Word Queer*, Pride, (Aug. 4, 2015), http://www.pride.com/queer/2015/8/04/6-reasons-you-need-use-word-queer.

reappropriated by the lesbian community, as recognized by the Federal Circuit's decision permitting a lesbian group to trademark the term "Dykes on Bikes."[26]

Support for reclamation movements does not mandate constitutional invalidation of the disparagement clause however. Historically, reclamation has been based on collective social action—not trademarking of slurs by individual parties or businesses. And while federal registration may aid in reclamation efforts, opening the benefits of federal registration to disparaging marks, without qualification or further analysis, also threatens to block reclamation of slurs and terms of abuse by minority communities. It would allow businesses to register—and commercially *appropriate*—marks like The REDSKINS, freezing pejorative meanings in place and removing derogatory terms from communal debate and actual control by the groups targeted by a disparaging mark.

Again, the Lanham Act is not pro-speech. By expanding the exclusive nature of a trademark, federal registration of marks actually inhibits speech by *precluding* their use by anyone else. Registering the mark expands the markholder's ability to sue other people who try to use the mark and *stop* speech, debate, and commentary. If the Washington "Redskins" football team is allowed to exclusively own the term REDSKINS, for example, the team can sue Native American protesters who use the term and logo in their protests (in protest posters, in protest t-shirts, or other items).

---

26. *McDermott v. S.F. Women's Motorcycle Contingent*, 240 F. App'x 865 (Fed. Cir. 2007).

The threat of chilling speech, and of markholders acing to suppress expression is not hypothetical. For example, when a Native American student at the University of North Dakota made a series of pins to express his disagreement with the University's "Fighting Sioux" logo and the logo's stereotypical portrayal of Native Americans, the University threatened to sue the student for trademark infringement. Intimidated, the student dropped his plan to protest through the pins.[27] Because the Lanham Act vests exclusive rights in the registrant, irrespective of reclamation goals, facial invalidation of the disparagement provision may have the baleful effect of *impinging* on free speech critical to reclamation movements, not protecting it.

For all these reasons, it is far too simple to cast facial invalidation of section 2(a) as an unqualified win for reclamation, let alone accept that it is "[m]inority groups" who are harmed by denying registration to racial and ethnic slurs and other disparaging marks.[28] *Amici* agree that reappropriation of slurs is a powerful social tool, but reclamation efforts are not furthered by opening the door to commercial appropriation of disparaging terms with no balancing of other factors or associated harms.

---

27. *See* Sonia Y. Katyal, *Trademark Intersectionality*, 57 UCLA L. Rev. 1689 (2009-2010), http://ir.lawnet.fordham.edu/faculty_scholarship/337.

28. Brief for the ACLU, et. al., as Amici Curiae Supporting Appellants, *In re Tam*, No. 14-1203 (Fed. Cir. Dec. 22, 2015).

II. VOIDING SECTION 2(a) IS COUNTERPRODUCTIVE WHEN EXPRESSIVE CONCERNS CAN BE WEIGHED UNDER A BALANCED DISPARAGEMENT ANALYSIS

Instead of striking down the disparagement clause as unconstitutional, *amici* urge the Court to reach a narrower holding that accounts for the free speech concerns on all sides and considers the interests of minority groups in guarding against disparagement.

A. The Compelling Interests at Stake Call for a Balanced Remedy

Amici recognize and are sensitive to the First Amendment issues in this case. But ignoring the commercial roots and the function of the Lanham Act, and failing to recognize *all* of the First Amendment interests at stake is harmful. The government should not be compelled, in the name of free speech, to put its heavy thumb on the scales and create a federally supported monopoly for commercial trademarks disparaging to minority groups in American society.

Invalidating the disparagement provision is overbroad in cases where no reclamation interest is asserted. And even when reclamation is raised, a more balanced approach is warranted. Tam's own mission highlights the dilemma. His goal of "reclamation" only makes sense because "slants" has a disparaging meaning in reference to Asian Americans *now*. Absent that current meaning, there would be no derogatory usage or connotation to reclaim and no progressive message to convey. Moreover, Tam's positive use of the term does not eliminate the potential harm flowing from its pejorative meaning.

The competing concerns are complicated, and a simplistic First Amendment analysis—focused only on the self-described expressive interest of the registrant—is neither adequate nor sufficient. Rather than facial invalidation, Tam's claims about reclamation, and other claims about expressive components of marks, can and should be weighed under a balanced disparagement analysis that also accounts for the harms caused by disparaging marks.

Amici leave it to the parties and other briefs to explain the specific doctrinal reasons for not opening the federal trademark registration system to slurs and derogatory marks. But one point bears emphasis and explains why a more balanced analysis is appropriate. Tam and other registrants should not be penalized because they seek to register a mark with an expressive component. But neither should their private expressive intent override the government's interest in not subsidizing disparaging marks, and not lending government resources to facilitate the commercial appropriation of slurs.

The private expressive goals of applicants—even if related to political issues—do not alter the essential commercial nature of trademarks. It is the latter that the Lanham Act is concerned with, regardless of the ancillary goals of individual applicants like Tam. While individual applicants may seek to use marks to express a message, they are not entitled to hijack the statute and turn the Lanham Act into a federal subsidy for private speech.[29]

---

29. *See Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 67-68 (1983) (reaffirming that advertising and promotional materials is permissibly regulated as "commercial speech" even if "they contain

A balanced approach also honors the real-world complexities presented by this case. Denying federal trademark registration on disparagement grounds is not a true restriction on speech in the ordinary sense. The applicant can still use any term (*e.g.*, "The Slants") as a common law mark for his band or any other product. The applicant can say anything he wants. His speech is not abridged. Any potential impact on individual expressive goals properly is "*incidental* to the primary congressional purpose" of promoting nationwide commerce without facilitating the use and appropriation of disparaging marks.[30]

The harm of authorizing disparaging marks by contrast are not incidental. A First Amendment analysis that ignores the ensuing harms would improperly give short shrift to what Justice Holmes famously called the "felt necessities of the time."[31] It pays insufficient heed to the importance of avoiding the impact of racial and ethnic disparagement in our society, and it fails to adequately assess the power that minority groups can achieve through reappropriation.

B. A More Nuanced Approach

Instead of striking down section 2(a) as unconstitutional, more tailored remedies are available to determine whether

---

discussions of important public issues" or otherwise "link[ ]a product to a current public debate.").

30. *See S.F. Arts and Athletics*, 483 U.S. at 536 (emphasis added).

31. Oliver Wendell Holmes, Jr., *The Common Law 15* (Paulo J.S. Pereira & Diego M. Beltran eds., University of Toronto Law School Typographic Society 2011)(1881)

a proposed mark is, in fact, disparaging.[32] This approach not only strikes the proper balance between the competing interests at stake, but it comports with the Court's principle of constitutional avoidance.[33]

Constitutional avoidance can be particularly valuable in the trademark context: "[b]ecause overextension of Lanham Act restrictions . . . might intrude on First Amendment values, [courts] must construe the Act narrowly to avoid such a conflict."[34] Indeed, courts have taken this tack in similar situations. For example, in *New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302 (9th Cir. 1992), the Ninth Circuit declined to grant broad First Amendment immunity from Lanham Act claims.[35] Instead, the Ninth Circuit crafted a new

---

32. Tam raised an as-applied challenge to the denial of his registration application below and has also suggested that this Court resolve the case on an as-applied basis.

33. *See Ariz. State Legislature v. Ariz. Independent Redistricting Comm'n*, 135 S. Ct. 2652, 2689 (2015) ("when 'a serious doubt of constitutionality is raised, it is a cardinal principle that this Court will first ascertain whether a construction of the statute is fairly possible by which the question may be avoided'" (citing *Crowell v. Benson*, 285 U.S. 22, 62 (1932)).

34. *See Rogers v. Grimaldi*, 875 F.2d 994, 998; *see also Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 322 (4th Cir. 2015) ("The canon of constitutional avoidance in this area [of the Lanham Act] is thus not a device of judicial evasion but an effort to reconcile the commercial values protected by the Lanham Act and the democratic value of expressive freedom.").

35. *New Kids*, 971 F.2d at 305 ("Indeed, where we are able to resolve the case on nonconstitutional grounds we ordinarily must avoid reaching the constitutional issue.").

fair use test, holding that a commercial user is entitled to a fair *nominative* use of a mark where "the only word reasonably available to describe a particular thing" is the trademarked term.[36]

Here, *amici* do not purport to set forth a specific test for the Court to adopt, they offer several factors that the Court should consider in formulating such a test. In proposing these factors, *amici* aim to identify considerations that will more objectively assess whether a mark is disparaging, and strike the correct balance in this context of promoting speech and protecting minority groups from discrimination.

These factors include: (1) whether the mark is part of a reclamation effort; (2) the potential harmful effects of the term, and (3) how expressive the mark is. These factors are not exclusive, and while they should not end the inquiry into whether a mark is disparaging, *amici* propose that they are a better start.[37]

1. Whether the Mark Is Part of Reclamation Efforts

Norms regarding racial and ethnic slurs are always in flux, and the law must account for reclamation concerns in

---

36. *New Kids on the Block*, 971 F. 2d at 308.

37. There is no question that case-specific application of these factors may be difficult. But that is no reason to discard the disparagement provision wholesale. "If adjudication is to be a rational process," Justice Frankfurter once said, "we cannot escape a candid examination of the conflicting claims with full recognition that both are supported by weighty title-deeds." *Dennis v. United States*, 341 U.S. 494, 519 (Frankfurter, J., concurring).

applying the disparagement provision. As Tam has pointed out, the Trademark Trial and Appeal Board (TTAB) has been inconsistent in its review of applications that include reclaimed terms.[38] Likely, this has to do with the difficult factual question that arises when the government—or anyone, for that matter—is trying to determine when a word has crossed over from disparaging to reclaimed. Many questions arise in this context: Can reclamation ever be truly successful? Who has standing to reclaim a word, and what kinds of inquiries, if any, should we make into a person's identity in this context? What if a word reclaimed by some members of a group is rejected by others? Can a word be both disparaging and reclaimed at the same time? These are difficult questions, but they do not warrant disposing of the disparagement inquiry altogether. To the contrary, they warrant serious consideration.

There are two ways in which we propose the Court should account for these difficult questions.

First, applicants should be allowed to submit evidence of reclamation in connection with their trademark applications, including evidence from linguists, sociologists, and other academics. Applicants could also submit community declarations of support for their mark. Giving applicants a chance to submit evidence of reclamation will ensure that the inquiry does not focus on the subjective intent of the applicant, but rather focuses on

38. Brief in Opp. at 31; *see also* Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(A) for the Lanham Act*, 106 Colum. L. Rev. 388 (Mar. 2006).

the use of the term in the relevant community.[39] Applicants should also be allowed to submit evidence of their own reclamation efforts with respect to the term they seek to trademark, though an applicant's individual efforts (or intent, for that matter) should not be dispositive. In this case, for example, Tam has a record replete with evidence of his work to reclaim the word "slants" through the expressive acts of his band over the past ten years.[40] But none of this information was ever considered by the PTO because it is not clearly part of the current disparagement analysis. Tam's expressive activity through his band should be considered, but it alone does not mean that the Asian American community has reclaimed the term. It is simply part of the larger body of evidence that should be considered.

Second, reclamation should only be considered as one factor of several in determining whether a mark is disparaging. If there is some minimal evidence of reclamation, but a mark is not used expressively and has a particularly pejorative history and meaning, then it may be rejected as disparaging. Reclamation should not open and close the inquiry, but it must be considered.

Thus, while some minority groups have successfully appropriated words like "gay" and "queer" previously considered disparaging, it cannot be the case that simply claiming reappropriation is enough to obtain trademark

---

39. This is precisely the sort of evidence that other applicants, such as the applicant for the DYKES ON BIKES mark have been able to submit. *See* Jessica M. Kiser, *How Dykes on Bikes Got It Right*, 46 U.S.F. L. Rev. 1, 2 (2011-2012).

40. Brief in Opp. at 3-4.

protection for an otherwise harmful and disparaging mark. Instead, this Court should adopt a test that looks holistically at whether the mark is being reclaimed, and the PTO should invite applicants to submit evidence of reclamation with their trademark applications.[41]

2. The history and potential harmful effects of the term

The collateral damage of encouraging widespread commercial use of offensive and derogatory marks also should not be ignored. Any analysis of whether to extend federal trademark protection to a disparaging term must therefore consider the potential effect of the mark on the target minority group.

Tam has urged the Court to consider his band name as part of the marketplace of ideas, but potential victims of broad dissemination of offensive marks (like children) often lack the resources to combat offensive and inflammatory trademarks. In today's climate, businesses are happy to engage in "shock marketing" tactics and cater to the lowest common denominator.[42] If the disparagement bar were removed, businesses could choose offensive brand names and marks—not for the

---

41. In this case, Lee did not initially submit evidence about the Asian American community's view of the term "slants" or provide material explaining if there was any movement (however nascent) to reclaim the term from its derogatory meaning, but he should have been given the opportunity to provide this additional information. J.A. 12-24; Pet. App. 168a-169a.

42. *See, e.g.*, Jonathan Long, *Welcome to the New Era of Viral Shock Marketing*, Huffington Post (Oct. 25, 2013), http://www.huffingtonpost.com/jonathan-long/welcome-to-the-new-era-of_b_4164671.html.

purpose of expression—but to capture attention and court controversy. While businesses may profit from these tactics, children and other members of minority groups would be left struggling to deal with and counteract the widespread use of slurs and other offensive words as a profit-driven marketing gimmick.

There can be no debate, at this point, that racial and ethnic slurs lead to harmful prejudice against minority groups.[43] Racial and ethnic slurs are not just words. They are words with consequences. And, in recent years, scientific literature has confirmed what many have long known: that discrimination—including through use of racial and ethnic slurs—is harmful to minority groups. Discrimination affects the mental and physical health of minority group members, as well as the ways in which a group functions within our society.[44]

---

43. This Court has a long history of relying on such information. *See, e.g. Brown v. Board of Educ.*, 347 U.S. 483, 494-95 (1954) (relying on social science research to demonstrate the harm caused by segregated schools); *see also Gratz v. Bollinger*, 539 U.S. 244, 299-300 (2003) (Ginsburg, J., dissenting) (looking to social science studies to illuminate the effect of discrimination on minority job and housing applicants); *Ballew v. Georgia*, 435 U.S. 223, 239 (1978) (holding that studies in the field of social psychology "lead [the Court] to conclude that the purpose and functioning of the jury in a criminal trial is seriously impaired, and to a constitutional degree, by a reduction in size to below six members"); *Jones v. Alfred H. Mayer Co.*, 392 U.S. 409, 428 (1968) (noting presence of comprehensive studies stressing prevalence of private hostility toward minorities and the need to protect these targeted groups from resulting discrimination in housing sales).

44. Hyung Chol Yoo; Gilbert C. Gee; D. Takeuchi, *Discrimination and health among Asian American immigrants: Disentangling racial from language discrimination.* 68(4) Soc. Sci. Med. *726*, 726-732 (2008) [hereinafter Yoo (2008)].

Many studies have confirmed the correlation between racial discrimination and mental health. The U.S. Department of Health and Human Services has acknowledged this effect, stating that "racial and ethnic minorities in the United States face a social and economic environment of inequality that includes greater exposure to racism and discrimination, violence, and poverty, all of which take a toll on mental health."[45] Experiencing discrimination can lead to an increased risk of stress and depressive symptoms.[46] There are also physical effects of discrimination on minority groups, including increased risk of the common cold, hypertension, cardiovascular disease, breast cancer, and mortality.[47] And worse yet, studies have shown that there are higher rates of suicide in ethnic groups referred to by slurs than in other immigrant groups.[48]

Moreover, there are social effects of discrimination among target groups. Ethnic groups referred to by more simplified and negative slurs are "more likely to be segregated into ethnic neighborhoods; more likely to be deemed suitable for hazardous work; less likely

---

45. U.S. Dep't of Health and Human Servs. (2001). Mental Health: Culture, Race and Ethnicity—A Supplement to Mental Health: A Report of the Surgeon General. (2001).

46. Jason Silverstein, *How Racism is Bad for Our Bodies*, The Atlantic (Mar. 12, 2013), http://www.theatlantic.com/health/archive/2013/03/how-racism-is-bad-for-our-bodies/273911/.

47. *Id.*

48. Brief of Psychology Professors as *Amicus Curiae* in Support of Petitioners, *Harjo v. Pro-Football, Inc.*, No. 09-326 (Oct. 16, 2009), at 12.

to become naturalized citizens; and more likely to be subjected to harsher immigration quotas . . . [and] were more likely to be portrayed to children in negative ways."[49] Stereotyping, as conveyed through ethnic slurs, also creates limiting expectations as to what group members can achieve. This reinforces the actions of individuals who meet expectations, but can have negative—and even retributive—consequences for those who do not.[50]

Slurs against Asian Americans are not exempt from the harms described above. There is an incorrect perception in this country that Asian Americans are less likely to be the target of racial discrimination and less likely to suffer as a result of it.[51] But, in fact, many Asian Americans still report experiencing discrimination and stereotyping.[52] Just weeks ago, a New York Times editor was walking on the Upper East Side of Manhattan when a woman yelled at him to "Go back to China" and "Go back to your fucking country."[53] His story prompted a deluge

---

49. *Id.* at 11-12.

50. *Id.* at 12.

51. Gilbert C. Gee, Annie Ro, Salma Shariff-Marco, David Chae, *Racial Discrimination and Health Among Asian Americans: Evidence, Assessment, and Directions for Future Research*, 31(1) Epidemiological Reviews 130, 130-151 (2009); *see also* Jennifer Wang, John Oliver Siy, Sapna Cheryan, *Racial Discrimination and Mental Health Among Asian American Youth*, in Asian American and Pacific Islander Children and Mental Health Volume 1 219, 219-242 (Frederick T.L. Leong, Linda Juang, Desiree Baolian Qin & Hiram E. Fitzgerald eds., 2013) [hereinafter Wang (2013)].

52. Wang (2013), 219-242.

53. Michael Luo, *An Open Letter to the Woman Who Told My Family to Go Back to China*, N.Y. Times (Oct. 9, 2016), http://

of responses and stories from other Asian-Americans who had experienced similar discrimination.[54] Also in October 2016, a German official of the European Union caused an uproar by referring to Chinese people as "slit-eyes."[55]

And as with other groups, there is a relationship between perceived racial discrimination and decreased health in Asian Americans. From a mental health perspective, a national study of Asian American adults found that "self-reported racial discrimination was associated with a greater likelihood of having any depressive or anxiety disorder within the past 12-month period, even after controlling for many factors such as accumulative stress, family cohesion, self-rated health,

---

www.nytimes.com/2016/10/10/nyregion/to-the-woman-who-told-my-family-to-go-back-to-china.html.

54. Michael Luo, *'Go Back to China': Readers Respond to Racist Insults Shouted at a New York Times Editor*, N.Y. Times Oct. 10, 2016; Louise Liu, *Asian-Americans share stories of racism after a New York Times editor was told to 'go back to China,'* Business Insider (Oct. 11, 2016), http://www.businessinsider.com/asian-racism-michael-luo-new-york-times-go-back-to-china-2016-10.

55. Melissa Eddy and James Kanter, *German E.U. Official Is in Trouble Over Remarks About Chinese*, N.Y. Times, (Oct. 31, 2016), http://www.nytimes.com/2016/11/01/world/europe/eu-official-insults-chinese.html?module=WatchingPortal&region=c-column-middle-span-region&pgType=Homepage&action=click&mediaId=thumb_square&state=standard&contentPlacement=9&version=internal&contentCollection=www.nytimes.com&contentId=http%3A%2F%2Fwww.nytimes.com%2F2016%2F11%2F01%2Fworld%2Feurope%2Feu-official-insults-chinese.html&eventName=Watching-article-click&_r=0.

and poverty."[56] Physically, racial discrimination is "associated with increased chronic conditions among Asian Americans even after accounting for age, sex, education, family income, health insurance, primary language, nativity status, and ethnicity."[57] For example, among Asian Americans, there is a relationship between perceived racial discrimination and increased risk of mental disorders and depressive symptoms, including a lowered sense of coherence, self-esteem, and satisfaction with life.[58]

No minority group is exempt from these harms. As a nation, we continue to battle against the use of hateful slurs to target and intimidate minority communities. Recent days have also seen a dramatic escalation in incidents of hate speech directed at Muslim and Sikh Americans, for example, with mosques and temples being vandalized with slurs such as "F*** Islam, go home."[59] Hateful vandalism also continues to be directed at African American churches and institutions.[60] Any analysis of whether a term is disparaging

---

56. Wang (2013), 227.

57. Yoo (2008), 731.

58. Yoo (2008), 727.

59. *See* Liam Stack, *Hate Crime Inquiry Opened Into Vandalism of Sikh Temple in California*, N.Y. Times (Dec. 9, 2015); Jordan Tidwell, *FBI Investigates Graffiti Vandalism at Two Fort Smith Mosques* (Oct. 20, 2016), *available at* http://5newsonline.com/2016/10/20/fbi-investigates-graffiti-vandalism-at-two-fort-smith-mosques-suspects-wanted/; Tim Padgett, *Another South Florida Mosque Vandalized; Anti-Muslim Hate Crimes Rising* (Nov. 3, 2016), available at http://wlrn.org/post/another-south-florida-mosque-vandalized-anti-muslim-hate-crimes-rising.

60. Sara Zendehnam, *North Highlands Church Vandalized in Apparent Hate Crime*, WLRN (June 5, 2016), http://wlrn.org/post/another-south-

must consider the harmful effects of encouraging commercial use of disparaging terms on other minority communities and the risks of promoting hateful speech.

3. The expressive context of the mark and requested use

This Court should also fashion a test that takes into account the requested use of the mark and expressive context in question. Logos, slogans, and other marks that more heavily incorporate expressive context should be stronger candidates for trademark protection than those that do not. Relatedly, the use of the mark matters.[61] Here, Tam sought to register "The Slants" in connection with planned live performances of his band.[62] Thus, not only does the mark sought identify an expressive activity: musical performance; the registered trademark would also be used in an artistic setting that would provide audience members (and other member of the public) with a comprehensive message-laden context (including the lyrics to the band's songs and the band's on-stage performance) to understand and appreciate the "wry" and "subversive" aspects of the mark that render it non-disparaging according to Tam.

---

florida-mosque-vandalized-anti-muslim-hate-crimes-rising ("Nig***" at predominantly African American church); Sarah Beth Hensley, *5 teens charged in historic Va. Schoolhouse vandalism*, WTOP (Oct. 20, 2016), http://wtop.com/loudoun-county/2016/10/5-teens-charged-in-historic-va-schoolhouse-vandalism/slide/1/ ("white power" at historic African American schoolhouse).

61. *See* 15 U.S.C. § 1112 (providing for the registration of trademarks based on class of planned use for goods or services).

62. J.A. 12-24.

The same context would likely be missing if "The Slants" were registered for a commercial product, like shoes or a beverage, without obvious artistic or expressive connection. The TTAB has recognized that use and context matter in connection with the *In re Heeb Media* registration application. There registration of HEEB was accepted as a mark for magazines, but was denied as a mark for non-magazine promotional materials such as T-shirts and mugs.[63] While "heeb" is a slang term for Hebrew with a long history of anti-Semitic use,[64] the context of the accepted mark, as the title of a magazine whose content was about, and offered for, the Jewish community, provided context for consumers to understand the non-disparaging "reclaimed" meaning of the mark. On T-shirts and other products, by contrast, the expressive context was absent and there were less cues to guard against understanding the term "heeb" in its customary, derogatory sense.

This Court has always afforded greater First Amendment protection to expressive speech compared to commercial speech.[65] Although, as argued above, the purpose of the Lanham Act is not to protect the First Amendment or to guarantee anyone the right to expression, factoring expressiveness into a disparagement analysis will help to correctly balance the First Amendment interests with the interests of minority groups.

---

63. *In re Heeb Media, LLC*, 89 U.S.P.Q.2d (BNA) 1071-72 (T.T.A.B. 2008).

64. *Id.* at 1071-73.

65. *See Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 562-63 (1980) ("The Constitution therefore accords a lesser protection to commercial speech than to other constitutionally guaranteed expression.").

CONCLUSION

For the foregoing reasons, the judgment of the court of appeals should be vacated and remanded for further proceedings.

Dated: November 14, 2016

Respectfully submitted,

CECELIA CHANG
ASIAN AMERICANS ADVANCING JUSTICE | AAJC
1620 L Street, Suite 1050
Washington, DC 20036
(202) 296-2300

DANIEL J. KORNSTEIN
Counsel of Record
ALANNA SMALL
EMERY CELLI BRINCKERHOFF & ABADY LLP
600 Fifth Avenue, 10th Floor
New York, New York 10020
(212) 763-5000
dkornstein@ecbalaw.com

Counsel for Amici Curiae

APPENDIX — LIST OF *AMICI CURIAE*

Rooted in the dreams of immigrants and inspired by the promise of opportunity, **Asian Americans Advancing Justice | AAJC (Advancing Justice | AAJC)** is a national nonprofit organization founded in 1991. Based in Washington D.C., Advancing Justice | AAJC works to advance civil and human rights for Asian Americans and to build and promote a fair and equitable society for all. Along with our Advancing Justice affiliates, Advancing Justice | AAJC works to promote justice and bring national and local constituencies together through community outreach, public policy advocacy, and litigation.

Asian Americans Advancing Justice – Atlanta (formerly Asian American Legal Advocacy Center or AALAC) is the first non-profit law center dedicated to Asian immigrants and refugees (Asian Americans) in the Southeast. The center's goal is to engage, educate and empower under-represented Asian Americans to greater civic participation. Asian Americans Advancing Justice – Atlanta is one of five independent organizations that make up the national Asian Americans Advancing Justice affiliation.

Asian Americans Advancing Justice – Chicago (AAAJ-Chicago) is a nonprofit organization that works to empower the Asian American community through advocacy, education, research, and coalition building. AAAJ – Chicago fights for laws and policies that promote social, economic, and political equity for the Asian American community as a whole.

Appendix

The **Asian Law Alliance (ALA)** is a non-profit law office founded in 1977 by law students from Santa Clara University School of Law. ALA's mission is to provide equal access to the justice system to Asian and Pacific Islanders and low income residents of Santa Clara County. ALA provides legal services in the areas of public benefits, civil rights, domestic violence, landlord and tenant law and immigration law.

Asian Pacific American Labor Alliance, AFL-CIO (APALA) is the first and only national organization of AAPI union members and allies to advance worker, immigrant, and civil rights. Backed by the AFL-CIO, APALA has 18 chapters and a national office in Washington, D.C. Since its founding in 1992, APALA has played a unique role in serving as the bridge between the broader labor movement and the AAPI community.

Asian Services In Action, Inc. (ASIA) is the largest Asian American & Pacific Islander (AAPI)-focused health and social service non-profit agency in the state of Ohio. For over 20 years, ASIA has taken on the most challenging tasks to help the underserved, low-income, refugee and immigrant communities. ASIA's mission is to empower and advocate for Asian Americans & Pacific Islanders (AAPIs); and to provide AAPIs and other communities with access to health and social services and culturally and linguistically appropriate information.

The Institute for Asian Pacific American Leadership & Advancement IAPALA was established in 2011 to build capacity through our chapters and partnerships

with local and national AAPI organizations. Alongside our sister organization APALA, IAPALA is working to ensure broader education, civic engagement, and capacity building for the AAPI community.

The **Laotian American National Alliance (LANA)** is the oldest and only national Laotian American non-partisan advocacy group in the United States. LANA's mission is to mobilize Laotian Americans by promoting social and economic advancement through civic participation and public policy advocacy. LANA advocates for social justice, civil rights, and equality for all multi-ethnic people from the community of Laos.

National Council of Asian Pacific Americans (NCAPA) is a coalition of thirty-five national Asian Pacific American organizations around the country. Based in Washington, D.C., NCAPA serves to represent the interests of the greater Asian American (AA) and Native Hawaiian Pacific Islander (NHPI) communities and to provide a national voice for the communities' concerns.

The **National Federation of Filipino American Associations (NaFFAA)** is an organization built upon ideals that seek to unite people with common goals, develop our current and future leaders, and advocate for issues that pertain to Filipinos and Filipino Americans. We are encouraged by the discourse of all parties involved that has resulted from this pending litigation. It has provided all those involved a chance to examine the facts, and the repercussions of the case. The result of the litigation would have implications across the broad spectrum of diversity

in the United States, including the Filipino American community. As such, NaFFAA would like to be included in the amicus brief.

OCA - Asian Pacific American Advocates (OCA) is a national, membership-driven organization dedicated to advancing the social, political, and economic wellbeing of Asian Pacific Americans. Through its 100 chapters and affiliates across the nation, OCA engages in policy advocacy, community organizing, and programming to advance the civil rights of Asian Pacific Americans, including the protection of our communities from disparaging racial comments.

The **Southeast Asia Resource Action Center (SEARAC)** is a national organization that advances the interests of Cambodian, Laotian, and Vietnamese American communities who came to this country as the largest group of refugees ever resettled in the U.S. Like many other immigrants and refugees, Southeast Asian Americans have been the target of racial slurs for decades, many with their origins in destructive U.S. foreign policies. Today our youth continued to be bullied and our communities targeted for our perceived racial and ethnic identities. In line with our commitment to fight for an equitable and just society for all immigrant communities, SEARAC joins its colleagues in this amicus brief in support of legal protections delineating the boundary between free speech and hate speech.

RECORD AND BRIEF

Supreme Court, U.S.
FILED
DEC 16 2016
OFFICE OF THE CLERK

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHAIO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF *AMICUS CURIAE* OF THE BECKET FUND FOR RELIGIOUS LIBERTY IN SUPPORT OF RESPONDENT

MARK L. RIENZI
Counsel of Record
ADÈLE AUXIER KEIM
THE BECKET FUND FOR RELIGIOUS LIBERTY
1200 New Hampshire Ave. N.W.
Suite 700
Washington, D.C. 20036
mrienzi@becketfund.org
(202) 955-0095

Counsel for Amicus Curiae

QUESTION PRESENTED

Whether the disparagement provision in 15 U.S.C. § 1052(a) is facially invalid under the Free Speech Clause of the First Amendment because it allows the government to refuse to protect speech it views as "disparaging" to beliefs, institutions, symbols, and persons.

TABLE OF CONTENTS

TABLE OF AUTHORITIES iii

INTEREST OF THE *AMICUS* 1

INTRODUCTION AND SUMMARY OF THE ARGUMENT 3

ARGUMENT 5

I. The "no disparagement" rule for religious speech is incompatible with true religious freedom 5

A. One person's blasphemy is another person's article of faith 5

B. Applied consistently, the "no disparagement" rule would restrict free religious discourse and force the government to adjudicate religious differences 6

II. The United States has rightly opposed "no disparagement" laws around the world 9

III. This Court should not endorse the notion that governments can withhold equal enforcement of the laws to punish disfavored speech 14

CONCLUSION 19

TABLE OF AUTHORITIES

Cases **Pages**

Cantwell v. *Connecticut*,
310 U.S. 296 (1940) 7

Pleasant Grove City, Utah v. *Summum*,
555 U.S. 460 (2009) 15

Pro-Football, Inc. v. *Blackhorse et al.*,
112 F. Supp. 3d 439 (E.D. Va. 2015)..... 16

Snyder v. *Phelps*,
131 S. Ct. 1207 (2011) 14, 18

W. Va. State Bd. of Educ. v. *Barnette*,
319 U.S. 624 (1943) 6

Walker v. *Texas Division, Sons of Confederate Veterans, Inc.*,
135 S. Ct. 2239 (2015) 14

Statutes

15 U.S.C. § 1052..... 4

18 U.S.C. § 241..... 17

18 U.S.C. § 245..... 17

18 U.S.C. § 247..... 17

18 U.S.C. § 249..... 17

42 U.S.C. § 3631..... 17

Other Authorities

G.A. Res. 217A, Universal Declaration of Human Rights art. 18 & 19 (Dec. 12, 1948) 4

International Covenant on Civil and Political Rights art. 19, Dec. 19, 1966, S. Exec. Doc. E, 95-2 (1978), 999 U.N.T.S. 171 4

H.R. Rep. No. 106-219, 21 (1999) 16

146 Cong. Rec. 16698 (2000) 16

The Becket Fund, Issues Brief Submitted to the U.N. Office of the High Commissioner for Human Rights, *Combating Defamation of Religions*, (June 2, 2008) 2

The Becket Fund, Moving Forward: Religious Defamation and Incitement Laws, Intervention at the Durban Review Conference, United Nations, Geneva (Apr. 23, 2009) 2-3

The Becket Fund, Racism and Religious Discrimination: Is the Concept of "Defamation of Religions" Productive?, Intervention at the Tenth Regular Session of the Human Rights Council, United Nations, Geneva (Mar. 24 2009) 2-3

The Becket Fund, Religious Land Use and Institutionalized Persons Act 16-17

The Becket Fund, Statement at the Second Regular Session of the Human Rights Council, United Nations, Geneva (Oct. 4 2006) 2

Richard Dawkins, *The God Delusion* (2008) 5

Dep't of Justice, Report on the Tenth Anniversary of the Religious Land Use and Institutionalized Persons Act (Sept. 22, 2010) 16

Five Men Sentenced to Death for Burning Christian Couple Alive, Christianity Today, Nov. 29, 2016 12-13

L. Bennett Graham, *Defamation of Religions: The End of Pluralism?*, 23 Emory Int'l L. Rev. 69 (2009) 1-2. 10

Brian Grim et al., *The Price of Freedom Denied: Religious Persecution and Conflict in the 21st Century* (2010) 12

Seamus Hasson, *The Right to Be Wrong* (2005) 9

Pew Research Center, *Trends in Global Restrictions on Religion*, Religion (June 23, 2016) 6

Letter from Eric C. Rassbach, Nat'l Dir. of Litig., The Becket Fund, to Bob Johnson, President Pro Tempore, Ark. Senate (Feb. 17, 2009) 2

Letter from Eric C. Rassbach, Nat'l Dir. of Litig., The Becket Fund, to Robbie Wills, Speaker of the House, Ark. House of Representatives (Feb. 17, 2009) 2

Rev. Thomas J. Reese, S.J. Chair, U.S. Comm'n on Int'l Religious Freedom, Testimony Before the Tom Lantos Human Rights Comm'n On Blasphemy Laws and Censorship by States and Non-State Actors: Examining Global Threats to Freedom of Expression (July 14, 2016) 12-13

Arsalan Suleman, Acting U.S. Special Envoy to the Org. of Islamic Cooperation, Senate Human Rights Caucus, Russell Senate Office Building, Washington, D.C. (May 26, 2016) 11-12

Asma T. Uddin, *Blasphemy Laws in Muslim Majority Countries*, The Review of Faith & Int'l Affairs, Summer 2011 ..... 1, 10, 13

Asma T. Uddin, *The Indonesian Blasphemy Act: A Legal and Social Analysis, in* Profane: Sacrilegious Expression in a Multicultural Age 223-48 (Christopher S. Grenda et al. eds., 2014) 1

Asma T. Uddin, *The UN Defamation of Religions Resolution and Domestic Blasphemy Laws: Creating a Culture of Impunity* (July 14, 2011) 1-2, 10

Trump: Some Indians 'extremely proud' of the Redskins, The Hill (Oct. 5, 2015) 16

U.S. Gov't Resp. to the U.N. Office of the High Comm'r for Human Rights Concerning Combating Defamation of Religions (Aug. 12, 2009) 11

INTEREST OF THE *AMICUS*[1]

The Becket Fund for Religious Liberty is a non-profit law firm that protects the free expression of all faiths. The Becket Fund has represented agnostics, Buddhists, Christians, Hindus, Jews, Muslims, Santeros, Sikhs, and Zoroastrians, among others, in lawsuits across the country and around the world. In addition to its work in U.S. courts, the Becket Fund also appears before international tribunals such as the European Court of Human Rights ("ECHR") and the United Nations Human Rights Committee, where the Becket Fund is a Non-Governmental Organisation in consultative status with the Economic and Social Council ("ECOSOC") of the United Nations.

The Becket Fund has long opposed laws restricting speech that is "insulting" or "disparaging" to religion. As the United States and the Becket Fund have argued together in the international context, depriving speech of legal protections because it is insulting or disparaging to a particular religion is dangerous, especially to people of minority faiths. Becket Fund lawyers have published scholarly works on blasphemy laws in other countries,[2] filed briefs opposing domestic

---

[1] No party's counsel authored any part of this brief. No person other than *Amicus Curiae* contributed money intended to fund the preparation or submission of this brief. All parties have consented to the filing of this brief, and letters indicating consent are on file with the Clerk.

[2] See, *e.g.*, Asma T. Uddin, The Indonesian Blasphemy Act: A Legal and Social Analysis, in *Profane: Sacrilegious Expression in a Multicultural Age* 223-48 (Christopher S. Grenda et al. eds., 2014); Asma T. Uddin, *Blasphemy Laws in Muslim Majority Countries*, The Review of Faith & Int'l Affairs, Summer 2011, at 1

blasphemy laws in Indonesia[3] and Australia,[4] sought to eliminate blasphemy laws still on the books in the United States,[5] and challenged resolutions condemning the "defamation of religions" in the United Nations General Assembly.[6]

[hereinafter Uddin, *Blasphemy Laws*]; Asma T. Uddin, *The UN Defamation of Religions Resolution and Domestic Blasphemy Laws: Creating a Culture of Impunity* (July 14, 2011), http://ssrn.com/abstract=1885770 [hereinafter Uddin, *Culture of Impunity*]; L. Bennett Graham, *Defamation of Religions: The End of Pluralism?*, 23 Emory Int'l L. Rev. 69 (2009).

[3] Amicus Brief of the Becket Fund, Request for Judicial Review of Act No. 1/PNPS/1965 on the Prevention of Mistreatment of Religion and/or Blasphemy under the 1945 Constitution of the Republic of Indonesia (No. 140/PUU-VII/2009) (filed Oct. 20, 2009), http://www.becketfund.org/wp-content/uploads/2012/02/Amicus-brief-to-the-Constitutional-Court-of-Indonesia-filed1.pdf.

[4] Legal Opinion of the Becket Fund, Catch the Fire Ministries Inc & Ors v Islamic Council of Vic Inc [2006] VSCA 284 (Court of Appeal) (Austl.).

[5] Letter from Eric C. Rassbach, Nat'l Dir. of Litig., The Becket Fund, to Robbie Wills, Speaker of the House, Ark. House of Representatives (Feb. 17, 2009), http://www.becketfund.org/wp-content/uploads/2013/09/02-17-09-Letter-to-Rep.-Robbie-Wills.pdf (urging legislature to eliminate anti-atheist provision); Letter from Eric C. Rassbach, Nat'l Dir. of Litig., The Becket Fund, to Bob Johnson, President Pro Tempore, Ark. Senate (Feb. 17, 2009), http://www.becketfund.org/wp-content/uploads/2013/09/02-17-09-Letter-to-Sen.-Bob-Johnson.pdf (same).

[6] See, *e.g.*, The Becket Fund, Statement at the Second Regular Session of the Human Rights Council, United Nations, Geneva (Oct. 4, 2006) (opposing resolution on "defamation of religions"); The Becket Fund, Issues Brief Submitted to the U.N. Office of the High Commissioner for Human Rights, *Combating Defamation of Religions* (June 2, 2008); The Becket Fund, Racism and Religious

The Becket Fund believes that accepting the government's arguments regarding "disparaging" speech in this case would undermine both our domestic tradition of broad and equal protection for religious speech, and the commendable and decades-long stand the United States has taken against blasphemy and anti-disparagement laws around the world.

INTRODUCTION AND SUMMARY OF THE ARGUMENT

This case is about whether the First Amendment allows the government to treat speech it finds "disparaging" worse than other kinds of speech. Citing the potential for trademarks that might disparage religious institutions or beliefs—for example, "demeaning illustrations of the prophet Mohammed and other religious figures"—the government argues that it merely wants to "disassociate itself from offensive communications." Gov't Br. at 10, 39. The government seeks First Amendment warrant for this action by claiming that its refusal to provide equal trademark protection is essentially a decision to "selectively fund a government program." Gov't Br. at 8.

The government's invocation of religious speech demonstrates why its argument should fail. Disagreements about deeply important issues such as religion can often be experienced as disparaging.

Discrimination: Is the Concept of "Defamation of Religions" Productive?, Intervention at the Tenth Regular Session of the Human Rights Council, United Nations, Geneva (Mar. 24, 2009); The Becket Fund, Moving Forward: Religious Defamation and Incitement Laws, Intervention at the Durban Review Conference, United Nations, Geneva (Apr. 23, 2009).

When Richard Dawkins calls belief in God a "delusion" and says that religion is not the root of "all" evil, he certainly disparages religious "institutions" and "beliefs" and "bring[s] them into contempt, or disrepute." 15 U.S.C. § 1052(a). And when Elwood Blues calls Sister Mary Stigmata a "fat penguin," he "disparages" not just her weight but also her religious habit. In both cases, it would be wrong for the government to punish speech simply because it wants to protect some religious "institutions" and "beliefs" from criticism.

In fact, to its credit, the United States has for many decades led the fight to convince other countries and international bodies to allow disparaging speech, and to resist using the law to punish those who disparage religion or commit blasphemy. Internationally, the United States' position sounds much more like the Federal Circuit's opinion than like its own brief in this case—overseas it argues that even disparaging speech should be protected, and only violent acts should be punished. Even when it is intended to protect vulnerable groups, empowering government to punish "disparaging" speech about religious ideas and institutions inevitably ends up privileging entrenched, powerful religious groups.

These universal principles[7] ought to be honored in their own country. The government should not be able to withhold the equal protection of trademark law (or any other law) from speech the government deems

---

[7] G.A. Res. 217A, Universal Declaration of Human Rights art. 18 & 19, at 71 (Dec. 12, 1948); International Covenant on Civil and Political Rights art. 19, Dec. 19, 1966, S. Exec. Doc. E, 95-2 (1978), 999 U.N.T.S. 171.

disparaging to particular beliefs and institutions. A decision from this Court embracing that kind of government power would endanger minority speech about religion and other issues. It would signal to state, local, and federal government actors that they have a newfound power to selectively withhold the use of a wide range of legal structures—such as deed registries, incorporation statutes, and copyright protection—based on government disapproval of speaker's message.

ARGUMENT

I. The "no disparagement" rule for religious speech is incompatible with true religious freedom.

A. One person's blasphemy is another person's article of faith.

Different people often make competing and irreconcilable claims about deeply important truths. Allowing citizens to freely exchange ideas on these subjects necessarily requires permitting speech that will sometimes be disparaging to competing groups and their religious beliefs and institutions.

For example, Richard Dawkins surely disparages people who believe in God when he calls their faith a "delusion." Richard Dawkins, *The God Delusion* (2008). And he likewise disparages Jews, Muslims, and Christians when he asserts that "the God of the Old Testament" is "a vindictive, bloodthirsty ethnic-cleanser" who is "misogynistic, homophobic, racist, infanticidal, genocidal, filicidal, pestilential, [and] megalomaniacal" all at once. Dawkins 51.

Even those who share a belief in God often disagree deeply about other matters. To take perhaps the most

prominent example, many Christians believe that Jesus of Nazareth was God incarnate; most Jews regard him as a merely human figure; Muslims typically hold that he was an inspired prophet; and some Unitarian Universalists view him as an example for moral living. Many Christians build their lives around the belief that Jesus rose from the dead; millions of others reject the resurrection as a myth. Embracing any one of these competing positions will often entail rejecting the others, and communicating that rejection to others. The historic American approach to deep religious difference has been to allow a robust marketplace of ideas to flourish without state interference. Far from creating a war of all against all, this approach has led to exceptionally low levels of social conflict over religion. See Pew Research Center, *Trends in Global Restrictions on Religion*, Religion (June 23, 2016), http://www.pewforum.org/2016/06/23/trends-in-global-restrictions-on-religion/.

B. Applied consistently, the "no disparagement" rule would restrict free religious discourse and force the government to adjudicate religious differences.

Deep religious disagreements often result in one side disparaging the religious beliefs and institutions of the other, sometimes in very harsh terms. But religious freedom and pluralism in a diverse society require allowing people to disagree about deeply important issues. After all, "freedom to differ is not limited to things that do not matter much" but includes "things that touch the heart of the existing order." *W. Va. State Bd. of Educ.* v. *Barnette*, 319 U.S. 624, 642 (1943). Indeed, many religious traditions

have sprung in part from the rejection of the "beliefs" and "institutions" of another. See, *e.g.*, Christian Scientists, Unitarian Universalists, Society of Friends (Quakers), and Bahá'í. Our courts have long recognized that allowing these differences is a prerequisite to pluralism:

> In the realm of religious faith, and in that of political belief, sharp differences arise. In both fields the tenets of one man may seem the rankest error to his neighbor. To persuade others to his own point of view, the pleader, as we know, at times resorts to exaggeration, to vilification of men who have been, or are, prominent in church or state, and even to false statement. But the people of this nation have ordained in the light of history, that, in spite of the probability of excesses and abuses, these liberties are, in the long view, essential to enlightened opinion and right conduct on the part of the citizens of a democracy.

Cantwell v. *Connecticut*, 310 U.S. 296, 310 (1940).

In this case, the government argues that the Patent and Trade Office ("PTO") should be able to exclude any mark that "disparage[s]" a "belief," an "institution" or "persons, living or dead," regardless of the mark's religious content. Gov't Br. at 10 (resisting the conclusion that the federal government should have to register "demeaning illustrations of the prophet Mohammed and other religious figures."). But, when it comes to religious marks, this policy will inevitably lead to government endorsement of a particular religious view. To take one example, the government cannot exclude marks that "disparage" Jesus without taking sides in a millennia-old theological debate over

who Jesus is. Is it disparaging to Jews to call Jesus the Messiah? To Catholics to deny he is the Son of God? To Muslims to say he is anything more (or less) than a prophet? Enforcing a no-disparagement rule in this context would force the government to either exclude all such statements or to pick one particular viewpoint to favor and protect as the truth while others are restricted as disparaging.

Such discrimination among viewpoints cannot be excused by claiming that denial of the legal protections that come with trademark registration is no burden. *Amici* the American Bar Association and the American Intellectual Property Law Association have both pointed out that excluding a mark from the federal trademark system can be "very harmful" and result in "significant disadvantages." ABA Amicus Br. at 19-20 (stating that the court below "may * * * have understated" the benefits of federal trademark registration and the "significant disadvantages" of exclusion from the federal system); AIPLA Amicus Br. at 7 ("[T]he PTO's refusal to register a trademark can be very harmful commercially.").

To date, the "no disparagement" rule appears to have been applied in an inconsistent—or even haphazard—way. AIPLA Amicus Br. at 11 (noting that the PTO denied registration to STOP THE ISLAMIZATION OF AMERICA, while granting registration to STOP THE ISLAMIZATION OF AMERICA in 2015); Resp. Br. at 57 (noting that the PTO "granted registration to HEEB in 2004 as the name of a magazine about Jewish culture, but refused registration *to the same applicant* for HEEB in 2008 as the name of a clothing line[.]") (emphasis added). But in this context, consistency is not necessarily a virtue. If the "no disparagement" rule

were applied consistently to religious marks, the PTO could do one of two things. First, it could decide to be the arbiter of which religious claims about disputed issues would be protected. In this scenario, the losing side would be excluded from the protection of federal trademark law, experiencing "substantial disadvantages" in protecting their marks and suffering harm to their interests. More than that, though, religious groups whose marks are left unprotected will know that the government had picked the winners and losers in these religious debates, and had left them unprotected. Or, second, the PTO could simply deny registration to anything that is remotely religiously controversial. In this scenario, the entire genre of religiously controversial potential trademarks would be off-limits for protection, thus creating an impression by the government that religion is like second hand smoke—too dangerous to protect by trademark. Compare Seamus Hasson, *The Right to Be Wrong* 5-6 (2005) (discussing the bureaucratic impulse to promote social peace by "[r]eplac[ing] all that messy [religious] competition with a wrinkle-free, synthetic, one-size-fits-all culture").

II. The United States has rightly opposed "no disparagement" laws around the world.

Ironically, when other nations have sought to withdraw legal protection from disparaging speech, the United States has been quick to oppose them. For 11 years, the Organisation of Islamic Cooperation (formerly the Organisation of the Islamic Conference) and others advocated for United Nations resolutions—both at the Human Rights Council and in the General

Assembly—condemning the "defamation of religions."[8] These resolutions were closely linked to domestic laws in Pakistan, Egypt, Indonesia, and elsewhere that criminalize speech that "insults" and "outrages" members of a religious group, and effectively withdraws the protection of the law from controversial religious speech. In Pakistan, for example, anti-blasphemy laws have long been used against religious minorities such as in the infamous case of Asia Bibi, an illiterate woman sentenced to death for allegedly insulting the Prophet Mohammed. See Uddin, *Blasphemy Laws* at 1; see also Uddin, *Culture of Impunity*.

The United States, along with the Becket Fund and many other civil society groups, strongly resisted these misguided resolutions. The United States has urged other countries to focus on combating discriminatory and criminal *acts* while protecting hateful *speech*, has emphasized that the U.S. government protects even hateful speech through its court system, and has pointed out that laws against "defaming," "blaspheming," or "insulting" *religion* inevitably draw the government into taking sides on religious questions.[9] In short, when engaging in international diplomacy, the United States sounds much more like

---

[8] For a detailed history of these resolutions, see Graham, 23 Emory Int'l L. Rev. 69.

[9] It is easy to see why this is so. Defamation laws typically protect individuals from public slander or libel that would negatively affect their livelihood. The traditional defense is the truth. But when someone says something that allegedly defames a religion, the government cannot assess truthfulness without deciding which religious claim is true.

the Federal Circuit's opinion than its own brief in this case.

For example: In 2009, the United States told the United Nations Office of the High Commissioner for Human Rights that the "best way" to combat disparaging statements about religions and religious groups "is to develop effective legal regimes to address *acts* of discrimination and bias-inspired *crime*" while "vigorously defend[ing] the rights of individuals to practice their religion freely and exercise their freedom of expression."[10] The United States has also emphasized the ways that the American government protects controversial speech, stating that "U.S. courts have upheld the rights of Neo-Nazis, holocaust deniers, and white supremacist groups to march in public, distribute literature, and attempt to convince others of their cause." *Ibid.* And earlier this year, Arsalan Suleman, Acting U.S. Special Envoy to the Organisation of Islamic Cooperation, told the Senate Human Rights Caucus that "[b]lasphemy laws empower the state to be the arbiter of religious truth or orthodoxy, which almost always reflects the views of the majority. When enforced, the end result is that individuals with different beliefs are prevented from fully expressing or carrying out their peaceful religious practice."[11]

---

[10] U.S. Gov't Resp. to the U.N. Office of the High Comm'r for Human Rights Concerning Combating Defamation of Religions (Aug. 12, 2009), http://www.state.gov/documents/organization/153526.pdf (emphasis added).

[11] Arsalan Suleman, Acting U.S. Special Envoy to the Org. of Islamic Cooperation, Senate Human Rights Caucus, Russell

The danger from government-enforced prohibitions on disparagement or blasphemy is real. As U.S. officials have acknowledged, social science research shows that "countries with the most restrictions on the exercise of religious freedom, including blasphemy laws, also have the highest level of religious hostilities." *Ibid.*; see generally Brian Grim et al., *The Price of Freedom Denied: Religious Persecution and Conflict in the 21st Century* (2010). Rev. Thomas Reese, S.J., Chair of the U.S. Commission on International Religious Freedom has explained that this is because "[b]lasphemy laws are used disproportionately against religious minorities or dissenting members of the majority community" and are therefore "ripe for abuse."[12]

Examples abound. In November 2014, a Christian couple in Pakistan was beaten and thrown into a brick kiln after the wife was accused of burning pages from the Koran.[13] Police at the scene failed to protect them

---

Senate Office Building, Washington, D.C. (May 26, 2016), http://www.state.gov/s/rga/rls/remarks/257830.htm.

[12] Rev. Thomas J. Reese, S.J. Chair, U.S. Comm'n on Int'l Religious Freedom, Testimony Before the Tom Lantos Human Rights Comm'n On Blasphemy Laws and Censorship by States and Non-State Actors: Examining Global Threats to Freedom of Expression, 2 (July 14, 2016), https://www.uscirf.gov/sites/default/files/Testimony.Chair%20Thomas%20J%20Reese.pdf (Reese Statement).

[13] In an unusual move, Pakistan's anti-terrorism court later sentenced five of the men who killed the couple to death. *Five Men Sentenced to Death for Burning Christian Couple Alive*, Christianity Today, Nov. 29, 2016, http://www.christianitytoday.com/gleanings/2016/november/pakistan-death-sentence-burning-christian-couple-alive.html.

and the couple burned to death, orphaning their three children. *Ibid.* In perhaps the most well-known example, Asia Bibi was sentenced to death in Pakistan for allegedly insulting the Prophet Mohammed during an argument over a drink of water. Uddin, *Blasphemy Laws* at 1. She is still in prison today. Reese Statement, 5-6.

Less publicized—but more common—is the use of blasphemy laws to punish voices advocating for change within their own religious tradition. Uddin, *Blasphemy Laws* at 4-5. In 2007, Egypt's blasphemy law was used to convict and imprison Abdel Karim Suleiman, a 22-year-old Sunni Muslim college student who criticized Sunni institution Al-Azhar University on his blog. *Ibid.* Indonesia criminally prosecuted followers of the religious group Sion City of Allah for deviating from "correct Christian teachings"—even though other Indonesian Christian groups asked the government not to do so. *Id.* at 3-4. And in Egypt, laws against blasphemy have been used by Sunni Muslim officials to prosecute Shi'a Muslims for their "deviant" beliefs. *Id.* at 4.

These types of laws use the claimed disparaging nature of religious speech to deprive people of equal protection of the law in the most basic sense—the law will not protect them when they are accused of engaging in disfavored speech. Experience has shown that laws against "insulting" speech are used to target religious minorities and to punish religious reformers. The United States is right to oppose such laws abroad and wrong to leave "disparaging" speech unprotected in this case.

III. This Court should not endorse the notion that governments can withhold equal enforcement of the laws to punish disfavored speech.

To be sure, the government does not think its no-disparagement rule is akin to laws banning blasphemy. Indeed, it repeatedly emphasizes that it has not banned Simon Tam from using his band name. U.S. Br. at 20-21, 25, 26. But the government still seeks for itself the power to determine which speech receives which protections depending on whether ideas or institutions are disparaged.

Although it is a core First Amendment principle that even offensive speech must be protected, see *Snyder* v. *Phelps*, 131 S. Ct. 1207 (2011), the government tries to sidestep the First Amendment because it maintains the list of trademarks and verifies which marks are on the list. Gov't Br. at 10. The government relies heavily on the government speech case *Walker* v. *Texas Division, Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015), mentioning it more than 25 times. But *Walker* involved a dispute over who controlled words and images on a state license plate that this Court analogized to a "government ID." 135 S. C. at 2249. Here, by contrast, the closest analogues are the copyright system or a registry of deeds, where the government's system is designed to protect private property. See Pet. App. 47a (concluding that the government acts similarly when it "issues permits for street parades, copyright registration certificates, or, for that matter, grants medical, hunting, fishing, or drivers licenses, or records property titles, birth certificates, or articles of incorporation.").

The government's reliance on the government speech principles set out in *Pleasant Grove City, Utah* v. *Summum*, 555 U.S. 460 (2009) is equally unavailing. Gov't Br. at 18-19. In *Summum*, the Court noted an important exception to the government speech rule: "if a town created a monument on which all of its residents (or all those meeting some other criterion) could place the name of a person to be honored or some other private message," then the government speech rule would not apply. 555 U.S. at 480. The situation here is more like the exception in *Summum* than the rule laid down in *Walker*. By maintaining a registry of federally recognized trademarks, the government is not putting an imprimatur on every phrase recorded by the PTO.

Moreover, if *Walker* controlled rather than the exception in *Summum*, the government could exclude written works from the copyright system based on their religious content, or refuse to register deeds for buildings owned by religious groups who advocate for positions the government does not like. And since the government's religious preferences may change from election to election, the result could be intellectual and real property rights that come and go depending on which party is in power.

This is not a hypothetical concern. We know that the "no disparagement" rule can lead to such flip-flopping of property rights because that is the actual result of the government's position in the related case concerning the Washington Redskins. There, the Redskins mark was protected by the Johnson Administration in 1967, lost protection as a "disparaging" mark under President Obama's Administration in 2014, and may well regain

protection under President-elect Trump's administration.[14] This type of unpredictability would defeat the very purpose of the trademark, copyright, and deed registry systems, which exist to bring stability and to reduce conflicting claims.

Religious groups have already faced similar problems in the land-use context. As Congress found when it passed the Religious Land Use and Institutionalized Persons Act (RLUIPA) in 2000, "religious institutions [are] often treated worse in zoning decisions than comparable secular institutions," and this discrimination "most often impact[s] minority faiths and newer, smaller, or unfamiliar denominations."[15] Indeed, at the time that RLUIPA was passed, "faith groups whose members constitute only nine percent of the population made up 50 percent of reported court cases involving zoning disputes." *Ibid.* (citing H.R. Rep. No. 106-219, 21 (1999); 146 Cong. Rec. 16698 (2000) (Joint Statement of Senators Hatch and Kennedy). The Becket Fund has represented dozens of clients—Muslims, Jews, Christians, and others—in land use disputes like

---

[14] *Pro-Football, Inc.* v. *Blackhorse et al.*, 112 F. Supp. 3d 439 (E.D. Va. 2015) (noting loss of registration); *Trump: Some Indians 'extremely proud' of the Redskins*, The Hill, (Oct. 5, 2015), http://thehill.com/blogs/blog-briefing-room/news/255918-trump-some-indians-extremely-proud-of-the-redskins.

[15] Dep't of Justice, Report on the Tenth Anniversary of the Religious Land Use and Institutionalized Persons Act (Sept. 22, 2010) at 3, https://www.justice.gov/sites/default/files/crt/legacy/2010/12/15/rluipa_report_092210.pdf.

these.[16] Very often, minority religious groups encounter government officials who have decided in advance that members of the faith group before them pose a special threat and deserve additional scrutiny.

Religious trademarks are not immune from these dynamics and, as with land use, minority religious groups are likely to be particularly vulnerable. If this Court were to endorse the government's view that it can pick and choose whom to protect in the trademark area because it registers marks and acknowledges them to others, state and local governments across the country could do the same. The result would be government officials using their deed registries; license-granting functions for professions, marriages, and sports; and incorporation statutes to make judgments about what speech and speakers are worthy or unworthy of protection.

In its defense, the government points to some of the most offensive categories of speech—including marks by white supremacists and racist groups that have a history of terrorizing racial minorities, especially African-Americans. But, as Mr. Tam has explained, the disparaging marks law was not enacted to address the threats posed by such groups, and the federal government has far more effective tools to combat them. Resp. Br. at 48-49; see generally Department of Justice, Hate Crime Laws, https://www.justice.gov/crt/hate-crime-laws (visited Dec. 15, 2016) (discussing 18 U.S.C. § 241, 18 U.S.C. § 245, 18 U.S.C. § 247, 18 U.S.C. § 249, and 42 U.S.C. § 3631). Furthermore,

---

[16] The Becket Fund, Religious Land Use and Institutionalized Persons Act, http://www.becketfund.org/rluipa/#cases (last visited Dec. 15, 2016).

given that the First Amendment protects so many other public derogatory statements, see *Snyder*, 131 S. Ct. 1207, it is difficult to believe that the threat would grow based on the PTO's allowing or disallowing a particular trademark.

Ultimately, the disparagement rule is a holdover from an era in which commercial speech enjoyed little to no First Amendment protection, and during which our First Amendment case law was in its early stages. Resp. Br. at 48-49 (noting that the rule was first proposed in 1939). The best that can be said of it is that it has been inconsistently enforced, and that many arguably disparaging marks have in practice been registered. See Pet. App. 7a-8a. Striking down the disparagement rule would bring trademark law in line with the rest of this Court's First Amendment jurisprudence.

Upholding the disparagement rule, however, would likely have worse and more far-reaching consequences for the First Amendment. Empowering federal, state, and local governments to withhold legal protections based on the content of speech would needlessly subject minority speech and religious rights to the whims of majority governments and the bureaucrats who staff them. Governments will be emboldened to explain how they too should be able to favor or disfavor certain speakers and institutions by granting or withholding basic legal protections.

In short, it is dangerous to allow the government at any level to withhold equal protection of the law based on the content of someone's speech or religion and to pretend such discrimination is a permissible decision about how to "selectively fund a government program." Gov't Br. at 8.

CONCLUSION

The Court should affirm the decision below.

Respectfully submitted.

MARK L. RIENZI
Counsel of Record
ADÈLE AUXIER KEIM
THE BECKET FUND FOR
RELIGIOUS LIBERTY
1200 New Hampshire Ave. N.W.
Suite 700
Washington, D.C. 20036
mrienzi@becketfund.org
(202) 955-0095

Counsel for Amicus Curiae

DECEMBER 2016

RECORD AND BRIEFS

No. 15-1293

IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,
Petitioner,

v.

SIMON SHIAO TAM,
Respondent,

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF FOR AMANDA BLACKHORSE, MARCUS BRIGGS-CLOUD, PHILLIP GOVER, JILLIAN PAPPAN AND COURTNEY TSOTIGH AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

ADAM G. YOFFIE
DRINKER BIDDLE & REATH LLP
105 College Road East
Princeton, NJ 08542
(609) 716-6500

JESSE A. WITTEN
Counsel of Record
TORE T. DEBELLA
PATRICK H. THOMPSON
DRINKER BIDDLE & REATH LLP
1500 K Street NW
Washington, DC 20005
(202) 842-8800
Jesse.Witten@dbr.com

Counsel for Amici Curiae

QUESTIONS PRESENTED

Section 2(a) of the Lanham Act provides that a mark is not eligible for federal registration if it "[c]onsists of or comprises . . . matter which may disparage . . . persons, living or dead . . . or bring them into contempt, or disrepute." 15 U.S.C. § 1052(a).

1. Does the disparagement provision of Section 2(a) violate the First Amendment?

2. Is the disparagement provision void for vagueness under the Due Process Clause?

3. Should the disparagement provision be interpreted according to its plain language?*

---

* The Government's Petition for a Writ of Certiorari presented the first question. Respondent Simon Tam's Opposition raised the latter two questions.

TABLE OF CONTENTS

QUESTIONS PRESENTED i

TABLE OF AUTHORITIES v

INTEREST OF THE *AMICI* 1

INTRODUCTION 2

A. Trademark And Service Mark Registration Process. 2

B. The Owner Of An Unregistrable Mark Has Statutory And Common Law Enforcement Rights 4

SUMMARY OF ARGUMENT 6

ARGUMENT 9

I. THE DISPARAGEMENT PROVISION DOES NOT VIOLATE THE FIRST AMENDMENT 9

A. Tam's First Amendment Rights Were Not Affected 9

1. Refusal To Register A Mark May Affect The Owner's Ability To Enjoin Others From Speaking, But The Right To Silence Others Is Not A First Amendment Right 9

2. Many Federal Trademark And Similar Laws Discriminate On The Basis Of Content And Would Fall If The Disparagement Provision Is Held Unconstitutional 15

3. Unregistrable Marks Are Enforceable. Their Owners Are Fully Capable Of Silencing Others..... 18

B. Refusing To Register A Mark Is An Example Of Government Speech 19

1. A USPTO Registration Certificate And The Principal Register Are Government Documents 20

2. Trademark Registrations Are Government Speech 23

II. THE DISPARAGEMENT PROVISION IS NOT VOID FOR VAGUENESS 26

A. The Standard Of Review Is Lenient Because Section 2(a) Of The Lanham Act Does Not Make Any Conduct Unlawful 26

B. The Term "May Disparage" Is Not Unconstitutionally Vague 27

1. The Disparagement Provision Gives Fair Warning 28

2. The Disparagement Provision Does Not Authorize Arbitrary And Discriminatory Enforcement 31

III. SECTION 2(A) SHOULD BE INTERPRETED ACCORDING TO ITS PLAIN MEANING 35

A. The Inclusion Of "May" In "May Disparage" Means That Proof Of Actual Disparagement Is Not Required For A Mark To Be Unregistrable 35

B. Intent To Disparage Is Not Required 37

C. Evidence Of A "Substantial Composite" Is One Way To Demonstrate That A Mark Contains Matter That "May Disparage," But Is Not The Only Way 38

CONCLUSION 41

TABLE OF AUTHORITIES

Page(s)

CASES

Accuride Int'l, Inc. v. Accuride Corp.,
871 F.2d 1531 (9th Cir. 1989).....5
Am. Legion v. Matthew,
144 F.3d 498 (7th Cir. 1998).....17
Anheuser-Busch, Inc. v. Balducci Publ'ns,
28 F.3d 769 (8th Cir. 1994).....10
B&B Hardware, Inc. v. Hargis Indus.,
135 S. Ct. 1293 (2015).....2, 19
Brother Records, Inc. v. Jardine,
318 F.3d 900 (9th Cir. 2003).....10
City of Chicago v. Morales,
527 U.S. 41 (1999).....27, 28
In re City of Houston,
731 F.3d 1326 (Fed. Cir. 2013).....4
Doe v. Chao,
540 U.S. 614 (2004).....36
F.T.C. v. Wyndham Worldwide Corp.,
799 F.3d 236 (3d Cir. 2015).....26, 27
FCC v. Fox TV Stations, Inc.,
132 S. Ct. 2307 (2012).....27
Flowers v. State,
220 S.W.3d 919 (Tex. Crim. App. 2007).....39
FTC v. Morton Salt Co.,
334 U.S. 37 (1948).....36
In re Geller,
751 F.3d 1355 (Fed. Cir. 2014).....38, 39
George Nelson Found. v. Modernica,
12 F. Supp. 3d 635 (S.D.N.Y. 2014).....9

Golan v. Holder,
132 S. Ct. 873 (2012).....14
Grayned v. City of Rockford,
408 U.S. 104 (1972).....26, 27
Herbko Int'l, Inc. v. Kappa Books, Inc.,
308 F.3d 1156 (Fed. Cir. 2002).....4, 5
Hershey's Co. v. Art Van Furniture, Inc.,
2008 WL 4724756 (E.D. Mich. Oct.
24, 2008).....10
Hill v. Colorado,
530 U.S. 703 (2000).....28
Hoffman Estates v. The Flipside,
Hoffman Estates, Inc.,
455 U.S. 489 (1982).....26, 27, 34
Holder v. Humanitarian Law Project,
561 U.S. 1 (2010).....34
Johanns v. Livestock Mktg. Assn.,
544 U.S. 550 (2005).....19
Johnson v. United States,
135 S. Ct. 2551 (2015).....34
The Last Best Beef, LLC v. Dudas,
506 F.3d 333 (4th Cir. 2007).....16
Leidersdorf v. Flint,
7 N.W. 252 (Wis. 1880).....5
Marsh v. Chambers,
463 U.S. 783 (1983).....8, 29
In re Mavety Media Grp., Ltd.,
33 F.3d 1367 (Fed. Cir. 1994).....40
McCann v. Anthony,
21 Mo. App. 83 (1886).....5
In re McGinley,
660 F.2d 481 (C.C.P.A. 1981).....40
Mitchell Bros. Film Grp. v. Cinema Adult Theater,
604 F.2d 852 (5th Cir. 1979).....15

Nat'l Endowment for the Arts v. Finley,
524 U.S. 569 (1998).....6, 13, 27, 30
Negusie v. Holder,
555 U.S. 511 (2009).....38
New Kids on the Block v. News Am. Publ'g, Inc.,
971 F.2d 302 (9th Cir. 1992).....11
Park 'N Fly v. Dollar Park & Fly, Inc.,
469 U.S. 189 (1985).....24
Pleasant Grove City v. Summum,
555 U.S. 460 (2009).....6, 13, 19
Pro-Football, Inc. v. Blackhorse,
112 F. Supp. 3d 439 (E.D. Va. 2015).....1, 34, 37
Radiance Found., Inc. v. NAACP,
25 F. Supp. 3d 865 (E.D. Va. 2014).....11
Reed Elsevier, Inc. v. Muchnik,
559 U.S. 154 (2010).....18, 19
Ridley v. Massachusetts Bay Transp. Auth.,
390 F.3d 65 (1st Cir. 2004).....30
Rubin v. City of Lancaster,
710 F.3d 1087 (9th Cir. 2013).....29
San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.,
483 U.S. 522 (1987).....10, 11, 16, 17
Simpson v. Chesterfield Cty. Bd. of Supervisors,
404 F.3d 276 (4th Cir. 2005).....29, 30
Starbucks Corp. v. Wolfe's Borough Coffee, Inc.,
736 F.3d 198 (2d Cir. 2013).....11
Sugar Busters LLC v. Brennan,
177 F.3d 258 (5th Cir. 1999).....5
In re Tam,
785 F.3d 567 (Fed. Cir. 2015).....39
In re Tam,
808 F.3d 1321 (Fed. Cir. 2015) (en banc)....*passim*

Town of Greece v. Galloway,
134 S. Ct. 1811 (2014).....29
Two Pesos, Inc. v. Taco Cabana, Inc.,
505 U.S. 763 (1992).....5
United States v. Arias-Espinosa,
704 F.3d 616 (9th Cir. 2012).....36
United States v. Lexington Mill & Elevator Co.,
232 U.S. 399 (1914).....36
United States v. Mead,
533 U.S. 218 (2001).....33
United States v. Williams,
553 U.S. 285 (2008).....26
Wag More Dogs, LLC v. Cozart,
680 F.3d 359 (4th Cir. 2012).....28
Walker v. Texas Div., Sons of Confederate Veterans, Inc.,
135 S. Ct. 2239 (2015).....*passim*
Ward v. Rock Against Racism,
491 U.S. 781 (1989).....28
Welch v. United States,
136 S. Ct. 1257 (2016).....34
Wrenn v. Boy Scouts of Am.,
2008 WL 4792683 (N.D. Cal. Oct. 28, 2008).....17

DOCKETED CASES

Pro-Football, Inc. v. Blackhorse, appeal docketed, No. 15-1874 (4th Cir. Aug. 6, 2015).....1, 2

TRADEMARK TRIAL AND APPEAL BOARD DECISIONS

Blackhorse v. Pro-Football, Inc.,
111 U.S.P.Q.2d 1080 (T.T.A.B. 2014).....*passim*
Harjo v. Pro-Football, Inc.,
50 U.S.P.Q.2d 1705 (T.T.A.B. 1999).....28, 40
In re Heeb Media, LLC,
89 U.S.P.Q.2d 1071 (T.T.A.B. 2008).....39
In re Lebanese Arak Corp.,
94 U.S.P.Q.2d 1215 (T.T.A.B. 2010).....35
In re Squaw Valley Dev. Corp.,
80 U.S.P.Q.2d 1264 (T.T.A.B. 2006).....33
In re Tam,
108 U.S.P.Q.2d 1305 (T.T.A.B. 2013).....38

CONSTITUTIONAL PROVISIONS

U.S. Const., art. 1, § 8, cl. 8 15
U.S. Const. amend. I .....*passim*

LEGISLATIVE MATERIAL

H.R. Rep. No. 2283 (1942) 36
Hearings on H.R. 82 Before the House Comm. on Patents, 78th Cong., 1st Sess. (1943) 36
Hearings on H.R. 82 Before the Subcomm. of the Senate Comm. on Patents, 78th Cong., 2d Sess. (1944).....36
Hearings on H.R. 102, H.R. 5461, S. 895, Before the Subcomm. on Trademarks of the House Comm. on Patents, 77th Cong., 1st Sess. (1941).....36

Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong., 1st Sess. (1939) 36

STATUTES, RULES & REGULATIONS

15 U.S.C. § 1051 ..... 2, 3
15 U.S.C. § 1052 ..... *passim*
15 U.S.C. § 1053 3
15 U.S.C. § 1057 3
15 U.S.C. § 1057(a) 20
15 U.S.C. § 1057(b) 23
15 U.S.C. § 1062 3
15 U.S.C. § 1063 3
15 U.S.C. § 1067(b) 31
15 U.S.C. § 1070 ..... 3, 4, 33
15 U.S.C. § 1071(b) 1
15 U.S.C. § 1125(a) 4, 7, 18
15 U.S.C. § 1127 2
17 U.S.C. § 411(a) 18
36 U.S.C. § 20907 17
36 U.S.C. § 21702 17
36 U.S.C. § 21705 17
36 U.S.C. § 21904 17
36 U.S.C. § 22306 17
36 U.S.C. § 22505 17
36 U.S.C. § 22706 17
36 U.S.C. § 30106 17
36 U.S.C. § 30306 17
36 U.S.C. § 30507 17
36 U.S.C. § 30706 17
36 U.S.C. § 30905 16
36 U.S.C. § 40306 ..... 16, 17

36 U.S.C. § 50305 17
36 U.S.C. § 70506 17
36 U.S.C. § 70902 17
36 U.S.C. § 70907 17
36 U.S.C. § 80305 16
36 U.S.C. § 140304 17
36 U.S.C. § 150707 17
36 U.S.C. § 152306 18
36 U.S.C. § 152506 18
36 U.S.C. § 152907 18
36 U.S.C. § 153104 18
36 U.S.C. § 153506 18
36 U.S.C. § 153706 18
36 U.S.C. § 154106 18
36 U.S.C. § 154707 18
36 U.S.C. § 170105 18
36 U.S.C. § 170307 18
36 U.S.C. § 190106 18
36 U.S.C. § 190307 18
36 U.S.C. § 200306 18
36 U.S.C. § 220306 18
37 C.F.R. § 2.61 3
37 C.F.R. § 2.80 3
37 C.F.R. § 2.129(a) 32
37 C.F.R. § 2.142(e)(1) 32
37 C.F.R. § 2.151 3
Fed. R. Evid. 401 39

OTHER AUTHORITIES

41 U.S. Op. Atty. Gen. 395 (U.S.A.G. Dec. 18, 1958) 15

Amicus Brief for Blackhorse, et. al., *In re Tam*, No. 14-1203 (Fed. Cir. July 23, 2015), ECF No. 148 22

Esha Bandari, *'You're Not Wrong, You're Just an A**hole,'* ACLU Blog of Rights (Mar. 6, 2015, 12:30 PM), https://www.aclu.org/blog/free-speech/youre-not-wrong-youre-just-ahole 12

New "Standard" Dictionary of the English Language, Funk and Wagnalls Company (1947) 29

Memorandum in Support of Motion for Summary Judgment on Constitutional Claims, *Pro-Football, Inc. v. Blackhorse*, No. 14-cv-01043 (E.D. Va. Feb. 23, 2015), ECF No. 56 29

Kimberly A. Pace, *The Washington Redskins Case and The Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 Pepp. L. Rev. 7, 33 (1994) 37

USPTO, *Trademark Manual of Examining Procedure* (Oct. 2016) 31, 32, 40

Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After* Eldred, 44 Liquormart, and Bartnicki, 40 Hous. L. Rev. 697 (2003) 11, 12

Webster's New International Dictionary, G. & C. Merriam Company (2nd ed. 1947) 28, 29

INTEREST OF THE *AMICI*[1]

Amici curiae Amanda Blackhorse, Marcus Briggs-Cloud, Phillip Gover, Jillian Pappan, and Courtney Tsotigh are Native American individuals who successfully petitioned the Trademark Trial and Appeal Board ("TTAB") to cancel six service mark registrations of the Washington NFL football team. The TTAB found that the team's marks were ineligible for registration under Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), and thus subject to cancellation, because they contain matter that may disparage Native Americans (*i.e.*, the term "redskin" or a derivation of "redskin"). *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 (T.T.A.B. 2014).

The team's owner, Pro Football, Inc. ("PFI"), brought an action in the Eastern District of Virginia, under 15 U.S.C. § 1071(b), to overturn the TTAB's decision. The District Court granted summary judgment in favor of Blackhorse and the other *amici*, agreeing with the TTAB that PFI's marks were ineligible for registration. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 467 (E.D. Va. 2015). The Court also rejected PFI's Constitutional arguments. *See id.* at 454-464.

PFI appealed and its appeal is pending. *Pro-Football, Inc. v. Blackhorse, appeal docketed*, No. 15-

---

[1] Petitioner's letter consenting to the filing of this brief, and Respondent's letter consenting to the filing of *amicus* briefs, are on file with the Clerk's office. No party or counsel for a party has authored this brief in whole or in part, and no person or entity other than *amici* and their counsel has made a financial contribution to its preparation or submission.

1874 (4th Cir. Aug. 6, 2015). PFI petitioned this Court for a writ of certiorari before judgment, which was denied.

Amici have an interest in ensuring that the United States Patent and Trademark Office ("USPTO") properly implements Section 2(a) so that they can avoid further insult resulting from the registration of marks that disparage them and other Native Americans.

INTRODUCTION

A. Trademark And Service Mark Registration Process.

A "trademark" is a word, name, symbol or combination thereof, used in commerce to identify and distinguish the goods of one entity from those of others, while a "service mark" is used to distinguish services. 15 U.S.C. § 1127. The term "mark" is a general term that covers trademarks and service marks. *Id.* The mark at issue in this case is a service mark.

Rights in a mark arise from use of the mark in commerce, not due to any Government action. *B&B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293, 1300 (2015). The Government does not grant or issue marks.

The Lanham Act, 15 U.S.C. §§ 1051 *et seq.*, creates a mechanism for a mark owner to seek a registration from the USPTO. This case does not concern the refusal of the USPTO to issue a mark

(which the Government does not issue) but rather its refusal to issue a mark *registration*.

USPTO Examining Attorneys review applications to determine whether the mark meets statutory and regulatory requirements for registration. 15 U.S.C. § 1051; 37 C.F.R. § 2.61. Section 2 of the Lanham Act provides that a mark is ineligible for registration if, among many other criteria, it contains or comprises matter that "may disparage" persons, institutions, beliefs or national symbols." 15 U.S.C. § 1052; *see also* 15 U.S.C. § 1053 (applying § 1052 to service marks).

If the Examining Attorney believes that the application satisfies the registration criteria, the USPTO publishes the application in the *Official Gazette*, a weekly USPTO periodical. 15 U.S.C. § 1062; 37 C.F.R. §§ 2.61 & 2.80. One who learns of the application from the *Official Gazette* may object by filing an opposition proceeding with the TTAB within 30 days of publication. 15 U.S.C. § 1063. The TTAB will then determine whether the USPTO should issue a registration despite the opposition. If there is no objection, and if the application satisfies the statutory and regulatory criteria, the USPTO will issue a registration certificate to the applicant and will list the mark on the Principal Register, the official record of all marks registered by the United States. 15 U.S.C. § 1057; 37 C.F.R. § 2.151.

On the other hand, if – as occurred with Respondent Simon Tam's application – an Examining Attorney refuses registration, the applicant may appeal the refusal to the TTAB. 15

U.S.C. § 1070. The TTAB will then decide whether the mark is entitled to registration.

B. The Owner Of An Unregistrable Mark Has Statutory And Common Law Enforcement Rights.

Unregistered marks – including unregistrable marks – are fully enforceable. The owner of an unregistrable mark can bring infringement claims for an injunction or damages under both Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and the common law.

The plain language of Section 43(a) permits enforcement against any person who "uses in commerce any word, term, name, symbol, device, or any combination thereof" that is likely to cause confusion or mistake regarding the source of that person's goods or services. 15 U.S.C. § 1125(a)(1)(A). There is nothing in Section 43(a) that limits these claims to registered or registrable marks.

Accordingly, courts have held that unregistrable marks are enforceable under Section 43(a). *See In re City of Houston*, 731 F.3d 1326, 1331 (Fed. Cir. 2013) (stating that a trademark ineligible for registration under Section 2(b) of the Lanham Act may be enforced under Section 43(a)), *cert. denied*, 134 S. Ct. 1325 (2014). In fact, courts have held that Section 43(a) provides for enforcement of titles of single literary works and trade names, neither of which is eligible for registration under the Lanham Act. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1163 n.2 (Fed. Cir. 2002) (single

book titles); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999) (same); *Accuride Int'l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1534 (9th Cir. 1989) (trade names).

The Federal Circuit's suggestion that unregistrable marks cannot be enforced under Section 43(a) is not well-founded. *See In re Tam*, 808 F.3d 1321, 1344 n.11 (Fed. Cir. 2015). It took out of context a statement by this Court that Section 43(a) protects "'qualifying unregistered trademarks'" and that "'the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).'" *Id.* (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)). In *Two Pesos*, this Court was merely stating that a mark eligible for registration will tend to have the source-identifying properties and hence be eligible for enforcement under Section 43(a). *Two Pesos* did not imply that unregistrable marks necessarily lack the source-identifying properties needed for Section 43 enforcement.

The Federal Circuit also doubted that Tam's mark was enforceable under common law. *See In re Tam*, 808 F.3d at 1344. There are, however, examples of enforcement under common law of trademarks comprising ethnic slurs. *See, e.g.*, *Leidersdorf v. Flint*, 7 N.W. 252 (Wis. 1880) ("Nigger-Hair Smoking Tobacco"); *McCann v. Anthony*, 21 Mo. App. 83, 91-92 (1886) ("Old Coon Smoking Tobacco").

SUMMARY OF ARGUMENT

1. The Federal Circuit erred in holding that the Lanham Act prohibition against registering marks that "may disparage" violates the First Amendment. *See In re Tam*, 808 F.3d at 1328. The refusal to register a mark does not implicate the First Amendment rights of the mark owner.

Trademark law grants a speech monopoly to mark owners, enabling the owner to silence others from using similar words or symbols. The USPTO's refusal to register Tam's mark may marginally reduce his ability to silence others, but that does not implicate – let alone violate – his right to Free Speech. There is no First Amendment right to curtail the speech of others.

There is no merit to Tam's argument that the disparagement provision violates the First Amendment because it involves viewpoint discrimination. If the Constitution prohibits viewpoint discrimination in the context of a mark registration, it is not the First Amendment that does so. Depending on the facts and circumstances presented, other Constitutional provisions, such as the Equal Protection, Due Process or Establishment Clause, might prevent the Government from discriminating based on content when it issues mark registrations. See *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 598 n.3 (1998) (Scalia, J., concurring); *Pleasant Grove City v. Summum*, 555 U.S. 460, 481-82 (2009) (Stevens, J., concurring). The right to silence others, however, is not a right that arises under the First Amendment. Therefore,

marginally reducing that right on alleged viewpoint-discriminatory grounds does not violate the First Amendment.

Even if this Court were to entertain the notion that First Amendment rights are implicated by a law that reduces a speech-monopolist's ability to silence others, the refusal to register a mark is not significant enough to burden the mark owner's Free Speech rights. Denial of a registration does not render a mark unenforceable. Unregistrable marks can be enforced under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and under the common law. The Federal Circuit erred in concluding otherwise, causing it to overstate significantly the impact of a registration denial.

2. Alternatively, due to the Government speech doctrine, the refusal to register Tam's mark did not violate his First Amendment rights. *See Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2246 (2015). Although a private party's use of a mark is not Government speech, the issuance of a registration and the publication on the USPTO's Principal Register are Government speech. Reprinted below are Government registrations of blatantly racist trademarks registered before Congress amended the Lanham Act to preclude registration of marks that "may disparage." *Infra* at 21-22. The First Amendment does not compel the Government to issue registration certificates for such marks or publish those marks on its Principal Register. Congress made a valid decision that the Government should not associate itself with such marks.

3. The disparagement provision of Section 2(a) is not void for vagueness under the Due Process Clause. Section 2(a) imposes no criminal or civil penalties and proscribes no conduct. As a result, it is reviewed deferentially for vagueness.

The term "may disparage" contains commonly understood words, and this Court even employed "disparage" to articulate the test for permissible legislative prayer under the Establishment Clause. *Marsh v. Chambers*, 463 U.S. 783 (1983). Section 2(a) also does not encourage and authorize arbitrary and discriminatory enforcement. The Lanham Act and USPTO regulations create a transparent and fair process for evaluating registration applications.

4. The disparagement provision of Section 2(a) should be interpreted according to its plain language. Both the plain language of the Lanham Act and its legislative history demonstrate that a mark is not eligible for registration if it "may disparage." Proof of actual disparagement is not required. Likewise, under the plain language of Section 2(a), proof that the mark owner intended to disparage is not required for the mark to be ineligible for registration.

When the TTAB applies the disparagement provision of Section 2(a), it looks for evidence that a "substantial composite" of the referenced group (here, people of Asian descent) find that a mark is disparaging. While evidence of the views of a "substantial composite" is one way of demonstrating that a mark "may disparage," it is not the only way. This Court should not imply that the TTAB's

"substantial composite" test is the only way to demonstrate that a mark "may disparage."

ARGUMENT

I. THE DISPARAGEMENT PROVISION DOES NOT VIOLATE THE FIRST AMENDMENT.

A. Tam's First Amendment Rights Were Not Affected.

1. Refusal To Register A Mark May Affect The Owner's Ability To Enjoin Others From Speaking, But The Right To Silence Others Is Not A First Amendment Right.

a. The Federal Circuit erred in treating the refusal to issue a service mark registration as burdening Tam's First Amendment rights. *In re Tam*, 808 F.3d at 1345.

The Federal Circuit's position turns trademark law on its head. Trademark law is not a device to protect the First Amendment rights of the mark owner, but to decrease the speech rights of everyone else. Trademark law grants a mark owner a speech monopoly. *See George Nelson Found. v. Modernica*, 12 F. Supp. 3d 635, 644-45 (S.D.N.Y. 2014) ("'The user who first appropriates the mark obtains [an] enforceable right to exclude others . . . .'") (citation omitted). The law empowers the owner to enjoin others from using similar words and symbols.

When the USPTO refuses to issue (or cancels) a registration, that action might marginally affect the owner's ability to enjoin others from speaking, but there is no First Amendment right to prevent others from speaking. Trademark law – and the mark registration process – do not exist to advance the First Amendment, but *despite* the First Amendment.

Every trademark or service mark injunction involves enforcing a speech monopoly on behalf of the mark owner and silencing others who wish to use similar words or symbols. *See, e.g., San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987) (affirming injunction barring a group from using the words "Gay Olympic Games"); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 772, 778-79 (8th Cir. 1994) (enjoining use of "Michelob Oily" by party commenting on oil spill in river supplying water to Anheuser-Busch brewery); *Hershey's Co. v. Art Van Furniture, Inc.*, 2008 WL 4724756 (E.D. Mich. Oct. 24, 2008) (enjoining furniture company from using a design of a brown sofa emerging from a wrapper on its web site because the image resembled a Hershey's bar).

As a result, "the primary cost of recognizing property rights in trademarks is the removal of words from (or perhaps non-entrance into) our language." *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 906 (9th Cir. 2003) (quotation omitted).

Even if a member of the public is able to defeat a mark owner's enforcement action, "social and commercial discourse" can be chilled or even

rendered "impossible" by the mere threat of an infringement lawsuit. *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 307 (9th Cir. 1992). And it can require extensive litigation for a member of the public to vindicate his or her right to free speech when a trademark owner wishes to exercise its monopoly speech power. *See Radiance Found., Inc. v. NAACP*, 25 F. Supp. 3d 865, 901-02 (E.D. Va. 2014) (enjoining organization from calling the NAACP the "National Association for the Abortion of Colored Persons" in protest over the NAACP's collaboration with Planned Parenthood), *rev'd*, 786 F.3d 316 (4th Cir. 2015) (reversing only after ACLU provided *pro bono* assistance with appeal); *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 736 F.3d 198, 200-02 (2d Cir. 2013) (affirming coffee shop's right to use the term "Charbucks" despite opposition by Starbucks, but only after a trial and three appeals).

This Court has recognized that marks restrict the public's ability to speak, but has held that such a restriction can be justified when it advances a substantial Government interest. *See San Francisco Arts*, 483 U.S. at 536-39 (holding that enforcement of trademark satisfied *Central Hudson* standard for commercial speech restriction). Even when justified, the enforcement of marks represents a restriction on the ability of the public to speak. *See* Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After* Eldred, 44 Liquormart, and Bartnicki, 40 Hous. L. Rev. 697, 698 (2003) (characterizing copyright law and trademark law as "speech restrictions").

Although the ACLU paradoxically has argued that Section 2(a) is unconstitutional, it agrees that cancelling a registration results in reducing the mark owner's ability to silence others, thereby increasing the legal rights of the public to speak:

> Furthermore, cancelling the Washington team's trademark may not even be effective, because cancelling a trademark doesn't prevent the team from using it. *It does, however, make it easier for other people to disseminate it. So the Trademark Office decision in this case might result in even more use of a distasteful term – not less.*

Esha Bandari, *'You're Not Wrong, You're Just an A**hole,'* ACLU Blog of Rights (Mar. 6, 2015, 12:30 PM), https://www.aclu.org/blog/free-speech/youre-not-wrong-youre-just-ahole (emphasis added). But making it "easier for other people" to use words and symbols, *i.e.*, freeing them of the need to obtain a license from a mark owner, means that more speech would be legally permitted by cancelling the registrations. The First Amendment is not violated when more speech is legally permitted.

b. Some have argued that the First Amendment problem with the disparagement provision is that it discriminates based on the alleged viewpoint expressed in the mark. They point out that a mark that "may disparage" Asian Americans (or Native Americans) is not eligible for registration while non-disparaging marks are eligible. And, they ask, how about a law that

discriminates based on a political position expressed in a mark? Would it be constitutional for Congress to permit registration of "Vote Democratic" brand ice cream but not "Vote Republican" brand ice cream?

If the Constitution prohibits viewpoint discrimination in the context of a mark registration, it is not the First Amendment that does so. Depending on the facts and circumstances presented, other Constitutional provisions, such as the Equal Protection, Due Process or Establishment Clause, might prevent the Government from discriminating based on content when it issues mark registrations. See *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 598 n.3 (1998) (Scalia, J., concurring) (stating that while the Constitution would prevent the Government from acting to promote Republican candidates, that "unconstitutionality has [nothing] to do with the First Amendment"); *Pleasant Grove City v. Summum*, 555 U.S. 460, 481-82 (2009) (Stevens, J., concurring) (stating that the Equal Protection Clause and, in some instances, the Establishment Clause – but not the speech provisions of the First Amendment – preclude the Government from expressing offensive or partisan messages).

As explained above, however, the right to silence others is not a right that arises under the First Amendment. Therefore, marginally reducing that right on alleged viewpoint-discriminatory grounds does not violate the First Amendment. This point is illustrated by a copyright case, *Golan v. Holder*, 132 S. Ct. 873 (2012).

In *Golan*, publishers, orchestra conductors, musicians and others argued that their First Amendment rights were violated by a law that re-extended copyright protection over works that had previously entered the public domain. The law prevented them from disseminating written works or playing music as they wished. *Id.* at 878. The Court affirmed the law, but suggested that their First Amendment rights might be violated if "copyright protection . . . hinge[d] on the author's viewpoint." *Id.* at 892. In other words, if a publisher's ability to disseminate a written work depended on the viewpoint expressed by the work, then the *publisher's* First Amendment rights might be violated. That is, viewpoint discrimination in copyright may infringe on *non-copyright holders'* First Amendment rights. The Court, however, did not suggest that the *copyright holder's* First Amendment rights would be implicated. This is because the right to enforce a copyright (and silence others), like the right to enforce a trademark, is not a right that arises under the First Amendment. *See id.* at 889 ("some restriction on expression is the inherent and intended effect of every grant of copyright").[2]

---

[2] As discussed above with marks, an author might have an Equal Protection, Due Process or Establishment Clause claim if he or she were denied a copyright registration due to the content or viewpoint expressed in the author's work. Further, Congress's power to enact copyright laws is subject to the Copyright Clause, which gives Congress the power to "promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive right" to their writings. U.S. Const., art. 1, § 8, cl. 8. The law is unsettled whether the Copyright

Tam's case differs from a scenario in which a burden on *speech* is imposed, such as if a city refused to plow the snow in front of a home with a "Vote Republican" sign but would plow if the sign said "Vote Democratic." In the snow-plowing case, the city is unquestionably burdening speech based on content. By contrast, when the Lanham Act provides that marks containing certain matter are unregistrable, speech is not burdened, but *the power to silence others* is burdened.

2. Many Federal Trademark And Similar Laws Discriminate On The Basis Of Content And Would Fall If The Disparagement Provision Is Held Unconstitutional.

The argument advanced above – that the First Amendment does not protect the right of a speech-monopolist to enjoin others from speaking – provides a narrow, coherent basis for decision. A ruling on this basis will create no tension with any prior decision of this Court and will have no impact on overall First Amendment jurisprudence.

Clause requires or prohibits content-based discrimination, due to uncertainty in how to interpret the Clause's language "to promote the Progress of Science." *Compare Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 856 (5th Cir. 1979) (stating that the Copyright Clause does not permit content-based discrimination) *with* 41 U.S. Op. Atty. Gen. 395 (U.S.A.G. Dec. 18, 1958) ("It has been generally accepted for years that seditious, libellous, obscene or immoral works are not entitled to copyright. . . . Judicial authority has been found to support this view; none has been found to the contrary.").

On the other hand, if the disparagement provision violates the First Amendment, then many other statutes do as well. For instance, the Section 2(a) provision against registering marks with "scandalous" or "immoral" matter would violate the First Amendment because it is a content-based provision. 15 U.S.C. § 1052(a); *see In re Tam*, 808 F.3d at 1330 n.1.

Similarly, if the disparagement provision violates the First Amendment, then so, too, do dozens of statutes giving special trademark-style protections to certain patriotic organizations. *See The Last Best Beef, LLC v. Dudas*, 506 F.3d 333, 339-40 (4th Cir. 2007) ("Congress has often removed specific trademarks from the general trademark application process."). These laws give the favored organizations the "exclusive right to use" the organization's name, and frequently its emblems, symbols, seals, and badges – and sometimes even the "words and phrases" that the organization uses, as is the case for Boy Scouts, Girl Scouts and Civil Air Patrol. 36 U.S.C. §§ 30905, 40306 & 80305.

These laws give the power to enjoin similar third-party uses without the need to show likelihood of consumer confusion and render them invulnerable to normal trademark defenses. *See San Francisco Arts*, 483 U.S. at 530-31 (holding that U.S. Olympic Committee did not need to prove likelihood of confusion and that "traditional trademark defenses" did not apply); *Wrenn v. Boy Scouts of Am.*, 2008 WL 4792683, at *4 n.3 (N.D. Cal. Oct. 28, 2008) (stating that Boy Scouts did not need to prove likelihood of confusion). "Many of the patriotic or fraternal

organizations chartered by Congress receive exclusive rights to words or phrases which may be enforced without regard to the normal standards of trademark law." *Am. Legion v. Matthew*, 144 F.3d 498, 499 (7th Cir. 1998).

The statutes award the special protections as a means of advancing the patriotic, pro-military or other laudable purposes of the organization. *See San Francisco Arts*, 483 U.S. at 537-38 & n.17 (stating that Congress provided special protections to the U.S. Olympic Committee to advance the statutory purposes of the organization). For example, one statute gives to Future Farmers of America (whose statutory purposes include to "train for useful citizenship, and foster patriotism") the exclusive right over its name, seals, emblems and badges. 36 U.S.C. §§ 70902, 70907. Other examples include:

- American Legion, *id.* §§ 21702, 21705.
- Ladies of the Grand Army of the Republic, *id.* §§ 130102, 130106.
- Little League, *id.* §§ 130502, 130506.
- United Service Organizations, Incorporated or USO, *id.* §§ 220102, 220106.
- Veterans of Foreign Wars of the United States, *id.* §§ 230102, 230105

There are many other such statutes. 36 U.S.C. §§ 20907, 21904, 22306, 22505, 22706, 30106, 30306, 30507, 30706, 40306, 50305, 70506, 140304, 150707, 152306, 152506, 152907, 153104, 153506, 153706, 154106, 154707, 170105, 170307, 190106, 190307, 200306, 220306.

If the disparagement provision of Section 2(a) is unconstitutional because it discriminates based on the content of the trademark, then these special protection laws – which discriminate based on the patriotic, pro-military or virtuous mission of the organization – are also unconstitutional.

3. Unregistrable Marks Are Enforceable. Their Owners Are Fully Capable Of Silencing Others.

Even if First Amendment rights are implicated by a law that reduces a speech-monopolist's ability to silence others, the refusal to register a mark is not significant enough to burden the mark owner's First Amendment right to free speech.

As explained above, an unregistrable mark is enforceable under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and under the common law. *See supra* at 4. Mark owners can obtain injunctions and damages for infringement. They can call upon the courts to bar others from using the words and symbols that they wish to use.

The fact that unregistrable marks are enforceable significantly distinguishes mark registration from copyright registration. A copyright infringement action cannot be brought unless the work has been registered with the Copyright Office. *See* 17 U.S.C. § 411(a); *Reed Elsevier, Inc. v. Muchnik*, 559 U.S. 154, 158 (2010). Thus, the refusal to issue a copyright registration has a far greater impact than the refusal to register a mark.

Furthermore, while the benefits of registration can be "substantial," *B&B Hardware, Inc.*, 135 S. Ct. at 1300, the benefits vary considerably from one mark to another. It is not possible to generalize. For example, the evidentiary presumptions that come with registration (*i.e.*, presumptions of validity, ownership, and exclusive right to use the mark) provide no added value to owners of well-established marks (*e.g.*, "Washington Redskins") because those evidentiary points cannot be reasonably disputed.

B. Refusing To Register A Mark Is An Example Of Government Speech.

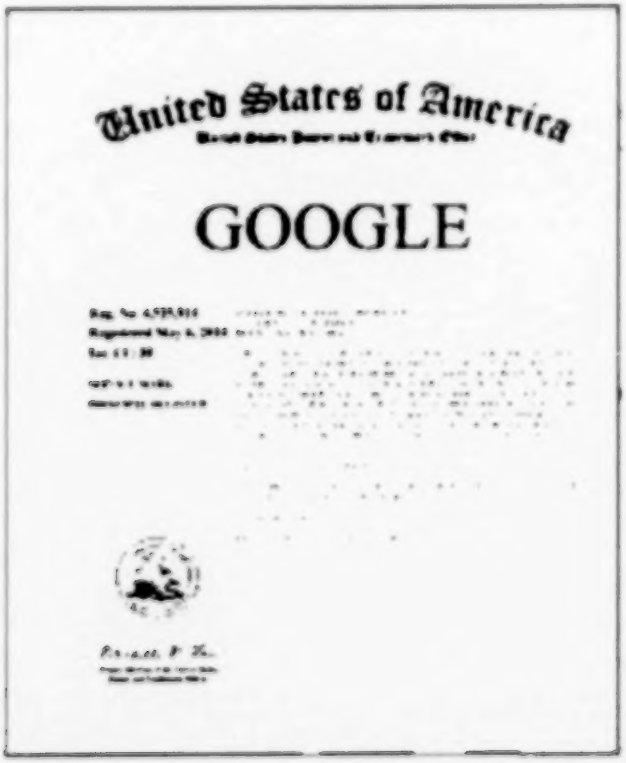
The USPTO's refusal to register Tam's mark fits within the Government speech doctrine and therefore does not implicate the Free Speech Clause. As this Court explained, "[w]hen [the] government speaks, it is not barred by the Free Speech Clause from determining the content of what it says." *Walker*, 135 S. Ct. at 2245; *see also Johanns v. Livestock Mktg. Assn.*, 544 U.S. 550, 553 (2005).

"The Free Speech Clause restricts government's regulation of private speech; it does not regulate government speech." *Pleasant Grove City, Utah*, 555 U.S. at 467. "[G]overnment statements (and government actions and programs that take the form of speech) do not normally trigger the First Amendment rules designed to protect the marketplace of ideas." *Walker*, 135 S. Ct. at 2245-46. Because the Government "is entitled to promote a program, to espouse a policy, or to take a position," the Government can discriminate between

viewpoints when it engages in Government speech. *Id.* at 2246.

1. A USPTO Registration Certificate And The Principal Register Are Government Documents.

The Lanham Act requires that a registration certificate be issued "in the name of the United States of America," "under the seal of the USPTO," and that it be "signed by the Director." 15 U.S.C. § 1057(a). The statute further requires that the registration certificate "shall reproduce the mark" and "state that the mark is registered on the principal register." *Id.* An image of a registration certificate is below:


United States of America

GOOGLE

If this Court rules that Section 2(a) of the Lanham Act is unconstitutional, the USPTO would have to issue registration certificates with ugly racist images. The following are examples of racist marks registered before enactment of the prohibition against registering disparaging marks.

Amicus Brief for Blackhorse, et. al. at 40-73, *In re Tam*, No. 14-1203 (Fed. Cir. July 23, 2015), ECF No. 148.

The Free Speech Clause does not obligate the Government to issue registration certificates displaying such hateful words and symbols, or publish them in its Principal Register.

2. Trademark Registrations Are Government Speech.

In *Walker*, this Court upheld Texas's refusal to issue specialty license plates featuring the Confederate battle flag. 135 S. Ct. 2239. A Texas statute provided that the State could refuse to create a specialty plate "if the design might be offensive to any member of the public." *Id.* at 2244-45. A refusal to issue a possibly offensive specialty license plate was an exercise of Government speech not subject to challenge on Free Speech Clause grounds. *Id.* at 2246, 2252-53.

In *Walker*, the Court found three factors important, each of which weighs in favor of a finding of Government speech here.

First, state governments have historically communicated messages through license plates. *Id.* at 2248. Here, too, a registration is a means by which the USPTO communicates to the public. The USPTO uses a registration certificate and the Principal Register to inform the public of the validity of the mark, the identity of the owner, and the owner's exclusive right to use the mark, subject to any limitations that the USPTO also communicates via the registration certificate. 15 U.S.C. § 1057(b). Although the Government does not communicate messages through the mark itself, it does communicate messages through the registration of the mark. That is the relevant inquiry because Tam was refused a registration, not a mark.

Second, the Court noted that the public associates messages on license plates with the Government, in part because the name of the issuing state is a part of every plate. *Walker*, 135 S. Ct. at 2248. Likewise, a registration certificate and the Principal Register are Government documents. Indeed, when parties seek to oppose or cancel the registration of another party's trademark, they must petition the TTAB for the obvious reason that a registration certificate is a Government communication and the Principal Register is a Government database.

Third, the Court relied on the fact that the state had "effectively controlled" the messages it conveyed by having "final approval authority" over the messages. *Id.* at 2249. Likewise, here, Congress established criteria over registrability and delegated responsibility for the registration program to the USPTO.[3]

Another relevant consideration is whether the Government's speech occurs in the context of a traditional Governmental function. Here, the USPTO issues registrations to advance traditional governmental functions – consumer protection and the protection of private property. *Park 'N Fly v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 207 (1985).

---

[3] The fact that Congress set expressive criteria in Section 2(a) distinguishes this case from the routine issuance of permits and licenses, contrary to the Federal Circuit's concern. *See In re Tam*, 808 F.3d at 1347-48.

The Federal Circuit found that the refusal to issue Tam's mark did not fall under the rubric of the Government speech doctrine, because the Lanham Act allows many tawdry and unsavory marks to be registered, marks expressing messages that the Government surely does not endorse. *In re Tam*, 808 F.3d at 1346-47. This argument is foreclosed by *Walker*. In *Walker*, the Court rejected the argument that, because Texas could not possibly be endorsing some of the messages on approved plates, the rejection of a specialty plate design did not satisfy Government speech. *See Walker*, 135 S. Ct. at 2255 (Alito, J., dissenting). Indeed, inconsistency in Government messaging is unsurprising. Politics and governance in a democracy involves compromises, balancing competing interests, and a great deal of human imperfection. The fact that the Government's messages may be mixed, or subject to criticism as hypocritical, incomprehensible or contradictory, does not make the speech any less Government speech.

II. THE DISPARAGEMENT PROVISION IS NOT VOID FOR VAGUENESS.

A. The Standard Of Review Is Lenient Because Section 2(a) Of The Lanham Act Does Not Make Any Conduct Unlawful.

The doctrine that a statute can be void for vagueness "is an outgrowth not of the First Amendment, but of the Due Process Clause of the Fifth Amendment." *United States v. Williams*, 553 U.S. 285, 304 (2008). The doctrine ensures that imprisonment or criminal or civil fines are not imposed based on the violation of an unduly vague law or regulation. *See, e.g., id.* at 304; *Grayned v. City of Rockford*, 408 U.S. 104, 108-09 (1972) (void-for-vagueness doctrine ensures that statutes and regulations give a "person of ordinary intelligence a reasonable opportunity to know what is *prohibited*, so that he may act accordingly") (emphasis added).

Section 2(a) of the Lanham Act, however, prohibits no conduct or speech. It imposes no criminal sanction or civil penalties. It is impossible to "violate" Section 2(a).

A greater degree of vagueness is therefore tolerated by the Constitution: "The degree of vagueness that the Constitution tolerates – as well as the relative importance of fair notice and fair enforcement – depends in part on the nature of the enactment." *Hoffman Estates v. The Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 498 (1982); *see also F.T.C. v. Wyndham Worldwide Corp.*, 799 F.3d 236, 249 (3d Cir. 2015) ("The level of required notice

for a person to be subject to liability varies by circumstance."). Economic regulation is "subject to a less strict vagueness test." *Hoffman Estates*, 455 U.S. at 498. Further, "[t]he Court has also expressed greater tolerance of enactments with civil, rather than criminal, penalties because the consequences of imprecision are qualitatively less severe." *Id.* at 498-99; *see also Finley*, 524 U.S. at 589 (stating that criminal statutes are subject to more stringent void-for-vagueness review).

While statutes and regulations that impose civil penalties on speech merit careful review because of their potential chilling effect, *see FCC v. Fox TV Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012), where the statute in question does not threaten speech with criminal or civil penalties, the scrutiny is relaxed. *See Finley*, 524 U.S. at 589 (applying a relaxed vagueness standard to review a statute setting criteria for NEA grants even though, "as a practical matter . . . artists may conform their speech to what they believe to be the decisionmaking criteria in order to acquire funding").

Because of the "nature of the enactment," Section 2(a) is entitled to lenient scrutiny under the void-for-vagueness doctrine. *Hoffman Estates*, 455 U.S. at 498.

B. The Term "May Disparage" Is Not Unconstitutionally Vague.

To be void for vagueness, a statute must "fail to provide the kind of notice that will enable ordinary people to understand what conduct it

prohibits . . . [or] authorize and even encourage arbitrary and discriminatory enforcement" by Government officials. *City of Chicago v. Morales*, 527 U.S. 41, 56 (1999). Neither concern applies here.

1. The Disparagement Provision Gives Fair Warning.

Although a statute must give "people of ordinary intelligence a reasonable opportunity to understand what conduct it prohibits,"[4] *Hill v. Colorado*, 530 U.S. 703, 732 (2000), the Due Process Clause does not require "perfect clarity and precise guidance." *Ward v. Rock Against Racism*, 491 U.S. 781, 794 (1989). Because we are "[c]ondemned to the use of words, we can never expect mathematical certainty from our language." *Grayned*, 408 U.S. at 110. Courts should look to "[d]ictionary definitions and old-fashioned common sense" in evaluating whether a statutory term is unduly vague. *Wag More Dogs, LLC v. Cozart*, 680 F.3d 359, 371 (4th Cir. 2012).

Dictionaries contemporaneous with the 1946 enactment of the disparagement provision of Section 2(a) contained consistent definitions of "disparage" as meaning "to dishonor by comparison with what is inferior," "to speak slightingly of," "to deprecate," to "undervalue," "to regard or speak of slightingly," "to affect or injure by unjust comparison . . . ." *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, at *35 (T.T.A.B. 1999) (quoting *Webster's New International Dictionary*, G. & C. Merriam Company (2nd ed.

---

[4] As noted, Section 2(a) does not "prohibit" any conduct.

1947) and *New "Standard" Dictionary of the English Language, Funk and Wagnalls Company* (1947)). From these definitions, the TTAB stated that to determine whether a trademark contains matter that "may disparage," it must determine whether the matter "may dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison." *Id.*[5]

This Court's use of "disparage" in *Marsh v. Chambers*, 463 U.S. 783 (1983), further demonstrates that "disparage" is not unconstitutionally vague. In *Marsh*, the Court employed "disparage" when it formulated the test under the Establishment Clause for the scope of permitted prayer to begin a legislative session: "The content of the prayer is not of concern to judges where, as here, there is no indication that the prayer opportunity has been exploited to proselytize or advance any one, *or to disparage any other*, faith or belief." *Id.* at 794-95 (emphasis added); *see also Town of Greece v. Galloway*, 134 S. Ct. 1811, 1823-24 (2014) (applying *Marsh* disparagement test); *Rubin v. City of Lancaster*, 710 F.3d 1087 (9th Cir. 2013) (permitting legislative prayer because it did "not proselytize, or advance or disparage (*Marsh's* language)" a particular faith); *Simpson v. Chesterfield Cty. Bd. of Supervisors*, 404 F.3d 276,

---

[5] PFI agrees that, when the Lanham Act was enacted, multiple dictionaries contained "materially identical definitions of 'disparage.'" Memorandum in Support of Motion for Summary Judgment on Constitutional Claims at 19 n.14, *Pro-Football, Inc. v. Blackhorse*, No. 14-cv-01043 (E.D. Va. Feb. 23, 2015), ECF No. 56.

284 (4th Cir. 2005) (upholding ordinance adopting *Marsh* disparagement language).

The First Circuit has also observed that "words like 'demean' or 'disparage' have reasonably clear meanings." *Ridley v. Massachusetts Bay Transp. Auth.*, 390 F.3d 65, 95 (1st Cir. 2004) (holding that guidelines prohibiting bus advertisements that "disparage" individuals or groups were not void for vagueness).

Further, the inclusion of the word "may" in front of "disparage" reduces any potential vagueness. The insertion of "may" gives notice that a trademark is not eligible for registration if there is some evidence of its disparaging character. Thus, it is not necessary to gather and weigh all relevant evidence to determine whether a mark is ineligible for registration; one need only check if there is enough evidence to find that a mark "may" disparage. *See, e.g.*, *Blackhorse*, 111 U.S.P.Q.2d at *29 (once evidence has been adduced that a trademark contains matter that may disparage, "the mere existence of differing opinions cannot change the conclusion").

Finally, "may disparage" is less vague than other terms that have been upheld in vagueness challenges. For example, in *National Endowment for the Arts v. Finley*, the Court reviewed a statute directing the NEA to fund works of art based on "artistic excellence and artistic merit . . . taking into consideration general standards of decency and respect for the diverse beliefs and values of the American public." *Finley*, 524 U.S. at 572, 589.

Although this language was "undeniably opaque," it was not void for vagueness. *Id.* at 576, 584, 588.

2. The Disparagement Provision Does Not Authorize Arbitrary And Discriminatory Enforcement.

It is not clear that the "arbitrary and discriminatory *enforcement*" prong of the vagueness test should apply; Section 2(a) is a not a statute that is "enforced" as it prohibits no conduct or speech. If it does apply, then it should be applied under a lenient review standard, as discussed above.

In any event, the Lanham Act and USPTO regulations ensure that decisions are made in an evenhanded and transparent way – they do not "authorize" or "encourage" "arbitrary and discriminatory" enforcement. Examining Attorneys are lawyers whose decisions approving or refusing trademark registrations are set forth in written letters that state the reasons for the decision. Those letters are published on the USPTO web site and can be reviewed by the public. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE ("T.M.E.P." or "Manual") §§ 108.01, 705. Likewise, TTAB Administrative Trademark Judges who review Examining Attorney decisions act in a public manner with controls that prevent arbitrary and discriminatory action. The TTAB consists of the Director and Deputy Director of the USPTO, the Commissioner for Patents, the Commissioner of Trademarks and Administrative Trademark Judges appointed by the Secretary of Commerce in consultation with the Director. 15 U.S.C. § 1067(b). The members of the TTAB are

publicly known. The TTAB sits in three-member panels when it reviews Examining Attorney decisions. 37 C.F.R. §§ 2.129(a) & 2.142(e)(1). TTAB decisions are written and published, identify the Judges who served on the panel, and are available for review and discussion by the public.

The Manual articulates the standard that Examining Attorneys will apply in determining whether a trademark contains matter that "may disparage," including whether matter "may be disparaging to a substantial composite of the referenced group." T.M.E.P. § 1203.03(b)(i). The Manual explains further that disparagement is considered in relation to the goods and services at issue. *Id.* It explains that intent is not a factor in the analysis. *Id.* And it contains citations to the holdings of numerous cases explaining where disparagement was found, where it was not found, and why. *Id.* § 1203.03(b)(ii).

Tam has argued that the disparagement provision of Section 2(a) is void for vagueness because there are multiple examples in which different Examining Attorneys came to different conclusions as to whether trademarks with similar matter may disparage.[6] But focusing only on inconsistent Examining Attorney decisions is to focus on a biased sample. It ignores all the consistent decisions of Examining Attorneys. Thus, while Tam and his supporting *amici* will likely be able to find seemingly inconsistent Examining

---

[6] Brief for Respondent in Opposition to a Writ of Certiorari at 31.

Attorney decisions, their disparagement examples will be cherry-picked and will not reflect a systematic, empirical inquiry.

It is unavoidable – and not unconstitutional – that determinations by frontline Government employees, like USPTO Examining Attorneys, will not always be consistent. *See United States v. Mead*, 533 U.S. 218, 224, 233-34 (2001). The USPTO examines more than 300,000 registration applications each year. Brief for the Petitioner at 51.

Furthermore, examples of inconsistent Examining Attorney decisions do not equate "arbitrary and discriminatory" enforcement by the USPTO, since every applicant whose application was refused had the right to appeal to the TTAB. *See* 15 U.S.C. § 1070. And Tam will not be able to find two TTAB decisions that reach different outcomes over whether trademarks with the same matter "may disparage."[7]

Any seemingly inconsistent Examining Attorney decisions are also not relevant to determining whether Section 2(a) is vague when applied to "slants." This Court has stated that whether a statute is void for vagueness is a case-

---

[7] In *In re Squaw Valley Dev. Corp.*, 80 U.S.P.Q.2d 1264 (T.T.A.B. 2006), the TTAB found that certain trademarks for clothing that contained "squaw" were disparaging to Native American women, but explained that a trademark containing "squaw" for ski equipment was not disparaging because, in connection with those goods, the likely meaning was a shorthand reference to the Squaw Valley, California ski area rather than to Native American women.

specific inquiry that depends on the specific facts presented. "We consider whether a statute is vague as applied to the particular facts at issue, for '[a] plaintiff who engages in some conduct that is clearly proscribed cannot complain of the vagueness of the law as applied to the conduct of others.'" *Holder v. Humanitarian Law Project*, 561 U.S. 1, 18-19 (2010) (quoting *Hoffman Estates*, 455 U.S. at 495). The question whether Section 2(a) is unduly vague when applied to "slants" is different from whether it is unduly vague when applied to "n*ggers" or to "redskins" or to some other term.[8]

---

[8] In *Johnson v. United States*, 135 S. Ct. 2551 (2015), the Court entertained a facial challenge to the Armed Career Criminal Act, which enlarged criminal sentences by at least five years for defendants previously convicted of three violent felonies. The Court held that the residual clause of the statutory definition of "violent felony" was void for vagueness, even though there were some crimes that would surely fall within the residual clause. In *Johnson*, whether a prior crime fit within the residual clause did not require courts to examine whether the facts of the prior crime involved violent conduct, but whether in the "ordinary case," the crime in question involved conduct that poses a serious potential risk of physical injury. *Id.* at 2557; *see also Welch v. United States*, 136 S. Ct. 1257, 1262 (2016). Contrary to the statute in *Johnson*, Section 2(a) does not turn on analyzing imponderable abstractions, but on the "particular facts" of the trademark at issue. *Humanitarian Law Project*, 561 U.S. at 18-19. These facts will necessarily vary from one trademark to another. *See, e.g.*, *Blackhorse*, 112 F. Supp. 3d at 472-88 (reviewing the facts establishing that "redskins" may disparage Native Americans, facts that are not relevant to other trademarks). For this reason and because of the lenient standard applicable to non-punitive statutes, Section 2(a)—unlike the statute in *Johnson*—is not amenable to a facial challenge for vagueness.

III. SECTION 2(A) SHOULD BE INTERPRETED ACCORDING TO ITS PLAIN MEANING.

A. The Inclusion Of "May" In "May Disparage" Means That Proof Of Actual Disparagement Is Not Required For A Mark To Be Unregistrable.

We agree with Tam that the disparagement provision should be interpreted according to its plain meaning. Brief for Respondent in Opposition to a Writ of Certiorari at 14-16. But Tam overlooks the word "may." *Id.* at 16 ("The statute just says 'disparage.'").

In fact, a mark is unregistrable if it comprises "matter which *may* disparage" persons. 15 U.S.C. § 1052(a) (emphasis added). Congress's insertion of "may" before "disparage" was deliberate. The multiple other bars to registration in 15 U.S.C. § 1052 conspicuously lack "may." For example, to refuse registration of an immoral, deceptive, or scandalous mark, the statute requires that the mark contain matter that *actually is* "immoral, deceptive, or scandalous." 15 U.S.C. § 1052(a). The contrast is plain and significant. *See In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, at *2 (T.T.A.B. 2010) ("The structure of Section 2(a), with various refusals and, therefore, different tests, interwoven into its various parts, is the result of its legislative development.").

The drafting history also demonstrates that Congress deliberately inserted "may" before "disparage." Initial House and Senate bills provided

that a trademark is ineligible for registration if it "tends to" disparage.[9] In 1942, the House Committee on Patents marked up a Senate bill and substituted "may" in place of "tends to."[10] Subsequent bills[11] and the enacted legislation contained the "may disparage" standard instead of "tends to disparage." 15 U.S.C. § 1052(a). This is significant. *See Doe v. Chao*, 540 U.S. 614, 622 (2004) (relying on drafting history to interpret statute). "May disparage" is a lower standard than "tends to disparage," which is itself a lower standard than "does disparage."

It is well-established "[i]n common and legal usage" that "'may' reflects possibility, not certainty." *United States v. Arias-Espinosa*, 704 F.3d 616, 619 (9th Cir. 2012); *see also FTC v. Morton Salt Co.*, 334 U.S. 37, 46 (1948) ("may" requires only "reasonable possibility"); *United States v. Lexington Mill & Elevator Co.*, 232 U.S. 399, 411 (1914) (applying ordinary meaning of "may"). Accordingly, it is not

---

[9] Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong., 1st Sess., at 1 (1939) (Section 2(a) contains "tends to disparage" standard); Hearings on H.R. 102, H.R. 5461, S. 895, Before the Subcomm. on Trademarks of the House Comm. on Patents, 77th Cong., 1st Sess., at 1-2 (1941) (Section 2(a) of H.R. 102, which is "identical" to S. 895, contains "tends to disparage" standard); *id.* at 15 (by contrast, H.R. 5461 contains "may disparage" standard).

[10] H.R. Rep. No. 2283, at 2 (1942) (recommending passage of S. 895 with certain amendments, including: "strike out 'tends to' and insert in lieu 'may'" before "disparage").

[11] Hearings on H.R. 82 Before the House Comm. on Patents, 78th Cong., 1st Sess., at 2 (1943); Hearings on H.R. 82 Before the Subcomm. of the Senate Comm. on Patents, 78th Cong., 2d Sess., at 2 (1944).

necessary that the USPTO have evidence that a mark actually disparages in order to be unregistrable, only that it may disparage.

One commentator[12] explained the significance of "may" before "disparage" as follows:

> Section 2(a) provides that registration should be refused when a mark '[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which *may* disparage . . . persons . . . . The statute does not prohibit 'matter which disparages;' rather, it prohibits 'matter which *may* disparage.' The latter is certainly a broader prohibition than the former.

Kimberly A. Pace, *The Washington Redskins Case and The Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 Pepp. L. Rev. 7, 33 (1994). Therefore, "[t]o cancel a mark because it disparages, the mark has to have the potential to disparage the group at the date of its registration." *Id.* at 33 n.174.

B. Intent To Disparage Is Not Required.

The inclusion of "may" also establishes that intent to disparage is not required in order for a mark to be ineligible for registration. *Blackhorse*, 112 F. Supp. 3d at 472.

---

[12] The commentator is now the Honorable Kimberly Moore of the Federal Circuit.

Other parts of Section 2(a) also make this point clear. The statute asks whether "matter" in the mark may disparage. "Matter" is the subject and "may disparage" is the verb. But, "matter" is inanimate and cannot possess intent. Likewise, the language shows that the relevant inquiry focuses on the "nature" of the mark, and not the owner's intent. *See* 15 U.S.C. § 1052(a) ("No *trademark* . . . shall be refused registration . . . on account of *its nature* unless *it* . . . [c]onsists of or comprises . . . matter which may disparage . . . .") (emphasis added).

Indeed, if the rule were otherwise, it would be quite difficult for Examining Attorneys to ascertain the intent of registration applicants. *See Negusie v. Holder*, 555 U.S. 511, 527-28 (2009) (Scalia, J., concurring).

C. Evidence Of A "Substantial Composite" Is One Way To Demonstrate That A Mark Contains Matter That "May Disparage," But Is Not The Only Way.

To evaluate whether Tam's marks may disparage, the TTAB considered whether a "substantial composite" of people of Asian descent consider "slants" to be disparaging. *In re Tam*, 108 U.S.P.Q.2d 1305, at *1 (T.T.A.B. 2013); *see also Blackhorse*, 111 U.S.P.Q.2d at *5 (employing substantial composite test). The Federal Circuit has used the "substantial composite" test in the disparagement context, but not through reasoned analysis. In *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 944 (2015), the parties agreed that the Court should employ a

"substantial composite" test and the Court did so for that reason. Subsequently, in *Tam*, the panel cited *Geller* as precedent for the "substantial composite" test. *In re Tam*, 785 F.3d 567, 571 (Fed. Cir. 2015), *vacated by* 808 F.3d 1321 (Fed. Cir. 2015).

There can be no doubt that if a substantial composite of the referenced group view a mark as disparaging, then the mark contains matter that "may disparage." But, while evidence of the views of a "substantial composite" is one way to demonstrate that a mark "may disparage," it should not be assumed to be the *only* way to prove it. *See Flowers v. State*, 220 S.W.3d 919, 922 (Tex. Crim. App. 2007) ("Just as there is more than one way to skin a cat, there is more than one way to prove a prior conviction").

For example, dictionaries, scholarly articles, evidence of usage, and admissions by a party, among other evidence, are all clearly probative to whether a mark contains matter that "may disparage." *See* Fed. R. Evid. 401. And, indeed, the TTAB has relied upon such forms of evidence when applying its "substantial composite" test. *See, e.g., Blackhorse*, 111 U.S.P.Q.2d at *28-29; *Tam*, 108 U.S.P.Q.2d at *1-2 (citing dictionaries); *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, *4-5 (T.T.A.B. 2008) (same); *see also In re Geller*, 751 F.3d at 1358-59 (citing dictionaries). The TTAB has stated that evidence of the general perception of the meaning of a term can "serve to support a finding that the referenced group finds the term to be disparaging." *Blackhorse*, 111 U.S.P.Q.2d at *4 n.15. The TTAB has needlessly complicated things. Such evidence is directly

probative to the "may disparage" question, a question that does not need to be mediated by a "substantial composite" test.

The origin of the "substantial composite" test demonstrates that it is not logical to view it as the sole means of providing that a mark "may disparage." The Federal Circuit's predecessor coined the term "substantial composite" in a case deciding whether a mark contains matter that *actually is* scandalous under Section 2(a). In *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981), the Court stated that "[w]hether or not the mark, including innuendo, is scandalous is to be ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public." *Id.* at 485; *see also In re Mavety Media Grp., Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). In *Harjo*, the TTAB borrowed "substantial composite" from the "is scandalous" context for use in the "may disparage" context. *Harjo*, 50 U.S.P.Q.2d 1705, *34-36 (T.T.A.B. 1999). Since *Harjo*, the TTAB has continued to use "substantial composite" in the "may disparage" context. T.M.E.P. § 1203.03(b). It is illogical, however, to use an expression relevant to whether a mark contains matter that actually is scandalous as the sole means of assessing whether matter may disparage, since "may disparage" requires only a potential to disparage. *See supra* at 35-37.

For these reasons, this Court's opinion should clarify that satisfying a "substantial composite" test is not the *only* way to demonstrate that a mark contains matter that "may disparage." In short, satisfying the "substantial composite" test is

sufficient, but not necessary, to demonstrate that a mark contains matter that may disparage.

CONCLUSION

For the foregoing reasons, this Court should reverse the judgment of the Federal Circuit.

Respectfully Submitted,

JESSE A. WITTEN
Counsel of Record
TORE T. DEBELLA
PATRICK H. THOMPSON
DRINKER BIDDLE & REATH LLP
1500 K Street, NW
Washington, DC 20005
(202) 842-8800
Jesse.Witten@dbr.com

ADAM G. YOFFIE
DRINKER BIDDLE & REATH LLP
105 College Road East
Princeton, NJ 08542
(609) 716-6500

Counsel for Amici Curiae Amanda Blackhorse, Marcus Briggs-Cloud, Phillip Gover, Jillian Pappan and Courtney Tsotigh

November 15, 2016

RECORD AND BRIEFS

No. 15-1293

Supreme Court, U.S.
FILED
DEC 15 2015

In The

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

AMICUS BRIEF FOR ERIK BRUNETTI IN SUPPORT OF RESPONDENT

JOHN R. SOMMER
Counsel of Record
DEVON A. BECKWITH
17426 Daimler Street
Irvine, California 92614
(949) 752-5344
sommerjohnr@gmail.com
Counsel for Amicus Curiae

COCKLE LEGAL BRIEFS (800) 225-6964
WWW.COCKLELEGALBRIEFS.COM

Library of Congress

TABLE OF CONTENTS

Page

TABLE OF CONTENTS i

TABLE OF AUTHORITIES iii

INTEREST OF AMICUS 1

SUMMARY OF ARGUMENT 2

ARGUMENT 3

I. SECTION 2(A) IS UNCONSTITUTIONAL AS TO TRADEMARKS BECAUSE IT WOULD BE UNCONSTITUTIONAL TO DENY COPYRIGHT REGISTRATION BASED UPON CONTENT 3

II. DENIAL OF TRADEMARK REGISTRATION MAKES USE IMPRACTICAL 5

III. BEFORE HOLDING SECTION 2(A) CONSTITUTIONAL THE COURT SHOULD CONSIDER BROADER IMPLICATIONS BEYOND TRADEMARKS 7

A. If Section 2(a) Is Constitutional It Opens The Door To Widespread Governmental Discrimination Against Unpopular Messages 8

B. Section 2(a) Undermines One Of The Purposes Of The Lanham Act: The Protection Of The Interests Of Trademark Owners 10

C. Holding Section 2(a) Constitutional Would Put The Government In An Impossible Quagmire Of Selecting Among Competing Viewpoints 11

TABLE OF CONTENTS – Continued

Page

D. The First Amendment Protects The Unpopular 14

CONCLUSION 15

TABLE OF AUTHORITIES

Page

CASES

Bad Frog Brewery v. New York State Liquor Authority, 134 F.3d 87 (2d Cir. 1998) 8

Cohen v. California, 403 U.S. 15 (1971) 12

In re Brunetti, Serial No. 85310960, 2014 WL 3976439 (T.T.A.B. Aug. 1, 2014) 1, 4

In re Lamson Oil Co., 6 USPQ2d 1041 (T.T.A.B. 1987) 12

In re Tam, 808 F.3d 1321 (Fed. Cir. 2015) 1, 2, 3

Kalman v. Cortes, 723 F. Supp. 766 (E.D. Pa. 2010 8

Pro-Football, Inc. v. Harjo, 415 F.3d 44 (D.C. Cir. 2005) 11

Sambo's Restaurants, Inc. v. City of Ann Arbor, 663 F.2d 686 (6th Cir. 1981) 9

Texas v. Johnson, 491 U.S. 397 (1989) 14

STATUTES

15 U.S.C. §1057(b) 5

15 U.S.C. §1060(a)(4) 6

15 U.S.C. §1065 11

15 U.S.C. §1072 6

15 U.S.C. §1115(a) 5

15 U.S.C. §1121(a) 6

15 U.S.C. §1121(b) 6

TABLE OF AUTHORITIES – Continued

Page

15 U.S.C. §1141(a) 6

28 U.S.C. §1331 6

OTHER AUTHORITIES

https://en.wikipedia.org/wiki/Colored 11

http://time.com/2894357/redskins-trademark-indian-interactive/ 10

Urbandictionary.com 10

www.trademark-clearinghouse.com 6

INTEREST OF AMICUS[1]

Amicus curiae Erik Brunetti is the appellant in a case pending before the Federal Circuit presenting a nearly identical issue as in this case. *See In re Brunetti*, CAFC No. 15-1109 (Fed. Cir. Jan. 21, 2016); the government discussed *Brunetti* in footnote 6 on page 23 of Petitioner's merits brief. Brunetti's application for a federal trademark registration for FUCT was refused under Section 2(a) of the Lanham Act as "vulgar." The United States Patent & Trademark Office ("PTO") incorrectly interpreted the prohibition against "scandalous" trademarks in Section 2(a) to include "vulgar" trademarks, but that issue is not before this Court. Brunetti appealed to the Trademark Trial and Appeal Board where the refusal was upheld. *See In re Brunetti*, Serial No. 85310960, 2014 WL 3976439 (T.T.A.B. Aug. 1, 2014).

Brunetti asserts the "scandalous" prohibition in Section 2(a) is an unconstitutional infringement on free speech. Brunetti's appeal was argued before the Federal Circuit a month after *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015), to a panel consisting of Judge Moore (author of the majority *en banc* opinion in *Tam*), Judge Dyk (author of a concurring and dissenting opinion in

[1] The parties in this case have consented to the filing of this brief. Copies of the blanket consent letters of the parties are on file with this Court. This brief was not authored in whole or in part by counsel for any party. No one other than the amicus curiae or its counsel made a monetary contribution to preparing or submitting this brief.

Tam) and Judge Stoll. It appears that the Federal Circuit is waiting for this Court's decision in *Tam* before deciding *Brunetti*. While it is possible that one of the Section 2(a) "disparaging" (in *Tam*) and "scandalous" (in *Brunetti*) prohibitions could survive while the other is unconstitutional, the issues are closely related. Accordingly, Brunetti is addressing some key matters that were not adequately briefed by the parties or other amici.

SUMMARY OF ARGUMENT

If it would be unconstitutional to deny copyright registration based upon content, then it would be unconstitutional to deny trademark registration based upon the content of the mark.

Although Respondent argues that denial of federal trademark registration is significant, it overlooks some very important consequences of that denial. There is a reason why virtually all successful trademarks are registered: the denial of registration makes it extremely difficult to use and protect that trademark.

The broader implications of holding Section 2(a) constitutional have not been adequately addressed. If Section 2(a) is constitutional, then any government (local, state or federal) could constitutionally prohibit the advertising, licensing or sale of any product or service that such government deems offensive. Any government could deny permits or licenses which prevent a

disfavored viewpoint from being effectively disseminated. Section 2(a) gives the majority, or a substantial composite of the disparaged group, a veto over what marks are used, even if the trademark owner seeks to raise social or political issues.

ARGUMENT

Section 2(a)'s provision, allowing the government to refuse trademark registration because a mark is unpopular is an invalid infringement of the First Amendment's guarantee of the right to free speech. So the prohibition against registering disparaging or scandalous marks should be held invalid.

I. SECTION 2(A) IS UNCONSTITUTIONAL AS TO TRADEMARKS BECAUSE IT WOULD BE UNCONSTITUTIONAL TO DENY COPYRIGHT REGISTRATION BASED UPON CONTENT

An analogy to copyright shows why Section 2(a) is unconstitutional as to trademarks. During the Federal Circuit oral argument in *Tam*, it seemed assumed that it would be unconstitutional for the government to deny copyright registration based upon content. Amicus agrees. In fact, the Copyright Office grants registrations for pornography, hate speech and nearly every other type of speech. Unless trademarks differ from copyrights in some relevant way, then Section 2(a) is likewise unconstitutional.

The distinction offered by the government is that trademarks are commercial speech. Both copyright and trademark protect the commercial rights of the owner, including controlling the use of the work or mark, or to obtain compensation for unauthorized use. Both copyright and trademark range from the purely commercial to core political speech. Copyright protects everything from the most "core" speech such as political and social discourse, to the most mundane commercial products (the "0s" and "1s" of software). Likewise, trademarks can range from the purely commercial to core political speech, such as STOP THE ISLAMIZATION OF AMERICA. The government is under the misapprehension that trademarks only identify commercial sources and are commercial speech. *See* Petitioner's brief, at page 48. However, trademarks often identify social, charitable, political or other non-commercial organizations. And trademarks often have a significant communicative function about the trademark owner's opinions and goals. In the case of this Amicus, Brunetti's trademark is FUCT and it was refused by the PTO as vulgar. However, to the extent it has a meaning, it is FRIENDS U CAN'T TRUST. The T.T.A.B. decision affirming the refusal to register was explicitly based upon Brunetti's alleged "assaults on American culture[,] critique capitalism, government, religion and pop culture." *In re Brunetti*, Serial No. 85310960, 2014 WL 3976439 (T.T.A.B. Aug. 1, 2014), at page 3. In other words, the T.T.A.B. refused to register his trademark *because of Brunetti's core political speech*.

Is there some other difference between the copyright and the trademark statutes that would allow one to be constitutional and the other not? In short, no. Both are recording systems; once the applicant complies with all requirements the registration ensues. The government makes no substantive evaluation of the copyrighted work or the trademark. The government does not approve or edit the work or the mark. For both copyright and trademark, it is not practical to enforce the owner's rights without registration. The First Amendment would not permit the government to refuse copyright registration due to content; ergo, it is not constitutional for the government to refuse registration of a trademark based upon its content.

II. DENIAL OF TRADEMARK REGISTRATION MAKES USE IMPRACTICAL

The government asserts it is not prohibiting speech because it is possible to use a trademark even if not registered. However, the adverse consequences of denial of federal trademark registration are so severe that use of such trademarks is impractical. Respondent's Brief notes at page 19 some of the consequences suffered by a person who is unable to obtain a federal registration. Those consequences are significant enough. Without a federal registration, the trademark owner is denied the *prima facie* evidence of ownership of the trademark and her exclusive right to use the mark. 15 U.S.C. §§1057(b), 1115(a). So, she has to prove ownership and secondary meaning in every case. Without a federal registration, there is no constructive

nationwide use, so the trademark user is always at risk of some third party commencing use of the mark in some other part of the nation. *Id.* §1072. Without a federal registration, the trademark owner cannot use the "intent-to-use" provisions that make the application date the constructive first use date. The constructive use date allows the owner to get its application approved prior to the product launch. It also prevents third parties from hearing of the trademark and appropriate the mark by rushing to market first. These are sufficient to show that the government is placing an unwarranted burden on disfavored speech.

Not mentioned in Respondent's Brief are other significant adverse consequences. Without a federal registration, a trademark owner cannot record a security interest with the PTO, making it difficult to obtain financing. *Id.* §1060(a)(4). Without a federal registration, it is difficult to sell a brand because the owner does not have any concrete evidence of ownership to show prospective purchasers. Without a federal trademark registration, a trademark owner based in the United States cannot take advantage of the Madrid Protocol, a treaty allowing nationals of the United States to obtain trademark protection in other countries using the World Intellectual Property Organization. *Id.* §1141(a). The Madrid Protocol cuts the cost of foreign trademark filings by about half. Federal subject matter jurisdiction is assured with a federal registration. 15 U.S.C. §1121(a) and 28 U.S.C. §1331. Local governments are prohibited from requiring alteration of registered marks. 15 U.S.C. §1121(b). Non-governmental agencies, such as Internet auction websites and the

Internet domain name pre-registration service (www.trademark-clearinghouse.com) require proof of ownership of a trademark before cancelling the auctions for counterfeit merchandise, or to block others from using the trademark as a domain name. Usually that proof is a federal trademark registration.

The package of rights that go with federal registration are so significant that the denial of federal registration is the practical equivalent of prohibition of use. There is a reason almost every famous trademark is registered, and why unregistered trademarks are rarely successful. It is not practical to build a successful brand without federal registration. In short, if the government can withhold trademark registration, the brand is only allowed to speak in a remote part of Hyde Park, but not at Speakers' Corner where the audience is.

III. BEFORE HOLDING SECTION 2(A) CONSTITUTIONAL THE COURT SHOULD CONSIDER BROADER IMPLICATIONS BEYOND TRADEMARKS

This Court should consider the astounding implications of holding Section 2(a) constitutional. The implications go far beyond whether a federal trademark registration is issued.

A. If Section 2(a) Is Constitutional It Opens The Door To Widespread Governmental Discrimination Against Unpopular Messages

Although this case only involves the question of whether Section 2(a) allows refusal or cancellation of trademarks with unpopular meanings, the Court will establish a precedent that will apply by analogy to other licensing areas. In the past, governments have tried to deny benefits or licenses because a trademark is unpopular.

If Section 2(a) is constitutional, then it follows that Congress could amend the Copyright Act to deny copyright registration to disparaging works. Congress could also prohibit transportation in commerce of goods and services bearing trademarks that have been refused. The federal government could refuse broadcast licenses for TV or radio stations if the corporate name is disparaging. Any level of government could deny licenses based upon the government's dislike of the applicant's trademark. In *Bad Frog Brewery v. New York State Liquor Authority*, 134 F.3d 87 (2d Cir. 1998), New York refused permission for a beer company to use a picture of a frog. The Second Circuit held that the prohibition of use of the beer company's label violated the First Amendment. In *Kalman v. Cortes*, 723 F. Supp. 766 (E.D. Pa. 2010), Pennsylvania refused to register I Choose Hell Productions LLC as an entity name, due to a state statute that barred corporate names containing "[w]ords that constitute blasphemy, profane, cursing or swearing or that profane the Lord's

name." The district court held the statute unconstitutional. But, if Section 2(a) is constitutional, states could refuse corporate names because they are perceived as disparaging or scandalous. This means states could make it impossible for unpopular political, social and religious groups to register their names.

If Section 2(a) is constitutional, states and cities could refuse sales tax permits, business licenses or even occupancy permits based upon the name of the applicant. This is not mere conjecture: a city refused permits for a Sambo's restaurant because its trademark logo was deemed offensive to African-Americans. *Sambo's Restaurants, Inc. v. City of Ann Arbor*, 663 F.2d 686 (6th Cir. 1981). Such refusal was held unconstitutional. But if Section 2(a) is constitutional, such decisions by local governments would be lawful. Local governments, depending on whether liberal or conservative, could deny organizations (whether it be the NRA or Planned Parenthood, or some smaller organization with an edgier name, for example Black Lives Matter) licenses (including building permits, sales tax authorizations, business licenses or occupancy permits), thus effectively preventing them from functioning in such localities. Certainly, it would follow that the District of Columbia could prohibit the sale of "Redskins" merchandise. If Section 2(a) is constitutional, there would seem to be no reason why a city could not entirely prohibit the sale of such products anywhere in its jurisdiction.

The logical consequences of a finding that Section 2(a) is constitutional illustrate why Section 2(a) is an unconstitutional burden on speech.

B. Section 2(a) Undermines One Of The Purposes Of The Lanham Act: The Protection Of The Interests Of Trademark Owners

The trademark registration system was designed to protect the public from confusion. It was also intended to protect the trademark owner's investment. As mentioned above, without federal registration, a trademark owner's ability to protect its mark is severely limited. However, there is a more significant problem. Acceptable names for ethnic groups or their members change over time. "Eskimo" is now considered "offensive" (see Google definition) or "derogatory" (per Urbandictionary.com). That means the beloved snack ESKIMO PIE could not be registered now (which would be needed if the registration should accidentally lapse, if registration is needed in different form or for other types of goods). What about the hundreds of registrations for INDIAN or depicting Native Americans (on motorcycles, clothing and smoking products)? http://time.com/2894357/redskins-trademark-indian-interactive/. It is possible that many could be cancelled. The culturally acceptable terms for African-Americans have evolved from Colored, Negro, Black, to African-American. NAACP cannot obtain any new registrations because "[i]n the 21st century, 'colored' is generally regarded as an offensive term." https://en.wikipedia.

org/wiki/Colored. Negro is "dated, offensive" according to the Google definition, so that would mean that United Negro College Fund cannot now register its name.

The Lanham Act provides that, after five years, a registration may become "incontestable" under Section 15. 15 U.S.C. §1065. However, Section 15 excludes from its protection challenges under Section 2(a). So, no mark, no matter how old or how long it has been used, is safe from a Section 2(a) challenge. Nor does equity provide any protection for established rights. Laches does not start until the person seeking cancellation has standing to sue, *i.e.*, becomes eighteen years old. *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005). So, any group, by selecting a young person who has just turned eighteen as the petitioner, could file a cancellation action and that claim would be timely.

Does it make sense to have established brands and institutions be subject to attack after decades of unobjected usage? Does not the First Amendment give people and organizations the right to call themselves whatever they want, even if some people might be offended? Section 2(a) should be invalidated.

C. Holding Section 2(a) Constitutional Would Put The Government In An Impossible Quagmire Of Selecting Among Competing Viewpoints

The saying is, "be careful what you wish for, because you may get it." The government cannot seriously want

to be selecting among competing political, social, religious, ethnic and other groups and viewpoints. Yet, if the PTO is serious about prohibiting registration of marks that offend people (because disparaging, scandalous, immoral or vulgar), then that would become its impossible task. That it is impossible can be shown by actual decisions of examining attorneys. The trademark MILF has been approved 23 times, but refused 20 times. Marks including each of the following have been both approved and refused: ANAL, ASS, BITCH, COCK, POTHEAD, SHIT, SLUT, WHORE. Words are sometimes approved by the PTO and sometimes refused: DAGO, HEEB, INJUN and SQUAW. CUM TOGETHER has been both approved and refused. DYKES ON BIKES and DYKE NIGHT have been approved, while 2 DYKES MINIMUM was refused.

Misspellings are disregarded in determining what trademarks mean. *In re Lamson Oil Co.*, 6 USPQ2d 1041 (T.T.A.B. 1987) (finding TRUCOOL and TURCOOL confusingly similar in appearance). So how is it that FCUK is registrable but FUCT is not? A man can wear a jacket into a courthouse that says "Fuck the Draft" (*Cohen v. California*, 403 U.S. 15 (1971)), but he cannot register such term as a trademark for his organization if Section 2(a) is constitutional.

In evaluating trademarks, the PTO considers the mark's meaning. No one mistakes what WTF, PHUC and F*WORD refer to, so why are they registered when other marks including "fuck" are not. KKK, N*WORD and SLAVE are all registered. HOMOPHOBIA with X

is registered while I'M COMFORTABLE WITH MY HOMOPHOBIA was refused. THE DEVIL IS A DEMOCRAT was approved while HAVE YOU HEARD SATAN IS A REPUBLICAN was refused. REDMAN, INDIAN, ESKIMO, CRACKER, RUSTLER, HONKY, WHITEY and WASP have all been approved, while there is little doubt that at least a portion of the referenced groups in question (Native Americans, Southern whites, Anglo-Saxon Protestants, etc.) would consider these terms disparaging.

In the context of religion, the PTO's problems get even more complicated because free exercise and nonentanglement are involved. The majority of Christians would find devil worship to be offensive, but what about the rights of Wiccans? DEVIL and WICCAN have been approved. Junipero Serra was recently made a saint by the Catholic Church. But Native Americans assert that Serra committed cultural genocide. The Virgin Mary and saints in general are seen differently by Catholics and some Protestants. So, does the PTO take sides when it is asked to register MADONNA, LA VIRGEN DE GUADALUPE, or other saints' names? What about break-away denominations? Does the PTO take sides just because a majority is offended by a smaller group's use of a name, e.g., OLD CATHOLIC CHURCH IN THE UNITED STATES? Should churches have the ability to register their names as trademarks subject to the will of a group or a majority?

In the context of social and political discourse, it is unlikely that there will be a consensus about abortion,

gun control, immigration or other political issues. Yet, pro and con groups may wish to register their names and slogans, which *ipso facto* will be offensive to those with contrary views. How does the PTO decide whose side to take?

To date, the PTO has not done a consistent job of refusing trademarks that are allegedly offensive. Even if the government could by some miracle start being consistent, and even if acceptable terms never changed, the government would still have to take sides in contentious disputes about what is acceptable politically or socially. If Section 2(a) is constitutional, the government will have to decide who is "right" in religious, social or political disputes. That is *not* what the government should be doing. The government should process applications and let the free marketplace of ideas decide which brands will succeed or fail.

D. The First Amendment Protects The Unpopular

Section 2(a) allows a part of society to import their opinions on others. This is the tyranny of the majority, or in the case of disparagement, the tyranny of a portion of a minority group. "If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." *Texas v. Johnson*, 491 U.S. 397, 414 (1989). A free marketplace of goods and services and a

free marketplace of ideas are intertwined. The government should not put the brakes on those whose ideas differ or are unpopular.

CONCLUSION

This Court should affirm the judgment of the *en banc* decision of the Federal Circuit.

Respectfully submitted,

JOHN R. SOMMER
Counsel of Record
DEVON A. BECKWITH
17426 Daimler Street
Irvine, California 92614
(949) 752-5344
sommerjohnr@gmail.com

RECORD AND BRIEF

Supreme Court, U.S.
FILED
DEC 16 2016

No. 15-1293

In the Supreme Court of the United States

Michelle K. Lee, Under Secretary of Commerce for Intellectual Property and Director, United States Patent and Trademark Office,
Petitioner,

v.

Simon Shiao Tam,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF THE CATO INSTITUTE AND A BASKET OF DEPLORABLE PEOPLE AND ORGANIZATIONS AS *AMICI CURIAE* SUPPORTING RESPONDENT

Ilya Shapiro
Counsel of Record
Thomas A. Berry
CATO INSTITUTE
1000 Mass. Ave., N.W.
Washington, DC 20001
(202) 842-0200
ishapiro@cato.org
tberry@cato.org

December 16, 2016

Library of Congress

QUESTION PRESENTED

Does the government get to decide what's a slur?

TABLE OF CONTENTS

Page

QUESTION PRESENTED i

TABLE OF AUTHORITIES iv

INTEREST OF *AMICUS CURIAE* 1

SUMMARY OF ARGUMENT 1

ARGUMENT 7

I. "DISPARAGING" LANGUAGE SERVES AN IMPORTANT ROLE IN OUR SOCIETY 7

A. Reclaiming Slurs Has Played a Big Part in Personal Expression and Cultural Debate ... 7

B. Rock Music Has a Proud Tradition of Pushing the Boundaries of Expression 10

II. THE GOVERNMENT SHOULD NOT BE DECIDING WHAT'S A SLUR 12

A. It Is Impossible to Draw an Objective Line as to What Is Disparaging 12

B. Brands That Do Not Wish to Offend Can Change Their Names Voluntarily 19

III. THE DISPARAGEMENT CLAUSE VIOLATES THE FIRST AMENDMENT 22

A. The Disparagement Clause Is a Viewpoint-Based Unconstitutional Condition 22

B. A Trademark Is Neither a Subsidy Nor an Endorsement 23

1. Choosing which artists and speakers to fund with limited resources is different than trademark registration. 24

2. Spending other people's money on political activity is unlike trademark registration. 24

3. Trademarks are not endorsements. 25

4. The government is incoherent because it admits that it uses resources to protect both registered and unregistered trademarks. 27

C. Expanding the "Government Assistance" Exception Risks Swallowing the Rule 28

D. The Government May Not Discourage Speech to Protect People from Being "Bombarded" with Opposing Views 30

CONCLUSION 34

APPENDIX: DESCRIPTION OF *AMICI* 1A

TABLE OF AUTHORITIES

Page(s)

Cases

B&B Hardware, Inc. v. Hargis Industries, Inc.,
135 S. Ct. 1293 (2015) 2

Bradwell v. Illinois,
83 U.S. 130 (1872) 27

Buck v. Bell,
274 U.S. 200 (1927) 27

Buckley v. Valeo,
424 U.S. 1 (1976) 3

Cohen v. California,
403 U.S. 15 (1971) 12

Davenport v. Wash. Educ. Ass'n,
551 U.S. 177 (2007) 24, 25

Dred Scott v. Sandford,
60 U.S. 393 (1856) 27

Erznoznik v. Jacksonville,
422 U.S. 205 (1975) 34

Flying Dog Brewery, LLLP v. Mich. Liquor Control Comm'n, 597 Fed. Appx. 342 (6th Cir. 2015) 4A

In re In Over Our Heads,
No. 755,278, 1990 WL 354546 (T.T.A.B. 1990) 13

Leathers v. Medlock,
499 U.S. 439 (1991) 28

National Endowment for the Arts v. Finley,
524 U.S. 569 (1998) 24

National Socialist Party of America v. Village of Skokie, 432 U.S. 43 (1977) 30

Perry v. Sindermann,
408 U.S. 593 (1972) 22, 28

Plessy v. Ferguson,
163 U.S. 537 (1896) 27

Pro-Football, Inc. v. Blackhorse,
112 F. Supp. 3d 439 (E.D. Va. 2015) 32

Regan v. Taxation With Representation of Wash.,
461 U.S. 540 (1983) 24

Rust v. Sullivan,
500 U.S. 173 (1991) 24

Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Board, 502 U.S. 105 (1991) 28, 29

Snyder v. Phelps,
562 U.S. 443 (2011) 34

United States v. American Library Ass'n,
539 U.S. 194 (2003) 24

Walker v. Texas Div., Sons of Confed. Veterans, Inc.,
135 S. Ct. 2239 (2015) 26

Williams v. Rhodes,
393 U.S. 23 (1968) 3

Ysursa v. Pocatello Educ. Ass'n,
555 U.S. 353 (2009) 24

Constitutional Provisions

U.S. Const. art. I, § 8, cl. 8 28

Statutes

15 U.S.C. § 1127 29

Other Authorities

11 Brand Names that Simply Couldn't Survive the Times, Adweek, March 18, 2015 http://bit.ly/1x0jkRb 21

Alexandra Petri, *Literally, Joe Biden*, Wash. Post, Sept. 7, 2012, http://wapo.st/2hpA521 30

Amy Chozick, *Hillary Clinton Calls Many Trump Backers 'Deplorables,' and G.O.P Pounces*, N.Y. Times, Sept. 10, 2016, http://nyti.ms/2cCNnXd 2

Barack Obama's Speech on Father's Day, June 15, 2008, available at http://bit.ly/2ggKS0H 9

Cavalier, Encyclopedia Britannica (11th ed. 1911), http://bit.ly/2gZ14BT 4

Christopher M. Fairman, *Fuck: Word Taboo and Protecting Our First Amendment Liberties* (2009) 20

Don Reisinger, *Isis Wallet Becomes Softcard to Avoid Confusion with Militant Group*, CNET, Sept. 3, 2014, http://cnet.co/2gzkfSf 21

Dyke Life: From Growing Up to Growing Old, a Celebration of the Lesbian Experience (Karla Jay, ed. 1996) 7

Elizabeth Wurtzel, *Bitch: In Praise of Difficult Women* (1998) 7

Eric Bogosian, *Chris Rock Has No Time for Your Ignorance*, N.Y. Times Magazine, Oct. 5, 1997, http://nyti.ms/2g5SO6c 9

Erik S. Jaffe, *When Easy Cases Make Bad Law*, 2006–2007 Cato Sup. Ct. Rev. 115 (2007) 25

Eve Ensler, *The Vagina Monologues* (1998) 7

"Hillbilly," Wikipedia, http://bit.ly/2h1QjBa 4

Inga Muscio, *Cunt: A Declaration of Independence* (1998) 7

J.D. Vance, *Hillbilly Elegy* (2016) 4

Jeremy Gordon, *The Band Formerly Known as Viet Cong Announce New Name*, Pitchfork.com, (April 21, 2016), http://bit.ly/1rp03b8 21-22

Jerome McCristal Culp, Jr., *Water Buffalo and Diversity: Naming Names and Reclaiming the Racial Discourse*, 26 Conn. L. Rev. 209 (1993) 14

Jerry L. Martin, *Should Alumni Remain Silent?*, 8 Academic Questions 70 (1995) 14

Jim Goad, *The Redneck Manifesto* (1997) 7

Jimmy Stamp, *Political Animals: Republican Elephants and Democratic Donkeys*, Smithsonian.com (Oct. 23, 2012), http://bit.ly/2gzmfKa 4

Joan Biskupic, *Justice Ruth Bader Ginsburg Calls Trump a "Faker," He Says She Should Resign*, Cnn.com, July 11, 2016, http://cnn.it/29zSCUS 3

John McWhorter, *"Tar Baby" Isn't Actually a Racist Slur*, The New Republic, Aug. 3, 2011, http://bit.ly/2gYZpMJ 15

John McWhorter, *Is "Colored People" a Slur?*, CNN.com, Aug. 23, 2016, http://cnn.it/2bTCp2f .. 16

Jonathan Eig, *This Woman Wants You to Call Her Bastard*, Offspring, June/July 2000 7

Kathleen Bishop, *Cracker Day Fun for All*, Flagler-Palm Coast Community Times, Mar. 29, 2000 8

Katy Steinmetz, *Everything You Need to Know About the Word 'Suffragette'*, Time, Oct. 22, 2015, http://ti.me/2he2Cvn 4

List of Schools that Changed Native American Nicknames, USA Today, Sept. 24, 2013, http://usat.ly/2gzt5zl 20

Louis Leroy, Visual Arts Encyclopedia (last visited Dec. 2, 2016), http://bit.ly/2h32pKO 4

Margery Post Abbott et al., *Historical Dictionary of the Friends (Quakers)* (2003) 3

Mario Sevilla, *Lohan Calls Obama "Colored," NAACP Says No Big Deal*, Mercury News, Nov. 12, 2008, http://bayareane.ws/2h2btxc 16

Mark Mooney, *'Yankee Doodle Dandy' Explained and Other Revolutionary Facts*, ABC News, July 4, 2014, http://abcn.ws/1zcxHQk 4

Mary Fairchild, *Methodist Church History*, About.com (last updated Dec. 2, 2016), http://abt.cm/2g5TWGZ 3

Matt Richards & Mark Langthorne, *Somebody to Love: The Life, Death, and Legacy of Freddie Mercury* 127 (2016) 11

Merriam-Webster's Dictionary, http://bit.ly/1LrwxH1 15

Michael du Plessis & Kathleen Chapman, *Queercore: The Distinct Identities of a Subculture*, 24 College Lit. 45 (1997) 11

Michael Thomas Ford, *That's Mr. Faggot to You: Further Trials from My Queer Life* (1999) 7

Michael Warner, *The Trouble with Normal: Sex, Politics and the Ethics of Queer Life* (1999) 7

Moriah Balingit, *School District Weighs Ban of 'Mockingbird,' 'Huckleberry Finn' after Complaint*, Wash. Post, Dec. 3, 2016, http://wapo.st/2gGFmSJ 18

N.W.A., "Straight Outta Compton" on *Straight Outta Compton* (Ruthless Records 1988) 11

Niggas vs. Black People, in Chris Rock, *Rock This!* (1997) 8-9

Pansy Division: Life in a Gay Rock Band (Last Rites Productions 2008) 11

Randall Kennedy, *Nigger: The Strange Career of a Troublesome Word* (2002) ..... *passim*

Randall Kennedy, *Who Can Say 'Nigger'? And Other Considerations*, 26 J. of Blacks in Higher Educ. 86 (2000) 17

Rare Edition of 'Mein Kampf' Stolen, UPI, Sept. 22, 1991, http://bit.ly/2g5PCHS 30

Reid Neilson, *Exhibiting Mormonism: The Latter-day Saints and the 1893 Chicago World's Fair* (2011) 3

Seinfeld, *The Yada Yada* (first aired April 24, 1997) 5-6

Society of Jesus, Catholic Encyclopedia (1913), http://bit.ly/2gN6i63 3

South Park, *It Hits the Fan* (first aired June 20, 2001) 17

South Park, *With Apologies to Jesse Jackson* (first aired March 7, 2007) 9-10, 18

Stephen Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 Trademark Reporter 661 (1993) 13, 31

Straight Outta Compton (Universal Pictures 2015) 11

Ta-Nehisi Paul Coates, *Why "Tar Baby" Is Such a Sticky Phrase*, Time, Aug. 1, 2006, http://ti.me/2h2Zfqk 15

The Vagina Monologues (HBO Films 2002) 8

Trump: Mexico Not Sending Us Their Best; Criminals, Drug Dealers And Rapists Are Crossing Border, RealClearPolitics, June 16, 2015, http://bit.ly/1GNRCpd 2

Yolanda Woodlee, *D.C. Mayor Acted "Hastily," Will Rehire Aide*, Wash. Post, Feb. 4, 1999, http://wapo.st/1j4yg7V 15

INTEREST OF *AMICI CURIAE*[1]

Amici are the following organizations and individuals, whose biographies appear in the appendix: the Cato Institute, P.J. O'Rourke, Nadine Strossen, Erik Nielson, Clay Calvert, Ralph Steadman, Flying Dog Brewery, the Comic Book Legal Defense Fund, DKT Liberty Project, and Reason Foundation.

Amici are committed to preserving free expression and pushing people out of their comfort zones. This case concerns *amici* because we all say things that some people find offensive or even disparaging—but it's not the government's role to make that judgment.

SUMMARY OF ARGUMENT

This case is about whether an Asian-American rock band called The Slants can trademark and own their own name. The Slants are a group of artists who have formed an identity "to take on these stereotypes that people have about us, like the slanted eyes, and own them." Resp. Cert. Brief 3. Some agree with The Slants' approach and some disagree, as is normal in a robust artistic marketplace. What's not normal is that the government has chosen sides in this debate, punishing The Slants for their choice of name by denying them federal trademark registration.

This punishment is the result of the "disparagement clause" in the federal trademark statute, the Lanham Act, which bars the registration of "matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them

---

[1] Rule 37 statement: Both parties lodged blanket consents to the filing of *amicus* briefs. Further, no counsel for any party authored this brief in whole or in part and no person or entity other than *amici* funded its preparation or submission.

into contempt or disrepute." Pet. App. 6a. As artists know, the denial of trademark registration comes with severe negative consequences, since the "benefits of registration are substantial." *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 1310 (2015). Faced with this potential punishment, many artists, advocacy groups, and businesses will simply choose a different name. The government's rule thus discourages some names and encourages others.

This Court should make the jobs of the employees at the U.S. Patent and Trade Office (PTO) much easier and put an end to the disparagement clause. Trying to stamp out "disparaging" speech is both misguided and unconstitutional. No public official can be trusted to neutrally identify speech that "disparages." Moreover, disparaging speech has been central to political debate, cultural discourse, and personal identity for as long as this country has existed.[2]

Disparaging epithets long ago entered our political vocabulary, encapsulating criticisms more succinctly than any polite term ever could. Schoolchildren today learn that Millard Fillmore ran for president in 1856 as the candidate of the "Know-Nothing" Party; few adults could tell you the party's "real" name. Yet a hypothetical 1856 PTO would likely have denied registration to a group called "Defeat the Know-Nothings" (disparaging to American Party members),

---

[2] For example, we recently concluded a presidential campaign in large part defined by pronouncements that large groups of people found to be personally disparaging. *See, e.g., Trump: Mexico Not Sending Us Their Best; Criminals, Drug Dealers And Rapists Are Crossing Border*, RealClearPolitics, June 16, 2015, http://bit.ly/1GNRCpd; Amy Chozick, *Hillary Clinton Calls Many Trump Backers 'Deplorables,' and G.O.P Pounces*, N.Y. Times, Sept. 10, 2016, http://nyti.ms/2cCNnXd.

just as the real PTO has denied registration to "Abort the Republicans" (disparaging to Republicans), "Democrats Shouldn't Breed" (disparaging to Democrats), and a logo consisting of the communist hammer-and-sickle with a slash through it (disparaging to Soviets). Pet. App. 8a. Political speech, including the right to criticize parties and politicians without government punishment, is recognized by this Court as "at the core of our electoral process and of the First Amendment freedoms." *Buckley v. Valeo*, 424 U.S. 1, 39 (1976) (quoting *Williams v. Rhodes*, 393 U.S. 23, 32 (1968)).[3] Thus, denial of a statutory trademark right represents particularly egregious government action that violates the First Amendment.

But the suppression of political speech is not the only problem arising from the disparagement clause. As this case shows, supposedly "disparaging" speech is often part of an effort to reclaim a word from its pejorative meaning. Efforts like this have already had a profound influence on the development of many groups' identities. Jesuits, Methodists, Mormons, and Quakers owe their popular names to terms that were originally given to them in a disparaging context, and that have since been reclaimed.[4] Without disparaging

---

[3] Indeed, questioning the character of our politicians is such a cherished American tradition that a member of this Court recently engaged in it herself. *See* Joan Biskupic, *Justice Ruth Bader Ginsburg Calls Trump a "Faker," He Says She Should Resign*, CNN.com, July 11, 2016, http://cnn.it/29zSCUS.

[4] *See Society of Jesus*, Catholic Encyclopedia (1913), http://bit.ly/2gN6i63; Mary Fairchild, *Methodist Church History*, About.com (last updated Dec. 2, 2016), http://abt.cm/2g5TWGZ; Reid Neilson, *Exhibiting Mormonism: The Latter-day Saints and the 1893 Chicago World's Fair* 24 (2011); Margery Post Abbott et al., *Historical Dictionary of the Friends (Quakers)* xxxi (2003).

epithets, our vocabulary would be deprived of such terms as "cavalier," "yankee," "impressionist" (Renoir, not Rich Little), and "suffragette."[5] How did a donkey become the Democratic Party symbol? A political opponent labeled Andrew Jackson a "jackass," so Jackson put the animal on campaign posters. *See* Jimmy Stamp, *Political Animals: Republican Elephants and Democratic Donkeys*, Smithsonian.com (Oct. 23, 2012), http://bit.ly/2gzmfKa. An 1820s PTO might have stopped him.

More recently, the author of the bestselling *Hillbilly Elegy* (2016) narrated his escape from the hollows of Kentucky to help explain our populist political moment. J.D. Vance does for "hillbillies"—a term even Wikipedia considers to be derogatory, http://bit.ly/2h1QjBa—what David Brooks did for "bobos" (bourgeois bohemians): explain conversationally an important yet disturbing slice of Americana.

Rock bands in particular often pick names *because* they are "disparaging." The Slits, the Queers, Queen, Pansy Division, N.W.A. (Niggaz Wit Attitudes), and the Hillbilly Hellcats—there's that word again—are just a few examples. Other bands, looking to push the envelope both musically and culturally, have chosen names like the Sex Pistols, Dead Kennedys, Butthole Surfers, Rapeman, Snatch and the Poontangs, Pussy Galore, Dying Fetus, and many, many more.

---

[5] *Cavalier*, Encyclopedia Britannica (11th ed. 1911), http://bit.ly/2gZ14BT; Mark Mooney, *'Yankee Doodle Dandy' Explained and Other Revolutionary Facts*, ABC News, July 4, 2014, http://abcn.ws/1zcxHQk; *Louis Leroy*, Visual Arts Encyclopedia (last visited Dec. 2, 2016), http://bit.ly/2h32pKO; Katy Steinmetz, *Everything You Need to Know About the Word 'Suffragette'*, Time, Oct. 22, 2015, http://ti.me/2hc2Cvn.

Further, the disparagement clause is unconstitutionally vague. Its application will always be unpredictable, because nearly any brand could be taken as disparaging by some portion of some group. Take, for low-hanging fruit, Aunt Jemima, Uncle Ben, the Cleveland Indians' Chief Wahoo, the women in La Tortilla Factory, or the Keebler Elves. *Amicus* Flying Dog Brewery has its own history of legal disputes over beer names like "Raging Bitch." *See* next page and appendix. Determining whether a term is disparaging is an incredibly complex endeavor that the government can't possibly be equipped to handle.

For example, one of this brief's authors is a cracker (as distinct from a hillbilly) who grew up near Atlanta, but he wrote this sentence, so we can get away with saying that.[6] Another contributor—unnamed because not a member of the bar—is an Italian-American honky who has always wanted to play in a band called the Dagos, which of course would close every set with "That's Amore" from "Lady and the Tramp." But, with only his great grandparents having come from Italy, is he dago enough to "take back" the term? And *amici*'s lead counsel is a Russian-Jewish émigré who's now a dual U.S.-Canadian citizen. Can he make borscht-belt jokes about Canuck frostbacks even though the first time he went to shul was while clerking in Jackson, Mississippi?[7]

---

[6] But he only moved to Atlanta when he was 10 and doesn't have a southern accent—and modern Atlanta isn't really part of the South—so maybe we can't.

[7] In one Seinfeld episode, Jerry is concerned that a friend who recently converted to Judaism did it "just for the jokes":

Jerry: And then he asked the assistant for a schtickle of fluoride.

It gets complicated. And that's the point. The disparagement clause places an unconstitutional condition on those who consider the use of an edgy or taboo phrase to be part of their brand.

None of the government's justifications for an exception to the doctrine carry weight: registering a trademark is not a public subsidy or endorsement. The Court should recognize that trademarks are in no way official speech and reaffirm that the government may not put its thumb on the scale to push controversial viewpoints out of the public square.

Elaine: Why are you so concerned about this?

Jerry: I'll tell you why. Because I believe Whatley converted to Judaism just for the jokes.

Jerry: So Whatley said to me, "Hey, I can make Catholic jokes, I used to be Catholic."

. . .

Jerry: Don't you see what Whatley is after? Total joke telling immunity. He's already got the two big religions covered, if he ever gets Polish citizenship there'll be no stopping him.

Seinfeld, *The Yada Yada* (first aired April 24, 1997).

ARGUMENT

I. "DISPARAGING" LANGUAGE SERVES AN IMPORTANT ROLE IN OUR SOCIETY

A. Reclaiming Slurs Has Played a Big Part in Personal Expression and Cultural Debate

The PTO has inserted itself into a cultural debate. It's no secret that for centuries, people have used language to ridicule and debase. Slurs have been used to stereotype groups, to label its members as inferior, and to express contempt in a universal shorthand. But for just as long, some of the people in these very groups have decided that the explosive power of these charged words does not have to be monopolized by those who seek to demean.

As Randall Kennedy has described, these people "have thrown the slur right back in their oppressors' faces. [Blacks] have added a positive meaning to *nigger*, just as women, gays, lesbians, poor whites, and children born out of wedlock have defiantly appropriated and revalued such words as *bitch*, *cunt*, *queer*, *dyke*, *redneck*, *cracker*, and *bastard*." Randall Kennedy, *Nigger: The Strange Career of a Troublesome Word* 38 (2002).[8]

---

[8] Kennedy cites, as examples, Michael Thomas Ford, *That's Mr. Faggot to You: Further Trials from My Queer Life* (1999); Michael Warner, *The Trouble with Normal: Sex, Politics and the Ethics of Queer Life* (1999); Eve Ensler, *The Vagina Monologues* (1998); Inga Muscio, *Cunt: A Declaration of Independence* (1998); Elizabeth Wurtzel, *Bitch: In Praise of Difficult Women* (1998); Jim Goad, *The Redneck Manifesto* (1997); *Dyke Life: From Growing Up to Growing Old, a Celebration of the Lesbian Experience* (Karla Jay, ed. 1996); Jonathan Eig, *This Woman Wants You to Call Her Bastard*, Offspring, June/July 2000;

Artists who choose to use such charged words do not always reach this decision easily. Frequently, their works reflect the artists' own attempts to grapple with a word, revealing precisely the debates and disagreements that make the choice to use it—if such a choice is made—so charged and powerful. *See, e.g.*, The Vagina Monologues (HBO Films 2002):

> [An audience member] also told me in the course of our conversation that I had said something negative about a particular word, a pejorative word, a word that's been used to declaim the vagina, and she needed to help me reconceive this word. So, for the next hour, she talked to me about this word. And when she was done, I was a convert. I wrote this for her. I call it: "Cunt." I've reclaimed it. "Cunt." I really like it. "Cunt." Just listen to it, listen to it: "Cunt."

Such debates, among artists and within one artist's body of work, would be impossible without a clear-throated acknowledgment of the words themselves.

This is not to say that the only meaningful cultural debates over the use of slurs and taboos words centers around purely positive reclamations. In some cases, artists and comedians have harnessed their power to send a critical message. For example, one of the most groundbreaking stand-up routines ever recorded, Chris Rock's "Niggas vs. Black People," engaged in cultural commentary that put some African Americans in a negative light—indeed, "disparaged" them. *See Niggas vs. Black People*, in Chris Rock,

---

Kathleen Bishop, *Cracker Day Fun for All*, Flagler-Palm Coast Community Times, March 29, 2000.

Rock This! 17–19 (1997). Many questioned and criticized both Rock's approach and, specifically, his use of "the N-word." *See, e.g.*, Eric Bogosian, *Chris Rock Has No Time for Your Ignorance*, N.Y. Times Magazine, Oct. 5, 1997, http://nyti.ms/2g5SO6c. ("Your audience is made up of whites, many of whom are happy to hear how lazy or stupid blacks are. You're using the word 'nigger.' And some of the white audience is saying, 'That's right.' . . . 'Nigger' is a heavy-duty word. You better have a good reason for using it."). Yet the routine had such cultural resonance that 12 years later it was cited positively by an African-American presidential candidate. *See* Barack Obama's Speech on Father's Day, June 15, 2008, available at http://bit.ly/2ggKS0H. ("Chris Rock had a routine. He said some—too many of our men, they're proud, they brag about doing things they're supposed to do. They say 'Well, I'm not in jail.' Well you're not supposed to be in jail!"). The 12-minute riff was undoubtedly an important contribution to an ongoing public debate—and its title and message undoubtedly would have been rejected by the PTO.

Of course many in the African-American community continue to disagree with comedians' decision to use racial epithets. Such disagreements are to be expected; it would be patronizing to assume that any racial or ethnic group would have a single monolithic view on any controversy.[9] But such disagreements

---

[9] Indeed, one harm of the government's approach, which attempts to discern whether a "substantial composite" of a given community has felt disparaged by a mark, is that it will naturally allow certain loud voices in a racial or ethnic community to "speak for" the entire group in determining whether a term has disparaged them. After all, asking a few self-anointed "community leaders" is much easier than ascertaining the sentiments of

over the true meaning and best approach to the use of a word are at the core of First Amendment debate.

We are not arguing—and the Court need not decide—that those who choose to use these words are always correct, whether they use them as a tool of pride or criticism. It is the PTO's rule, by effectively giving a veto power to those who *disagree* with such usage and punishing those who use them, which has impermissibly taken sides in this debate.

B. Rock Music Has a Proud Tradition of Pushing the Boundaries of Expression

Post-war popular music—from rock, to soul, to rap, to R&B, to punk—has consistently pushed the boundaries of expressive propriety. From its very beginnings, rock music has made parents uncomfortable, school teachers cringe, and officials riled up. It wouldn't be rock music if it didn't.

The boundaries of expression are generally congruent with the boundaries of social convention. Many marginalized groups have sought to challenge social conventions by choosing disparaging terms as

---

millions of members of a diverse group. *See* South Park, *With Apologies to Jesse Jackson* (first aired March 7, 2007):

Stan: Hey Token. I just wanted to let you know that everything is cool now. My dad apologized to Jesse Jackson.

Token: Oh I see, so I'm supposed to feel all better now.

Stan: Well, yeah.

Token: You just don't get it, Stan!

Stan: Dude, Jesse Jackson said it's okay!

Token: Jesse Jackson is not the emperor of black people!

Stan: (confused) He told my dad he was . . .

band names. The so-called "Queercore" or "Homocore" movement of the '80s, '90s, and 2000s was typified by bands like the Pansy Division, an all-gay rock band that explicitly adopted a disparaging epithet in their name. *See* Michael du Plessis & Kathleen Chapman, *Queercore: The Distinct Identities of a Subculture*, 24 College Lit. 45 (1997); Pansy Division: Life in a Gay Rock Band (Last Rites Productions 2008). When he came up with the name "Queen" for his legendary band, front man Freddie Mercury said he liked the "regal" sound, but he was also "certainly aware of the gay connotations." Matt Richards & Mark Langthorne, *Somebody to Love: The Life, Death, and Legacy of Freddie Mercury* 127 (2016).

"Taking back" disparaging epithets has also been a philosophy of rap and R&B music, both of which use variations of "nigger" in their lyrics and names. N.W.A., one of the most culturally significant groups of the past 30 years, is the most prominent example. Straight Outta Compton (Universal Pictures 2015). They grabbed the slur with pride, announcing to themselves and the world with the brazen opening line, "straight outta Compton, crazy motherfucker named Ice Cube, from the gang called niggaz wit attitudes." N.W.A., "Straight Outta Compton" on *Straight Outta Compton* (Ruthless Records 1988).[10]

---

[10] "A cursory survey just of titles yields Dr. Dre's 'The Day the Niggas Took Over,' A Tribe Called Quest's 'Sucka Nigga,' Jay-Z's 'Real Nigger,' the Geto Boys' 'Trigga Happy Nigga,' DMX's 'My Niggas,' and Cypress Hill's 'Killa Hill Nigga.' In 'Gangsta's Paradise,' meanwhile, Coolio declares, 'I'm the kind of nigga little homies want to be like on their knees in the night saying prayers in the streetlights.'" Kennedy, *supra*, at 35–36.

N.W.A. received a trademark for its name. That The Slants have been denied one for theirs only underscores the arbitrary and biased nature of the Lanham Act's disparagement clause.

Finally, band names are also chosen to convey valuable information about the music the band plays. It should come as no surprise that the Queers are not a Lawrence Welk cover band, the Revolting Cocks are not a string quartet, Dying Fetus does not play jazz standards, and Gay Witch Abortion would never open for Paul Anka. Similarly, The Slants have chosen a name that, through its insouciance, expresses something about their music—and the government's jejeune label of "disparaging" fails to capture the many levels of communication inherent in that name.

II. THE GOVERNMENT SHOULD NOT BE DECIDING WHAT'S A SLUR

A. It Is Impossible to Draw an Objective Line as to What Is Disparaging

As the Court has observed, "it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual." *Cohen v. California*, 403 U.S. 15, 25 (1971). The history of the disparagement clause is a textbook example of this problem.

In applying the clause, the PTO tries to "look[] at what message the referenced group takes from the applicant's mark in the context of the applicant's use," and then "den[y] registration only if the message received is a negative one." Pet. App. 22a–23a. Even the clause's defenders admit that "[p]redictability . . . is a real problem" and that "those

who are called upon to interpret the disparagement standard of Section 2(a) still are required to ascertain the subjective feelings of others regarding the use of the challenged trademarks." Stephen Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 Trademark Reporter 661, 668 (1993). And as the Federal Circuit pointed out, "the PTO [has] admitted that '[t]he guidelines for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one.'" Pet. App. 33a n.6 (quoting *In re In Over Our Heads*, No. 755,278, 1990 WL 354546, at *1 (T.T.A.B. 1990)). *See also id.* at 33a n.7 (listing examples of arbitrary PTO decisions).

Nonetheless, the government assures us that it knows how to draw an objective line as to what is "disparaging." If it seems to contradict itself in registering some marks and denying others, that is only because "analysis of whether a mark is disparaging requires consideration of the mark's meaning in relation to the particular goods and services for which registration is sought and the context in which the mark is used." Pet. Brief 51. For several reasons, we are less sanguine that such a neutral and objective arbiter of true disparagement can be found anywhere, let alone in the federal government.

First, history shows that people have often taken serious offense—that is, received a "negative" message—from words and phrases that also have perfectly innocuous meanings. Consider the infamous Penn "water buffalo" incident:

> Late on a Friday evening at the University of Pennsylvania [in 1993], freshman Eden Jacobowitz was studying in his dormitory room. After midnight, his study was interrupted by some boisterous sorority sisters, who happened to be black, celebrating outside his window. He and other students yelled out their windows at the students. Young Eden shouted, "Shut up you water buffalo!" When a campus judicial officer interrogated him, Mr. Jacobowitz told him what he had yelled and offered to apologize for his rudeness. Nevertheless, he was charged with having violated Penn's speech code prohibiting "racial harassment."

Jerry L. Martin, *Should Alumni Remain Silent?*, 8 Academic Questions 70, 70 (1995).

Since that incident, entire journal articles have been written debating whether this bovine analogy was a racial slur. *Compare* Jerome McCristal Culp, Jr., *Water Buffalo and Diversity: Naming Names and Reclaiming the Racial Discourse*, 26 Conn. L. Rev. 209, 225 (1993) ("In context, it is possible that this statement was in fact meant to be nonracial, but is it quite possible that one could not mistake the racial nature of the statement?") *with* Martin, *supra* at 70 ("[N]o one, including scholars in the university's ethnic studies department, could cite any previous use of the term 'water buffalo' as a racial slur."). If the brightest academic minds can debate whether a term was a racial slur for two decades, what hope does a single lawyer in the Trademark Office have?

There have been similarly intense controversies over the use of the word "niggardly," which has an

entirely innocuous dictionary definition[11] but happens to also sound similar to another word of less innocuous origins. Use of the word has become so controversial that one employee of the D.C. Mayor's Office lost his job for using it in a public meeting. *See* Yolanda Woodlee, *D.C. Mayor Acted "Hastily," Will Rehire Aide*, Wash. Post, Feb. 4, 1999, http://wapo.st/1j4yg7V. *See also* Kennedy, *supra*, at 94–96. What to make of such controversies? Perhaps there are some secret racists who receive a thrill from being able to say "niggardly" out loud and get away with it, like the second-grader who seems to enjoy saying "Hoover Dam" a bit too much. But most, surely, use the word only out of a desire to show that they know their way around a thesaurus. Which definition of "niggardly" would the government use if someone attempted to include the word in a trademark? The dictionary or the dog-whistle? It is hard to know, and that, again, is exactly the problem.

The list of such disputed slurs is endless. Yet more heated debates, for example, have raged over use of the term "tar baby." *See* Ta-Nehisi Paul Coates, *Why "Tar Baby" Is Such a Sticky Phrase*, Time, Aug. 1, 2006, http://ti.me/2h2Zfqk; John McWhorter, *"Tar Baby" Isn't Actually a Racist Slur*, The New Republic, Aug. 3, 2011, http://bit.ly/2gYZpMJ. Once again, the PTO would have us believe that although linguists, historians, and pundits disagree, everyone who works at 600 Dulany Street in Alexandria magically acquires the power to settle these debates.

Yet a further wrinkle is that sometimes the process of reclamation described above can occur in *re-*

---

[11] Niggardly (adj.): 1. Grudgingly mean about spending or granting. Merriam-Webster's Dictionary, http://bit.ly/1LrwxH1.

verse. That is, a term formerly considered respectful can evolve to be considered pejorative. Imagine, for example, that an entirely new organization were founded today with the term "colored people" in its name. Would this not at least raise some eyebrows at the PTO? After all, the term has evolved to the point where no one would now use it in polite company; a morning news anchor had to quickly apologize when she slipped up and used it on the air last summer. *See* John McWhorter, *Is "Colored People" a Slur?*, CNN.com, Aug. 23, 2016, http://cnn.it/2bTCp2f. Yet it is also true that, in 1910, the founders of this country's preeminent advocacy organization for African Americans "chose the word 'colored' because it was the most positive description commonly used at that time." *See* Mario Sevilla, *Lohan Calls Obama "Colored," NAACP Says No Big Deal*, Mercury News, Nov. 12, 2008, http://bayareane.ws/2h2btxc (interview with Carla Sims, Communications Director for NAACP in Washington, D.C.). Perhaps the NAACP is right that the term colored is "outdated and antiquated but not offensive." *Id.* But this raises the question: At what point between 1910 and the present would the PTO have ceased granting registration to marks using "colored"?[12] Once again, there is no clear answer.

But these problems of uncertainty are not limited to whether a term should be considered a slur. Even with words that are indisputably pejorative, it is still a complex question whether a given usage is meant to disparage, because of the process of reclamation. People will always, in good faith, disagree as to when, if ever, such "reclamatory" uses are positive for the group in question, and whether their use should be

---

[12] *See also* the United Negro College Fund

encouraged or condemned. Even among those who believe that such uses can be valuable, there will be disagreements as to the speakers, settings, and usages that are permissible. *See generally* Randall Kennedy, *Who Can Say 'Nigger'? And Other Considerations*, 26 J. of Blacks in Higher Educ. 86 (2000).[13]

The case of The Slants illustrates precisely this problem. Even though the band is entirely composed of Asian Americans, and even though few doubt that their intentions are good, some in the Asian-American community have disagreed with their approach and objected to their name. *See* Pet. App. 11a.

This opposition should not be surprising. Nearly every use of a taboo word, no matter how well-meaning, will offend some part of the population. In 1926, Carl Van Vechten chose to title his newest novel—a sympathetic and serious portrayal of black life in Harlem—"Nigger Heaven." As Randall Kennedy describes, "The title alone alienated many blacks, including some who knew the author personally. . . . At an antilynching rally in Harlem, a protester burned a copy of *Nigger Heaven*. And in Boston, the book was banned." Kennedy, *supra*, at 101. The inescapable fact is that no matter the intention or artistic merit, the use of such words will always be met with contro-

---

[13] *See also* South Park, *It Hits the Fan* (first aired June 20, 2001):

Mr. Garrison:	Well, they can't use "fag." Because you can't say "fag" unless you're a homosexual.
Randy:	Really? So we can't say [bleep]?
Mr. Garrison:	No. See, you got beeped.
Man:	You mean you have to be a [bleep] to say [bleep]?
Mr. Garrison:	That's right.

versy. Prominent African-Americans have, in good faith, earnestly objected to the appearance of racial slurs in everything from *Huckleberry Finn* to Merriam-Webster's Dictionary. *Id.* at 105–12.

The serious risk of such outcry shows that even those who believe that their intentions are good cannot be certain that their trademark will be approved. The government's standard of looking to the sentiments of the community at issue will not necessarily save well-meaning or "valuable" uses of difficult words. Instead, it threatens to give veto power to those voices who complain the loudest—a phenomenon that is not necessarily correlated with the actual number of people who truly object to a term.[14] Since the decision to reject a mark will be skewed toward those cases that have attracted the most public attention and outcry *after* the mark has already been chosen, the actual likelihood of being denied registration is even more unpredictable in advance. The result is that artists will be even more incentivized to "play it safe" and choose names that will be unlikely to generate any controversy—exactly the chilling of speech that makes such arbitrary rules so dangerous.

---

[14] *See, e.g.*, South Park, *With Apologies to Jesse Jackson* (Michael Richards, Mark Fuhrman, and the fictional Randy Marsh start a vociferous campaign and successfully lobby Congress to ban the phrase "nigger guy" as a slur against white people who have used the racial epithet. Senator: "From now on, if a person uses the word 'nigger,' it must be at least seven words away from the word 'guy.'"). For a real-life example, *see, e.g.*, Moriah Balingit, *School District Weighs Ban of 'Mockingbird,' 'Huckleberry Finn' after Complaint*, Wash. Post, Dec. 3, 2016, http://wapo.st/2gGFmSJ (describing how school board pulled literary classics pending consideration of permanent ban; also noting an earlier complaint about Toni Morrison's *Beloved*).

For all of these reasons, a "mixed" approach, as proposed by one group of *amici*, would not work. *See* Brief of *Amici Curiae* Asian Americans Advancing Justice | AAJC, et. al., in Support of Neither Party. These a*mici* argue that this Court should leave the disparagement clause largely in place, but strike down its denials of trademarks that are "actually" well-intended. They propose "a more comprehensive and nuanced disparagement analysis that considers both the expressive interest in reclamation and the potential harmful effects of the proposed mark." *Id.* at 3. But the government will never be able to draw such an objective line. Even if it could, the effort would only make the PTO rule *more* blatantly violate the First Amendment, since it would take the viewpoint of a mark's message into account even more.

To avoid such vagueness and unpredictability, the PTO should follow a bright-line rule: make registration decisions based on the merits, not the message.

B. Brands That Do Not Wish to Offend Can Change Their Names Voluntarily

When the government decides that it will be the arbiter of offensiveness, it risks doing exactly what it did here: denying registration to a trademark that has an important contribution to make in expressing identity and breaking down racial stereotypes. So long as it remains in effect, the disparagement clause will continue to swallow up many serious, important, and well-meaning usages of taboo words. Even worse, these harms are the product of a wholly unnecessary governmental mission. The government does not have to step in to defend us against offensive marks, be-

cause the market is best equipped to judge when a brand is truly mean-spirited.[15]

Complaining to the government is not the only way for people truly offended by a title, name, or mascot to influence its creator. In some cases, of course, artists will stick to their guns and keep a title they believe to be important even at the risk of losing sales, as in the case of Carl Van Vechten and *Nigger Heaven*. But in many others, offending their consumers is the last thing market participants want to do. That's why brands have evolved without the need for the government to police their language.

In the 1970s, both Stanford and Dartmouth voluntarily changed their mascots from the "Indians" to the (difficult-to-make-into-a-costume) incorporeal colors "Cardinal" and "Big Green," respectively. Today, dozens of other colleges, motivated by fears of angry donors or triggered students, have replaced similar mascots with equally bland alternatives. *See List of Schools that Changed Native American Nicknames*, USA Today, Sept. 24, 2013, http://usat.ly/2gzt5zl. Whatever one thinks about such changes, they have been accomplished without a bureaucrat's deciding where to draw the line on what's derogatory.

Likewise, brands have voluntarily changed their names when new circumstances suddenly gave formerly innocuous names some entirely new (and unwanted) associations. In 1946, an "appetite suppressing candy" was trademarked with a simple and easy to remember name: Ayds. In the 1970s and early '80s Ayds was part of a popular dieting plan. (Actual slo-

---

[15] *See generally* Christopher M. Fairman, *Fuck: Word Taboo and Protecting Our First Amendment Liberties* (2009).

gans included "With Ayds, I ate less!" and "Why take diet pills when you can enjoy Ayds?") By 1986, the AIDS crisis had given the name and slogan an entirely different meaning, and the candy went through a quick—and completely voluntary—rebranding.[16] *See 11 Brand Names that Simply Couldn't Survive the Times*, Adweek, March 18, 2015 http://bit.ly/1x0jkRb. A similar fate more recently befell both Italo Suisse Chocolates when it decided to rebrand as "Isis Chocolates" in 2013, *id.*, and the likewise poorly timed "Isis Wallet." They soon became "Libeert" and "Softcard," respectively. *See* Don Reisinger, *Isis Wallet Becomes Softcard to Avoid Confusion with Militant Group*, CNET, Sept. 3, 2014, http://cnet.co/2gzkfSf.

Then there is the highly acclaimed post-metal band ISIS, now disbanded, who may have run afoul of the disparagement clause had they started their band in 2016 rather than 1997. If the band were still together today, market forces might push them to consider a name change, just as the band formerly known as Viet Cong, now known as Preoccupations, did in 2016. Jeremy Gordon, *The Band Formerly Known as Viet Cong Announce New Name*, Pitchfork.com, (April 21, 2016), http://bit.ly/1rp03b8. Under the name Viet Cong, they elicited controversy and at least one cancelled show. *Id.* In the press release announcing the name change, the band "apologize[d] to those who were adversely affected by our former band name." "This was never anticipated nor our intent[,]" they wrote, "We are artists and not politicians, we understand that the name reflected pain to

[16] The candy became "Aydslim" in Britain and "Diet Ayds" in the United States, before eventually being phased out.

some individuals and we are happy to change it and move on and focus on our music." *Id.*

History thus shows that if the government steps aside, we will have the best of both worlds: Those brands that wish to make money and fear alienating customers (which is most of them) will police themselves. And those brands and artists that wish to be bolder and make an artistic point that is more controversial, like The Slants, will remain free to do so.

III. THE DISPARAGEMENT CLAUSE VIOLATES THE FIRST AMENDMENT

A. The Disparagement Clause Is a Viewpoint-Based Unconstitutional Condition

"Disparaging" words of the type singled out by the PTO have played a valuable role in personal expression and social debate. But the burden is not on those like Simon Tam to show his expression's value. It suffices to say that any mark which can be interpreted as disparaging is clearly *expression*, and that the government is disadvantaging those who identify themselves with such expression. This fact alone is enough to invalidate the disparagement clause under the unconstitutional-conditions doctrine.

This Court has made it clear that the government "may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech." *Perry v. Sindermann*, 408 U.S. 593, 597 (1972). The disparagement clause does precisely that. As the Federal Circuit correctly noted, "the disparagement provision at issue is viewpoint discriminatory on its face. The PTO rejects marks under § 2(a) when it finds the marks refer to a group in a negative way, but it per-

mits the registration of marks that refer to a group in a positive, non-disparaging manner." Pet. App. 21a.

The government halfheartedly attempts to hedge on whether it is punishing expression by generalizing trademarks as "source identifiers in commerce that are not inherently expressive." Pet. Brief 47. But such a generalization, even if true, is irrelevant to the constitutional issue. Whenever the disparagement clause comes into play, the particular trademark at issue *must* have an expressive content. It is its expressive content—a perceived disparaging sentiment—that leads to the mark being denied registration.[17]

B. A Trademark Is Neither a Subsidy Nor an Endorsement

To rescue the disparagement clause, the government argues that trademark registration is a discretionary "government program." The government claims that the unconstitutional-conditions doctrine does not apply because when it rejects a trademark, it "is not restricting speech, but instead declining to provide government assistance." Pet. Brief 19. Yet each of the cases cited by the government to support

---

[17] In dissent, Judge Reyna offers another strange argument, that marks must not have expressive content because, if they did, trademark law itself would violate the free-speech rights of *nonholders* of a mark. "[I]f the expressive *content* of the mark precludes regulation, on what authority may the government grant Mr. Tam the exclusive right to use this mark in commerce?" Pet. App. 112a–113a (Reyna, J., dissenting). This is like arguing that books must not have any expressive content, because otherwise copyright law would violate the speech rights of those who wish to print someone else's book. Imagine Judge Reyna asking with perplexity "If *Harry Potter and the Deathly Hallows* is expressive speech, on what authority may the government grant J.K. Rowling the exclusive right to print it?"

this proposition dealt with "government programs" that fell into categories much different from the basic protection of trademark registration.

1. Choosing which artists and speakers to fund with limited resources is different than trademark registration.

First, the government cites several cases that specifically concerned *monetary subsidies*. *See* Pet. Brief 15–17 (citing *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540 (1983); *Rust v. Sullivan*, 500 U.S. 173 (1991); *National Endowment for the Arts v. Finley*, 524 U.S. 569 (1998); *United States v. American Library Ass'n*, 539 U.S. 194 (2003)). These cases are of no help to the government. Turning down some requests for money is a necessary "consequence of the nature of arts funding." *Finley*, 524 U.S. at 585. The government does not have unlimited funds and therefore unavoidably must make distinctions among artists and speakers it chooses to subsidize. But such a justification plainly does not apply to the granting of a trademark, since "trademark registration is user-funded, not taxpayer-funded," and "the government spends far more significant funds defending its refusal decisions under the statute." Pet. App. 64a.

2. Spending other people's money on political activity is unlike trademark registration.

Since the subsidy cases are of no help, the government cites two additional cases to claim that the "government assistance" exception is not limited to subsides: *Davenport* v. *Wash. Educ. Ass'n*, 551 U.S. 177 (2007) and *Ysursa* v. *Pocatello Educ. Ass'n*, 555 U.S. 353 (2009). *See* Pet. Brief 41. Yet both *Davenport*

and *Ysursa* also differ from this case in a crucial respect: both concerned "a condition placed upon [a] union's extraordinary *state* entitlement to acquire and spend *other people's* money." *Davenport*, 551 U.S. at 187 (emphasis original). That is, both cases involved a restriction on a union's spending "agency shop" fees taken from union nonmembers (specifically, a ban on spending such money on certain types of political lobbying). *Davenport* and *Ysursa* thus both represent highly unusual situations where First Amendment concerns were implicated on *both* sides of the conflict; the "government benefit" itself "also impinge[d] upon the First Amendment rights of [the union's] nonmembers by forcing them to support the speech of the union." Erik S. Jaffe, *When Easy Cases Make Bad Law*, 2006–2007 Cato Sup. Ct. Rev. 115, 116 (2007).

Further, unlike in *Davenport* and *Ysursa*, the disparagement clause discriminates on the basis of *viewpoint*, not just content. The regulation in *Davenport* was "a reasonable, *viewpoint-neutral* limitation on the State's general authorization allowing public-sector unions to acquire and spend the money of government employees." *Davenport*, 551 U.S. at 189 (emphasis added). The disparagement clause here, by contrast, is clearly not viewpoint-neutral.

3. Trademarks are not endorsements.

The government has one more argument: that even if a federally registered trademark is not a government subsidy, it is a government endorsement. The government argues that registration would be perceived as an endorsement because it "would cause the mark to be published on the Principal Register; would cause a certificate for the mark to be issued 'in the name of the United States' (which may be trans-

mitted to foreign countries); and would entitle respondent to use the ® symbol to convey to the public that the mark has an official status." Pet. Brief 39. To support this "endorsement exception," the government primarily relies on *Walker* v. *Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015).

In *Walker*, some of the present *amici* believed it was hard to characterize every specialty license plate printed by the state of Texas as an endorsement, given that many gave contradictory and opposing messages (for example, the state apparently endorsed *both* the Oklahoma Sooners *and* the Texas Longhorns). While the Court disagreed, here the government's case for an endorsement is notably weaker even than in *Walker*. Perhaps both sides of a fight can be "endorsed" when the government thinks both sides are valiant and honorable. But even with this low bar, the trademarks that the PTO *has* registered almost certainly do not meet it. It is hard to believe that the position of the federal government is that every trademark it has ever registered is to be respected—considering that this includes such hallowed brands as "Capitalism Sucks Donkey Balls" and "Take Yo Panties Off." *See* Pet. App. 43a.

Further, even though some of the *amici* here didn't think that printing a symbol on a license plate looked like much of a government endorsement, this case presents even *fewer* of the potential trappings of endorsement. Authorized trademarks are not proudly displayed on publicly visible moving vehicles next to the seal of the United States; they are noted in the online Trademark Official Gazette and then filed

away in a register where only some (unlucky) lawyers will ever want to go looking for them.[18]

4. The government is incoherent because it admits that it uses resources to protect both registered and unregistered trademarks.

Finally, the government's position—"Holders of unregistered marks can also invoke the Lanham Act's federal cause of action to protect their marks against misappropriation and consumer confusion." Pet. Brief 20.—is incoherent. There is no principled reason why expending the resources and authority of the federal judiciary to protect an *unregistered* trademark constitutes neither a subsidy nor endorsement of that mark, but expending those same resources to protect a *registered* trademark constitutes both. Registration under the Lanham Act indeed provides significantly more benefits than common-law trademark rights (which is why The Slants and others in their position have been significantly harmed), but the government will be entangled with "disparaging" trademarks no matter what, unless it goes so far as to abrogate even the common-law rights of marks it dislikes.

---

[18] The government should be careful if it truly believes that printing a disparaging message on *any* official publication will forevermore be seen as an imprimatur of endorsement for the respectability of the message conveyed—and that this justifies cleansing such publications of all disparaging sentiments. If so, this Court can only hope, for the sake of its own posterity, that the same principle is not eventually extended to another official publication of the federal government that has printed more than a few disparaging sentiments throughout its history: the United States Reports. *See, e.g.*, *Dred Scott v. Sandford*, 60 U.S. 393 (1856); *Bradwell v. Illinois*, 83 U.S. 130 (1872); *Plessy v. Ferguson*, 163 U.S. 537 (1896); *Buck v. Bell*, 274 U.S. 200 (1927).

In the end, there is no justification for departing from the basis for the unconstitutional-conditions doctrine, one that should be decisive here: "[I]f the government could deny a benefit to a person because of his constitutionally protected speech or associations, his exercise of those freedoms would in effect be penalized and inhibited." *Perry*, 408 U.S. at 597.

C. Expanding the "Government Assistance" Exception Risks Swallowing the Rule

An artist can survive losing an NEA grant; such funding does not give the government the means to suppress speech. But in most cases, a creator cannot survive being deprived of *all* potential profits from his work. This has been recognized since the time of the Framers, who tasked the new government with "securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries" to ensure that such expression is created in the first place. U.S. Const. art. I, § 8, cl. 8.

For the same reason, this Court has recognized that the government cannot deny a normal ownership right in one's own written work. *See Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Board*, 502 U.S. 105 (1991). In *Simon & Schuster*, the Court struck down a state law that "require[d] that an accused or convicted criminal's income from works describing his crime be deposited in an escrow account" and distributed to a crime victims' fund. *Id.* at 108. The Court noted the longstanding rule that "[a] statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech." *Id.* at 115 (citing *Leathers v. Medlock*, 499 U.S. 439, 447 (1991)). As the Court held, forbidding authors to prof-

it from books describing their own crimes "plainly imposes a financial disincentive only on speech of a particular content." *Id.* at 116.

The government makes much of the fact that Tam is not banned from uttering the phrase "The Slants" or describing his band by that name. But neither, in *Simon & Schuster*, were authors banned from writing books describing their crimes. By requiring that the profits from such books be forfeited to the state, however, the government removed any financial incentive to author such books.

This Court's precedent in *Simon & Schuster* is largely determinative of this case. Removing normal trademark protections is like removing the ability to own the rights to one's book, or to patent an invention. The purpose of trademark law is "to protect persons engaged in [interstate] commerce against unfair competition." 15 U.S.C. § 1127. If a potential competitor can copy and use a mark, it is more likely that the mark will not be used at all—just as if everyone can copy and sell a book, it is more likely that the book will not be written at all. The disparagement clause thus removes much of the economic incentive a business or artist would have to choose "disparaging" marks as a means of identifying themselves. And such self-identification, especially when it involves a derogatory term often applied to oneself, is undeniably a form of expression unique and separate from simply using the term in some other context.

If trademark protection is simply "government assistance" that can be withheld on the basis of speech content, it is hard to see what basic economic and property protections would *not* qualify as discretionary "government assistance." Indeed, under the gov-

ernment's own proposed rule, any service that Congress or a local legislature is "not obligated to provide"—which is literally the case for *every* service[19]—could be selectively withheld on the basis of speech.

Consider the case of the theft of a valuable early edition of *Mein Kampf*. *See Rare Edition of 'Mein Kampf' Stolen*, UPI, Sept. 22, 1991, http://bit.ly/2g5PCHS. Could the police have declined to provide their discretionary "theft investigation governmental assistance" in such a case, on the basis of a disagreement with the content of the work stolen? ("A museum may choose to display Nazi ideas, but they may not rely on the government to aid them against overzealous souvenir-hunters.")

Or consider this Court's decision in *Nat'l Socialist Party of America v. Village of Skokie*, 432 U.S. 43 (1977). Could the government grant a permit for a public protest but then selectively withhold the "government assistance" of crowd control or traffic diversion on the basis of the protest's message?

If trademark registration may be withheld based on viewpoint, what government protections could not?

D. The Government May Not Discourage Speech to Protect People from Being "Bombarded" with Opposing Views

The government admits that "the essential function of trademarks is to identify goods and services as emanating from a particular commercial source." Pet. Brief 48. It is hard to understand how the disparagement clause furthers a legitimate PTO goal, then,

---

[19] Actual, non-Biden sense of the word "literally." *See, e.g.*, Alexandra Petri, *Literally, Joe Biden*, Wash. Post, Sept. 7, 2012, http://wapo.st/2hpA521.

since "it cannot be contended seriously that scandalous, immoral, and disparaging trademarks fail to promote the well-known purposes underlying trademark law. . . . the protection of the public from deception and the protection of the trademark owner from misappropriation." Baird, *supra*, at 673 & n.40.

Nonetheless, the government argues that it "has a legitimate interest in encouraging the use of non-disparaging marks in interstate commerce, rather than allowing that program to be used to increase the likelihood that 'underrepresented groups in our society' will be 'bombarded with demeaning messages in commercial advertising.'" Pet. Brief 48 (quoting Pet. App. 81a (Dyk, J., concurring in part, dissenting in part)).[20] Such bombardment, it contends, "tends to disrupt commercial activity and to undermine the stability of the marketplace." Pet. Brief 49 (quoting Pet. App. 117a–118a (Reyna, J., dissenting)).

---

[20] This is hard to reconcile with the argument that granting a trademark actually *reduces* overall speech by allowing a trademark holder to prevent others from using a mark. *See* Brief of *Amici Curiae* Law Professors Supporting Petitioners, at 2. ("Rather than facilitating public debate, a trademark registration is a government-issued document that makes it easier for its owner to suppress the speech of others.") By that logic, shouldn't the government *prefer* that only one entity can use each epithet? Instead, now those who object to "Slants" must not only fear being "bombarded" by Tam's band, but face the horrifying prospect of dozens of knock-off Slants tribute bands, able to simultaneously trample on Tam's market share and the dignity of the Asian-American community with impunity. The answer to this conundrum is that trademark law, in fact, should not be used as a cudgel to achieve *any* specific outcome in the public marketplace of ideas; the PTO should simply grant trademarks on their own merits and let the chips fall where they may.

To begin with, this justification is difficult to square with the backwards-looking focus of the disparagement clause. If the clause's goal is to prevent the "disrupting" force of being "bombarded" with disparaging messages in the marketplace, one might assume that the meaning of a term *today* should be the relevant inquiry. Instead, decision makers focus on the meaning of a term when a mark was originally registered, which in some cases can be decades ago. *See, e.g.*, *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 472 (E.D. Va. 2015) (attempting to ascertain whether "redskin" was disparaging in 1967).[21] Such an approach is starkly at odds with the supposedly urgent need to stamp out disparaging messages being transmitted *today*, raising serious doubts as to whether such a goal is really the compelling interest the government claims.

Rather than promoting an offense-free marketplace, the goal of the trademark system is quite simple: for people to know what they're buying. This goal is *aided*, not diminished, by allowing artists and brands to choose (and own) an identity that accurately characterizes their work.

What if The Slants had chosen a less controversial name, as the government apparently wishes they had? Suppose instead of calling themselves "The Slants," the band played it safe and called themselves "Four Asian-American Men Who Are Very Respectful of Our Diversity as a Nation." Someone attending a show by such a band might well find it *more* "destabilizing" to only then discover that the band's songs contain lyrics referencing the schoolyard taunt "Chi-

---

[21] Couldn't the Redskins controversy be obviated by keeping the name but replacing the logo with a smiling potato head?

nese, Japanese, dirty knees, look at these." Resp. Cert. Brief 4.

In other words, brand names are how artists can encapsulate their tone and their ethos as succinctly as possible. People who showed up to watch a (now defunct) band called Anal Cunt knew they were probably not getting a cover of "Careless Whisper." People who show up to watch The Slants know they're getting a take on Asian-American identity that's irreverent and sometimes politically incorrect. Rather than "destabilizing" the market, their brand gives consumers information and prevents confusion, which are exactly the goals of the federal trademark system.[22]

Finally, even if the use of such marks does cause hurt and offense to some, punishing speech to prevent such offense is simply not permissible under the First Amendment. Suppose that instead of punishing trademarks, the government had made exactly the same arguments in favor of punishing certain public picketers who express disparaging statements (but not those who express positive statements). Such a punishment would obviously be unacceptable. "[T]he Constitution does not permit the government to decide which types of otherwise protected speech are sufficiently offensive to require protection for the unwilling listener or viewer. Rather, the burden normally falls upon the viewer to avoid further bombard-

---

[22] Perhaps what the government truly finds "destabilizing" is not the existence of trademarks like "The Slants," but the actual product and message on offer in their performances themselves. Of course, the government could not admit this as a goal of banning disparaging marks and economically harming those artists who would be inclined to use them; even the government knows that discouraging "disparaging" songs and artwork could never pass First Amendment scrutiny, right?

ment of his sensibilities simply by averting his eyes." *Snyder v. Phelps*, 562 U.S. 443, 459 (2011) (quoting *Erznoznik v. Jacksonville*, 422 U.S. 205, 210–211 (1975) (alterations omitted)). This principle is no less true whether the expression appears on a placard, billboard, or flyer promoting a performance. The First Amendment does not allow the government to punish disfavored messages so others will not see them.

CONCLUSION

Amici, and all others who sometimes find themselves lumped into a basket of deplorables—now that's a great band name!—urge the Court to let people judge for themselves what's derogatory.

Respectfully submitted,

ILYA SHAPIRO
Counsel of Record
THOMAS A. BERRY
Cato Institute
1000 Mass. Ave., N.W.
Washington, D.C. 20001
(202) 842-0200
ishapiro@cato.org
tberry@cato.org

December 16, 2016

APPENDIX: DESCRIPTION OF *AMICI*

The **Cato Institute** is a non-partisan public policy research foundation that was established in 1977 to advance the principles of individual liberty, free markets, and limited government. Cato's Center for Constitutional Studies was founded in 1989 to restore the principles of constitutional government that are the foundation of liberty. Toward those ends, Cato holds conferences and publishes books, studies, and the annual *Cato Supreme Court Review*.

P.J. O'Rourke is one of America's leading political satirists, an H.L. Mencken Research Fellow at the Cato Institute, and an equal-opportunity offender. Formerly the editor of the *National Lampoon*, he has written for such offensive publications as *Car and Driver*, *Playboy*, *Esquire*, *Vanity Fair*, *House & Garden*, *The New Republic*, *The New York Times Book Review*, *Parade*, *Harper's*, and *Rolling Stone*. He is a contributing editor at *The Weekly Standard* and a member of the editorial board of *World Affairs*. O'Rourke's books have been translated into a dozen languages and three have been *New York Times* best-sellers: *Parliament of Whores*, *Give War a Chance*, and *All the Trouble in the World*. He is also the author of the forthcoming *How the Hell Did This Happen?: The Election of 2016*—in which he disparages both the ruling class and unwashed masses, yet still hopes to enforce his intellectual-property rights.

Nadine Strossen holds the John Marshall Harlan II Chair at New York Law School, was president of the American Civil Liberties Union from 1991 through 2008, and continues to serve on the ACLU's National Advisory Council. She also holds leadership positions in other organizations that focus on free

speech issues, including the Foundation for Individual Rights in Education. Strossen's extensive writings that defend freedom for offensive expression include her book, *Defending Pornography: Free Speech, Sex, and the Fight for Women's Rights* (Scribner 1995) and her co-authored book, *Speaking of Race, Speaking of Sex: Hate Speech, Civil Rights, and Civil Liberties* (NYU Press 1994). Her ideas on this and other topics have many times been deemed sufficiently offensive to trigger boycotts, dis-invitations, and picketing, as well as death threats.

Erik Nielson is an associate professor of liberal arts at the University of Richmond. He has published widely on African-American music and poetry, with a particular emphasis on rap. He is co-editor of *The Hip Hop & Obama Reader* (2015) and co-author of *Rap on Trial* (forthcoming). He writes regularly on race, politics, and popular culture for national media outlets such as the *New York Times*, *Washington Post*, *Atlantic*, and *Rolling Stone*. He has served as an expert witness or consultant in dozens of criminal cases involving rap music as evidence, and he was the lead author of two *amicus* briefs before the Supreme Court on the history and conventions of rap (*Elonis v. United States* and *Bell v. Itawamba County School Board*). His work often requires him to explain why rhetoric that sounds "derogatory" actually isn't—or why rhetoric that sounds benign is actually quite nasty. It's all very complicated, and probably not something the PTO is going to clear up anytime soon.

Clay Calvert is the Brechner Eminent Scholar in Mass Communication at the University of Florida. He also directs the Marion B. Brechner First Amendment Project, in which capacity he has filed many

Supreme Court *amicus* briefs, in cases such as *Elonis v. United States* and *Brown v. Entertainment Merchants Association*. His scholarship focuses on freedom of expression, and he has published multiple journal articles regarding offensive speech—including ones featuring interviews with *Hustler* publisher Larry Flynt and several porn stars. Because "Clay" is a four-letter word, he found himself fixated at an early age by the offensive and profane. Furthermore, because he was born without a middle name—his parents reportedly were too poor to afford one—he has always been slightly bitter and, in turn, prone to engage in offensive expression himself. Finally, Calvert's highest academic honor is itself somewhat offensive to the puritanical and prudish: a former student at the University of Florida who took his undergraduate media-law class later adopted his last name for her stage name in the adult-movie industry, where she performs today as Casey Calvert.

Ralph Steadman, born in Liverpool in 1936, discovered his love of drawing as a child, when he recalls visiting the home of a friend whose "mother allowed him to express himself all over the walls . . . scribble, scribble, scribble." Steadman's award-winning output over the last 50-plus years has been expressed in many forms: drawings, paintings, cartoons, collage, photography, sculptures, sets, and costume designs. Steadman began collaborating with Hunter S. Thompson in 1970 when Warren Hinckle III, cofounder of *Scanlan's Monthly*, identified Steadman as the perfect artist to illustrate Thompson's article on the Kentucky Derby. Thompson had suggested that what they needed was "somebody with a really peculiar sense of humor, because this is going to be a very twisted story. It'll require somebody with a serious

kink in his brain." The article was hailed by the *Boston Globe* as "pure GONZO." In 2012, Johnny Depp narrated For No Good Reason, a documentary of Steadman's life and work. For Steadman, the freedom of speech and expression "are as fundamental to our being as the alphabet itself." He lives with his wife Anna in a castle in Kent, England.

Flying Dog Brewery is a craft brewery located in Frederick, Maryland. Founded in 1990, it is the largest brewery in Maryland and, as of 2015, the 37th largest in the country. Flying Dog is known for its connection to "gonzo journalism" through close ties to Hunter S. Thompson and Ralph Steadman. Flying Dog's beer names and artwork have often been interpreted as vulgar and insinuating, which has led to controversies with government agencies. In 1995, while drawing the first "Road Dog" label, Steadman splashed "Good Beer, No Shit" across the back. (This was an indirect reference to an ancient Celtic axiom that Thompson included in his short essay memorializing the release of Flying Dog's first beer with Steadman's artwork.) The Colorado Liquor Board removed the bottles from shelves, citing "obscenity," but allowed them back five years later. In 2007, Arkansas wouldn't allow the sale of "In Heat Wheat" because of both the name and label image. In 2009, Michigan denied Flying Dog the licensing right to sell its 20th Anniversary beer, "Raging Bitch" (a Belgian-style IPA, now its best seller), finding that the label was "detrimental to public health, safety and welfare." After losing before the Sixth Circuit on the issue of qualified and quasi-judicial immunity, *Flying Dog Brewery, LLLP v. Mich. Liquor Control Comm'n*, 597 Fed. Appx. 342 (6th Cir. 2015), the state commission relented. With the damages awarded from that

case, Flying Dog established the 1st Amendment Society, which advocates and educates on the First Amendment and organizes events that promote the arts, journalism, and civil liberties.

The **Comic Book Legal Defense Fund** is a nonprofit organization dedicated to the protection of the First Amendment rights of the comics art form and education that creates awareness about those rights. With a membership that includes comic book retailers, creators, publishers, educators, librarians, and readers, the CBLDF has defended dozens of First Amendment cases in courts across the United States, and led important education initiatives promoting comics literacy and free expression.

Thomas Jefferson warned that "[t]he natural progress of things is for liberty to yield, and government to gain ground." Letter from Thomas Jefferson to Edward Carrington (May 27, 1788). Mindful of this trend, the **DKT Liberty Project** was founded in 1997 to promote individual liberty against encroachment by all levels of government. This not-for-profit organization advocates vigilance over regulation of all kinds, particularly that which constrains First Amendment rights.

Reason Foundation is a nonpartisan and nonprofit public policy think tank, founded in 1978. Its mission is to promote free markets, individual liberty, equality of rights, and the rule of law. Reason advances its mission by publishing *Reason* magazine, as well as commentary on its websites, www.reason.com, www.reason.org, and www.reason.tv. To further its commitment to "Free Minds and Free Markets," Reason participates as *amicus curiae* in cases raising significant legal and constitutional issues.

RECORDS AND BRIEFS

Supreme Court, U.S.
FILED
NOV 21 2016
OFFICE OF THE CLERK

No. 15-1293

IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF CERTAIN MEMBERS OF CONGRESS AS AMICI CURIAE IN SUPPORT OF NEITHER PARTY

JOHN T. JOHNSON
FISH & RICHARDSON P.C.
601 Lexington Avenue
52nd Floor
New York, NY 10022
(212) 765-5070
jjohnson@fr.com

JOHN DRAGSETH
Counsel of Record
FISH & RICHARDSON P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, MN 55402
(612) 335-5070
dragseth@fr.com

Counsel for Amici

Library of Congress

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES ii
INTEREST OF THE AMICI CURIAE 1
SUMMARY OF THE ARGUMENT 3
ARGUMENT 4
I. Disparaging Trademarks Encourage Discriminatory Behavior 4
II. Trademark Law Is for Trade Identification—Not a Forum for Exchanging Ideas 9
III. Offensive Trademarks Are Inherently Inefficient Source-Identifiers 12
CONCLUSION 13

TABLE OF AUTHORITIES

Page(s)

Cases

Abercrombie & Fitch Co. v. Hunting World, Inc.,
537 F.2d 4 (2d Cir.1976) 13

Boy Scouts of Am. v. Dale,
530 U.S. 640 (2000) 7

Cardtoons, L.C. v. Major League Baseball Players Ass'n,
95 F.3d 959 (10th Cir. 1996) 12

Elvis Presley Enters., Inc. v. Capece,
141 F.3d 188 (5th Cir. 1998) 5

Hazelwood Sch. Dist. v. Kuhlmeier,
484 U.S. 260 (1988) 11

Heart of Atlanta Motel, Inc. v. United States,
379 U.S. 241 (1964) 7

In re Standard Oil Co.,
275 F.2d 945 (C.C.P.A. 1960) 10

In re Tam,
808 F.3d 1321 (Fed. Cir. 2015) (en banc) 6, 14

Int'l Soc'y for Krishna Consciousness, Inc. v. Lee,
505 U.S. 672 (1992) 10

Katzenbach v. McClung,
379 U.S. 294 (1964) 7

Mishawaka Rubber & Woolen Co. v. S.S. Kresge Co.,
316 U.S. 203 (1942) 5

Rogers v. Grimaldi,
875 F.2d 994 (9th Cir. 1989) 12

Two Pesos, Inc. v. Taco Cabana, Inc.,
505 U.S. 763 (1992) 13

United States v. Kokinda,
497 U.S. 720 (1990) 10

Walker v. Tex. Div., Sons of Confederate Veterans, Inc.,
135 S. Ct. 2239 (2015) 11

Statutes

15 U.S.C. § 1127 10

15 U.S.C. § 1051(a)(3)(C) 10

17 U.S.C. § 102 10

Civil Rights Act of 1964,
Pub. L. No. 88-352, 78 Stat. 241 7

Pregnancy Discrimination Act of 1978,
Pub. L. No. 95-555, 92 Stat. 2076 7

Americans with Disabilities Act of 1990,
Pub. L. No. 101-336, 104 Stat. 327 7

Family and Medical Leave Act of 1993, Pub. L. No. 103-3, 107 Stat. 6 7

Alan Brownstein, *The Nonforum as a First Amendment Category: Bringing Order Out of the Chaos of Free Speech Cases Involving School-Sponsored Activities*, 42 U.C. Davis L. Rev. 717 (2009) 10

Christine Haight Farley, *Registering Offense: The Prohibition of Slurs as Trademarks*, *in* Diversity in Intellectual Property: Identities, Interests, and Intersections (Irene Calboli & Srividhya Ragavan eds., 2015) 6

Michael Grynberg, *A Trademark Defense of the Disparagement Bar*, 126 Yale L.J. F. 178 (2016) 13

INTEREST OF THE AMICI CURIAE[1]

Amici are certain Members of the U.S. House of Representatives and one Member of the U.S. Senate, as identified below.

U.S. House of Representatives:

- Rep. Hakeem Jeffries (NY-08)
- Rep. Karen Bass (CA-37)
- Rep. Joyce Beatty (OH-03)
- Rep. G.K. Butterfield (NC-01)
- Rep. Judy Chu (CA-27)
- Rep. David Cicilline (RI-01)
- Rep. Yvette Clarke (NY-09)
- Rep. Theodore Deutch (FL-21)
- Rep. Tulsi Gabbard (HI-02)
- Rep. Colleen Hanabusa (HI-01)
- Rep. Michael Honda (CA-17)
- Rep. Sheila Jackson Lee (TX-18)
- Rep. Henry C. "Hank" Johnson Jr. (GA-04)
- Rep. Barbara Lee (CA-13)
- Rep. John Lewis (GA-05)
- Rep. Ted Lieu (CA-33)
- Rep. Grace Meng (NY-06)

---

[1] Letters consenting to the filing of this brief are on file with the Clerk. No counsel for a party authored this brief in whole or in part, and no person, other than amici or their counsel, made any monetary contribution to the preparation or submission of this brief.

- Rep. Gwen Moore (WI-04)
- Del. Eleanor Holmes Norton (DC-at large)
- Rep. Scott Peters (CA-52)
- Rep. Cedric Richmond (LA-02)
- Rep. Terri Sewell (AL-07)
- Rep. Mark Takano (CA-41)
- Rep. Frederica S. Wilson (FL-24)
- Rep. Doris Matsui (CA-06)

U.S. Senate:

- Sen. Mazie K. Hirono (HI)

Amici represent diverse communities in the United States Congress and file this brief on behalf of themselves and their constituents, who would be negatively impacted if the government was required to sanction disparaging trademarks.

Amici believe that Section 2(a) is Constitutional because it does not interfere with free expression even as it refuses federal-trademark protection to a great variety of racist, sexist, and homophobic words. As Members of Congress, we have a strong interest in seeing that the government protects legitimate First Amendment rights while ensuring the efficient flow of commerce that underpins trademark law. We also have a strong interest because of the odious and lasting discriminatory impact that disparaging and hateful terms have on American society and in particularly on communities of color.

Amici do not support either party even though we argue for the Constitutionality of Section 2(a) because Amici are neutral regarding the ultimate outcome of

the case, and whether the USPTO properly or improperly denied registration.[2]

SUMMARY OF THE ARGUMENT

This case is about whether the government must put its stamp of approval on particular types of words—it is not about restricting speech. Disparaging, racist, sexist, and homophobic words do little to forward any goals of the First Amendment, and do even less as identifiers of source. Rather, they distract from the goals of both First Amendment law and trademark law—they create resistance in consumers without communicating helpful information about products or services. While the First Amendment properly protects all viewpoints that are expressed in a forum for speech, trademark registration is not a forum for the free exchange of ideas: it is, instead, government approval of source-identifying marks for commercial goods and services. And the presence or absence of a circle-R symbol or legal procedural rights does not allow a successful applicant to use the mark in expressing himself, or to prevent an unsuccessful applicant from expressing himself. Accordingly, consistent with the First Amendment, Congress may limit trademark registration to marks that are efficient source-identifiers. Disparaging marks are not: they distract consumers and improperly arouse passions without designating source in a meaningful manner. Section 2(a) of the Lanham Act is constitutional.

---

[2] In accordance with Supreme Court Rule 37.3, this brief is submitted within 7 days after the time allowed for filing the petitioner's brief because this amicus brief is in support of neither party.

ARGUMENT

I. Disparaging Trademarks Encourage Discriminatory Behavior

Language is powerful. It shapes our attitudes and informs our actions. Racist, sexist, misogynist, and homophobic slurs in everyday commerce send the message that discriminatory behavior is acceptable. *See Mishawaka Rubber & Woolen Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942) ("The protection of trademarks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them.").[3] Hate is the natural creator of disparagement, and its natural result is the unnatural treatment of disparaged people.

We know personally the acidic effects of disparaging terms from our own lives, from the experiences that drove us to serve, and from the stories we hear from our constituents who battle disparagement and discrimination daily. Disparaging terms used with goods and services communicate to consumers prejudicial messages that negatively impact buying decisions. Rather than cementing in the mind of a listener a connection to a source of goods or services (as a trademark is supposed to do), racial epithets and other disparaging terms enflame hateful passions: "Whether a restaurant named, 'SPICS NOT WELCOME' would actually serve a Hispanic patron is

---

[3] We recognize that Mr. Tam is an Asian- American whose goals in obtaining the mark here appear honorable. But we also recognize that trademark law cares about the impression that the mark's use may leave on the public, and not the applicant's identity or intent. *Cf. Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 203 (5th Cir. 1998).

hardly the point. The mere use of the demeaning mark in commerce communicates a discriminatory intent as harmful as the fruit produced by the discriminatory conduct." *In re Tam*, 808 F.3d 1321, 1380 (Fed. Cir. 2015) (en banc) (Reyna, J., dissenting). The clarity that trademark law seeks to provide consumers becomes lost in the dissonance of the term's hate.

Moreover, because a trademark affords its owner the right to sue and seek damages, the presence of a disparaging mark imposes a chilling effect on the public. Trademark rights extend beyond repetition of the exact mark (that is, to any use that might cause a likelihood of confusion). The presence of that disparaging mark therefore imposes a particularly broad chilling effect on the very segment of the public that needs all the tools it can muster to respond to the hate that disparaging marks contain.

Disparaging trademarks also signal to the public that hateful conduct is acceptable—not merely against the targeted group of the trademark, but against other groups too. "The public acceptance of hateful language against one group suggests tolerance of other hateful language and treatment toward others groups." Christine Haight Farley, *Registering Offense: The Prohibition of Slurs as Trademarks*, *in* Diversity in Intellectual Property: Identities, Interests, and Intersections 105-29 (Irene Calboli & Srividhya Ragavan eds., 2015). While we may need to put up with and counter such terms in day-to-day debate, there is no need, and certainly no requirement, that the government place its seal of approval on them in the form of the circle-R.

And discriminatory conduct negatively disrupts commerce. Commerce works best when it is not

blocked by illogical hate and prejudice. Hateful, disparaging marks help create an economic embargo against the targeted group who cannot engage in the free market on equal terms. *See Katzenbach v. McClung*, 379 U.S. 294, 299 (1964) (commenting on "the burdens placed on interstate commerce by racial discriminations"); *see also Heart of Atlanta Motel, Inc. v. United States*, 379 U.S. 241, 252 (1964) (commenting on the "burdens that discrimination by race or color places upon interstate commerce"). Congress has properly and repeatedly fought discrimination in interstate commerce with tough antidiscrimination laws. *See, e.g.*, Civil Rights Act of 1964, Pub. L. No. 88-352, 78 Stat. 241; Pregnancy Discrimination Act of 1978, Pub. L. No. 95-555, 92 Stat. 2076; Americans with Disabilities Act of 1990, Pub. L. No. 101-336, 104 Stat. 327; Family and Medical Leave Act of 1993, Pub. L. No. 103-3, 107 Stat. 6.

The First Amendment should not be turned "into a free pass out of antidiscrimination laws." *Boy Scouts of Am. v. Dale*, 530 U.S. 640, 688 (2000) (Stevens, J., dissenting). If the Court facially strikes down Section 2(a), the USPTO will be powerless to prevent entities from registering offensive marks—indeed highly offensive ones.

For example, the USPTO has used Section 2(a) to refuse registration to the following marks:

- SOUTHERN WHITE KNIGHTS TO THE KU KLUX KLAN[4]
- PUSSY NIGGA BE COOL (P. N. B. C.)[5]
- S.N.I.T.C.H= SUCKA NIGGA INFORMING THE COPS HATING[6]
- BABY JAP[7]
- BFF BIG FUCKING FAGGOT[8]
- CUNT[9]
- FUDGEPACKERS[10]

---

[4] U.S. Trademark App. No. 78/478,272 (filed Sept. 2, 2004).

[5] U.S. Trademark App. No. 85/952,753 (filed June 6, 2013).

[6] U.S. Trademark App. No. 85/379,668 (filed July 25, 2011).

[7] U.S. Trademark App. No. 78/665,332 (filed July 7, 2005).

[8] U.S. Trademark App. No. 77/722,463 (filed Apr. 25, 2009).

[9] U.S. Trademark App. No. 77/048,672 (filed Nov. 21, 2006)

[10] U.S. Trademark App. No. 78/681,877 (filed July 29, 2005)

The USPTO has also used Section 2(a) to refuse registration of the design mark "HADJI, PLEASE!" for firearm targets:[11]

If the Court holds Section 2(a) facially unconstitutional, entities may register these kinds of disparaging marks—and place next to the marks the circle-R that indicates government endorsement to the public. Free speech is not forwarded by the commodification of racist, sexist, homophobic words and marks.

Re-appropriation of the term here is certainly a laudable goal, but that goal will be harmed, not helped, by trademark registration. To change the way that the public understands a term takes time and broad-based work. That is best achieved if the public has full access to the term: to debate about it, to use it, and to condemn any improper and hateful use of it. And until the public properly understands the term as non-disparaging, it is best left open for public use rather than being subjected to limitation via registration. *Cf.* DYKES ON BIKES, Registration No.

[11] U.S. Trademark App. No. 77/424,420 (filed Mar. 18, 2008).

3,323,803 (allowing registration after applicant provided evidence that the term had been re-appropriated as a term of endearment and empowerment).

In short, disparaging terms are best left open for the public. They should not be reserved to a single private party, even if narrowed to a single good or service. The government's favorable association with such terms causes great harm, while doing little to enhance free expression.

II. Trademark Law Is for Trade Identification—Not a Forum for Exchanging Ideas

Congress defines a "trademark" as something "to identify and distinguish [an applicant's] goods." 15 U.S.C. § 1127. Trademark rights require both use of the mark in commercial activity and ability to indicate source to the public. *Id.* § 1051(a)(3)(C). Trademarks are not works of "original expression"—that is copyright. *Compare id.* § 1127, *with* 17 U.S.C. § 102. Any expressive function of a trademark is incidental: "[t]he Trademark Act is not an act to register words but to register trademarks." *In re Standard Oil Co.*, 275 F.2d 945, 947 (C.C.P.A. 1960).

Trademark registration is not a soapbox, a pulpit, a bullhorn, or a microphone. It is not a street, park, or sidewalk. *See United States v. Kokinda*, 497 U.S. 720 (1990). In this Court's vernacular, trademark registration is not a "forum." *See Int'l Soc'y for Krishna Consciousness, Inc. v. Lee*, 505 U.S. 672 (1992); Alan Brownstein, *The Nonforum as a First Amendment Category: Bringing Order Out of the Chaos of Free Speech Cases Involving School-Sponsored Activities*, 42 U.C. Davis L. Rev. 717, 784 (2009). Rather, the relevant "forum" here is any location in which com-

mercial speech may occur. But the term for which registration is sought can be used freely in that forum—indeed, Tam and his bandmates appear to be using SLANTS fully and freely. The refusal of registration itself does not constitute restriction of speech in a forum, and its practical result does not prevent such speech in any way. It simply means that the speech may not have a circle-R next to it, and that the speaker may not obtain extra litigation-related benefits that are unavailable to other speakers in the forum.

Moreover, a term when presented as a registered trademark bears the government's imprimatur: the circle-R. Government-stamped racist, sexist, and homophobic trademarks tell the public: "We approve." But the First Amendment permits the government to withhold its approval. A public-school newspaper may censor its students' articles on pregnancy and divorce. *Hazelwood Sch. Dist. v. Kuhlmeier*, 484 U.S. 260, 271 (1988) (permitting censorship of "expressive activities" that "the public might reasonably perceive to bear the imprimatur of the school"). So too then may Congress refuse to confer its circle-R on disparaging marks.

Further still, registered trademarks involve government speech and thus are within the government's discretion. This Court held in *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015), that a vehicle's license plate with a personally chosen background or design was government speech, *id.* at 2248. So too are registered trademarks. Like license plates, the USPTO "maintains direct control over the messages conveyed" with registered trademarks. *Id.* at 2249. Every registered trademark is issued by the USPTO, just as "every Texas license

plate is issued by the State." *Id.* at 2248. And registered trademarks serve the governmental purpose of source identification, just like "[e]ach Texas license plate . . . serv[es] the governmental purposes of vehicle registration and identification." *Id.*

Most importantly, the Court in *Walker* noted that "a person who displays a message on a Texas license plate likely intends to convey to the public that the State has endorsed that message. . . . [T]he individual prefers a license plate design to the purely private speech expressed through bumper stickers . . . because Texas's license plate designs convey government agreement with the message displayed." *Id.* at 2249. And so when a trademark applicant asks the government for its circle-R, any registered mark necessarily becomes government speech.

Tam's invocation of the First Amendment in this case is ironic. The First Amendment, in fact, has traditionally and properly been used to *narrow* trademark-holders' rights—not enlarge them. That is because the Court has recognized that assertion of registered marks *lessens* the ability of the general public to speak. For instance, artists have used the First Amendment as a defense when they have incorporated trademarks into their artistic work. *See, e.g.*, *Rogers v. Grimaldi*, 875 F.2d 994, 998 (9th Cir. 1989) ("[O]verextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values."). And the First Amendment protects unauthorized use of registered trademarks for parody. *E.g.*, *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996). The irony of this case only buttresses the point that trademarks are not subject to First Amendment protection.

Moreover, the First Amendment issue here is not a one-way street in an applicant's direction, but instead involves competing considerations by which protection of the general public's right to speak is paramount.

III. Offensive Trademarks Are Inherently Inefficient Source-Identifiers

Ineffective source-identifiers cannot be trademarked. Most notably, Congress has carved out "generic" and "merely descriptive" terms from trademark protection because they are bad source-identifiers. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768-74 (1992) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976)). The word 'PAPER' cannot be a valid trademark for paper; consumers would have no idea where PAPER-brand paper comes from.

Disparaging marks too are poor trademarks, but for a very different reason: they distract consumers. Disparaging marks are so infused with non-source meaning that they cannot perform their source-identifying function. Michael Grynberg, *A Trademark Defense of the Disparagement Bar*, 126 Yale L.J. F. 178, 187-88 (2016) ("Slurs leave less room for trademark meanings than do the comparative neutral terms that trademark law traditionally favors."). A disparaging term immediately shifts consumers' focus away from the product and to the odious sentiment of the offensive term. No longer is a consumer contemplating which product to buy; rather, her response to seeing the disparaging term is personal, political, and emotional—not commercial.

The marketplace is best served by transactions that are based on rational decision-making and not on

racial slurs, disparaging comments, and insults. "Commerce does not benefit from political volatility, nor from insults, discrimination or bigotry." *Tam*, 808 F.3d at 1380.

CONCLUSION

For the reasons above, the Court should hold that Section 2(a) is not facially unconstitutional.

Respectfully submitted,

JOHN T. JOHNSON
FISH & RICHARDSON P.C.
601 Lexington Avenue
52nd Floor
New York, NY 10022
(212) 765-5070
jjohnson@fr.com

JOHN A. DRAGSETH
Counsel of Record
FISH & RICHARDSON P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, MN 55402
(612) 335-5070
dragseth@fr.com

November 21, 2016

RECORD AND BRIEFS

Supreme Court, U.S.
FILED
DEC 16 2016
OFFICE OF THE CLERK

No. 15-1293

IN THE

Supreme Court of the United States

MICHELLE K. LEE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF OF *AMICUS CURIAE* THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA IN SUPPORT OF RESPONDENT

LILY FU CLAFFEE
KATE COMERFORD TODD
WARREN POSTMAN
U.S. CHAMBER LITIGATION CENTER
1615 H Street, N.W.
Washington, D.C. 20062
(202) 463-5337

EUGENE SCALIA
Counsel of Record
AMIR C. TAYRANI
MICHAEL R. HUSTON
GIBSON, DUNN & CRUTCHER LLP
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036
(202) 955-8500
escalia@gibsondunn.com

Counsel for Amicus Curiae

Library of Congress

TABLE OF CONTENTS

Page

INTEREST OF *AMICUS CURIAE* 1

SUMMARY OF ARGUMENT 2

ARGUMENT 4

I. SECTION 2(a)'S ANTI-DISPARAGEMENT PROVISION IS A VIEWPOINT-BASED RESTRICTION ON EXPRESSION 4

II. SECTION 2(a)'S ANTI-DISPARAGEMENT PROVISION IS NOT A PERMISSIBLE REGULATION OF "COMMERCIAL SPEECH" 6

A. "Commercial Speech" Is A Narrow Category Limited To Speech Proposing A Commercial Transaction 7

B. The Government May Not Engage In Viewpoint Discrimination Simply Because The Speaker Has An Economic Interest In A Message 9

C. Even If Trademarks Are Commercial Speech, Section 2(a)'s Anti-Disparagement Provision Is Still Subject To Heightened Judicial Scrutiny 16

III. SECTION 2(a)'S ANTI-DISPARAGEMENT PROVISION IS UNCONSTITUTIONAL UNDER ANY STANDARD OF SCRUTINY 17

A. The Trademark Registration Program Is Not A Government Subsidy 18

B. Registration Is Critically Important To Trademark Holders 20

CONCLUSION 25

TABLE OF AUTHORITIES

Page(s)

Cases

Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc., 133 S. Ct. 2321 (2013) 19

Ashcroft v. Am. Civil Liberties Union, 535 U.S. 564 (2002) 5

B & B Hardware, Inc. v. Hargis Indus., Inc., 135 S. Ct. 1293 (2015) 12, 14, 19

Bd. of Trs. of State Univ. of N.Y. v. Fox, 492 U.S. 469 (1989) 15

Bigelow v. Virginia, 421 U.S. 809 (1975) 14

Brown v. Entm't Merch. Ass'n, 564 U.S. 786 (2011) 4

Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y., 447 U.S. 557 (1980) 4, 5, 7, 11, 13, 16

City of Cincinnati v. Discovery Network, Inc., 507 U.S. 410 (1993) 13

Cox v. Louisiana, 379 U.S. 536 (1965) 22

Edwards v. South Carolina, 372 U.S. 229 (1963) 22

Friedman v. Rogers, 440 U.S. 1 (1979) 14, 15

Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp. of Boston, 515 U.S. 557 (1995) 5

N.Y. Times Co. v. Sullivan,
376 U.S. 254 (1964) 14

Nat'l Endowment for the Arts v. Finley,
524 U.S. 569 (1998) 6, 18

Near v. Minnesota,
283 U.S. 697 (1931) 8

Ohralik v. Ohio State Bar Ass'n,
436 U.S. 447 (1978) 7

Pac. Gas & Elec. Co. v. Pub. Utils. Comm'n of Cal., 475 U.S. 1 (1986) 5

Regan v. Taxation Without Representation of Wash., 461 U.S. 540 (1983) 18

Rust v. Sullivan,
500 U.S. 173 (1991) 18

San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.,
483 U.S. 522 (1987) 7, 14, 15

Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.,
502 U.S. 105 (1991) 21

Snyder v. Phelps,
562 U.S. 443 (2011) 8

Sorrell v. IMS Health Inc.,
564 U.S. 552 (2011) 2, 3, 5, 6, 9, 13, 15, 17, 18, 21

United States v. Am. Library Ass'n,
539 U.S. 194 (2003) 19

United States v. Playboy Entm't Grp., Inc.,
529 U.S. 803 (2000) 5, 21

Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc., 425 U.S. 748 (1976) 3, 7

Walker v. Texas Div., Sons of Confederate Veterans, Inc., 135 S. Ct. 2239 (2015) 22

Ward v. Rock Against Racism, 491 U.S. 781 (1989) 5, 17

Statutes

15 U.S.C. § 1052(a) 2

Other Authorities

American flag banned by Calif. university students to create 'inclusive' atmosphere, The Washington Times (Mar. 7, 2015) 24

Google Co., *Our history in depth* 11

PepsiCo, *The Pepsi-Cola Story* 10

Someone wrote 'Trump 2016' on Emory's campus in chalk. Some students said they no longer feel safe, The Washington Post (Mar. 24, 2016) 24

BRIEF OF *AMICUS CURIAE* THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA IN SUPPORT OF RESPONDENT

INTEREST OF *AMICUS CURIAE*[1]

The Chamber of Commerce of the United States of America (the "Chamber") is the world's largest business federation. It represents 300,000 direct members and indirectly represents the interests of more than 3 million companies and professional organizations of every size, in every industry sector, and from every region of the country. An important function of the Chamber is to represent the interests of its members in matters before Congress, the Executive Branch, and the courts. To that end, the Chamber regularly files *amicus curiae* briefs in cases that raise issues of concern to the nation's business community.

The Chamber is participating in this case because it is deeply concerned about the potential diminution of First Amendment rights that could result if the Court were to condone viewpoint-based regulation of speech when the speaker is engaged in commercial activity. Although this Court has held that some regulations of "commercial speech" are subject to intermediate rather than strict First Amendment scrutiny, it has also made clear that the category of "commercial speech" is narrow. And the Court has never applied

---

[1] Pursuant to this Court's Rule 37.6, *amicus curiae* states that no counsel for any party authored this brief in whole or in part, and no entity or person, aside from *amicus curiae*, its members, and its counsel, made any monetary contribution toward the brief's preparation or submission. All parties have consented in writing to the filing of this brief.

intermediate scrutiny to allow the Government to restrict speech because it finds the viewpoint expressed to be offensive.

The Chamber seeks to underscore that the Government violates the First Amendment whenever it withholds important legal protections based on the viewpoint expressed by a speaker. Denial of federal trademark registration, and the attendant loss of procedural protections against infringement, confusion, and usurpation, seriously impairs the right of a trademark holder to use that mark as a means of conveying its message. This viewpoint-based burden on speech directly implicates the core protections of the First Amendment and cannot survive any level of constitutional scrutiny.

SUMMARY OF ARGUMENT

This Court has long condemned viewpoint-based regulation of speech, whether the setting is political, cultural, or commercial. *See Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011). The anti-disparagement provision of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), violates this longstanding prohibition on viewpoint-based regulation and burdens the fundamental freedom of expression that rests at the heart of the First Amendment.

Section (2)(a)'s anti-disparagement provision should be subject to strict scrutiny because it regulates trademarks that involve more than commercial communications and that therefore cannot be treated simply as "commercial speech." As the record in this case makes clear, trademark holders use their names and marks not solely for commercial purposes, but to express something about themselves, to contribute to the marketplace of ideas, and to speak on matters of public concern. These protected expressions are not

subject to reduced constitutional protection just because the speakers make them in connection with goods they offer for sale.

Affording full constitutional protection to trademarks that the Government deems "disparaging" is the only conclusion consistent with this Court's precedent, which describes the category of "commercial" speech in narrow terms as speech that does "*no more* than propose a commercial transaction." *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) (emphasis added). Mr. Tam, like many other trademark holders, seeks to express a unique message, not merely to advertise goods and services. And when the Government denies trademark registration on the basis of Section 2(a)'s anti-disparagement provision, it does so because of the *expressive* content of the holder's speech, not because of the commercial purposes for using the mark.

Applying the commercial-speech doctrine in this case would therefore expand that classification dramatically and result in a corresponding reduction in the amount of speech that is entitled to full First Amendment protection. Moreover, even if trademarks could properly be treated as commercial speech, Section 2(a)'s anti-disparagement provision would still be subject to "heightened judicial scrutiny" because it is a viewpoint-based restriction. *See Sorrell*, 564 U.S. at 565.

The Government cannot evade First Amendment scrutiny of the anti-disparagement provision by characterizing the federal trademark registration system as a subsidy program. While the Government has broad discretion in disbursing funds to beneficiaries or granting tax exemptions, trademark registration does not subsidize trademark holders but rather helps

maintain the channels of commerce by providing a uniform, nationwide registration system.

Ultimately, whether Section 2(a) is examined under strict scrutiny or heightened scrutiny (or even under the commercial-speech standard of *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*, 447 U.S. 557, 566 (1980)), the Government cannot meet its burden to justify the speech restrictions imposed by the anti-disparagement provision. The statute imposes a severe burden on the First Amendment rights of trademark holders by denying their "disparaging" messages the procedural and practical protections that accompany federal registration. Those protections are enormously important, especially to a small business. And no one could seriously regard a trademark as government speech, or even government-condoned speech, so the Government has no legitimate interest in disassociating itself from "disparaging" trademarks.

The Federal Circuit's judgment invalidating Section 2(a)'s anti-disparagement provision as an unconstitutional restriction on speech should be affirmed.

ARGUMENT

I. SECTION 2(a)'S ANTI-DISPARAGEMENT PROVISION IS A VIEWPOINT-BASED RESTRICTION ON EXPRESSION.

The First Amendment bars the Government from attempting to regulate the marketplace of ideas. "[T]he most basic of [First Amendment] principles is this: 'As a general matter, government has no power to restrict expression because of its message, its ideas, its subject matter, or its content.'" *Brown v. Entm't Merch. Ass'n*, 564 U.S. 786, 790–91 (2011)

(quoting *Ashcroft v. Am. Civil Liberties Union*, 535 U.S. 564, 573 (2002)).

This principle applies whether the speaker is an individual or a corporation, and whether he seeks political change, social dialogue, or commercial gain. *See Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011). "The First Amendment requires heightened judicial scrutiny 'whenever the government creates a regulation of speech because of disagreement with the message it conveys,'" and "[c]ommercial speech is no exception." *Id.* (quoting *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989)). The prohibition on viewpoint discrimination applies both when the Government attempts to prohibit the speech of "business corporations" and when the Government attempts to compel it. *Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp. of Boston*, 515 U.S. 557, 573–74 (1995); *see also Pac. Gas & Elec. Co. v. Pub. Utils. Comm'n of Cal.*, 475 U.S. 1, 16 (1986) (plurality op.) ("For corporations as for individuals, the choice to speak includes within it the choice of what not to say."). And the prohibition applies whether the Government directly bans particular speech or indirectly burdens it. *See United States v. Playboy Entm't Grp., Inc.*, 529 U.S. 803, 812 (2000) ("Government's content-based burdens must satisfy the same rigorous scrutiny as its content-based bans.").

In cases where this Court has approved restrictions on commercial speech, it has done so only because the rules directly advanced a substantial government interest, and only where the Government did not target speech based on its viewpoint. *See Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 556 (1980). These commercial-speech restrictions are permissible only because—and only so long as—they do not attempt to "burden the

speech of others in order to tilt public debate in a preferred direction." *Sorrell*, 564 U.S. at 578–79. Similarly, where the Government creates a subsidy program, it may enact certain content-based conditions on participation in order to further the purposes of the program, so long as the Government does not "leverage its power to award subsidies on the basis of subjective criteria into a penalty on disfavored viewpoints." *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 585, 587 (1998).

Section 2(a)'s anti-disparagement provision fails the core test of the First Amendment: The statute imposes burdens on speech based on the Government's determination that the viewpoint expressed is offensive. As the Government acknowledges, the anti-disparagement provision was enacted with the express purpose of disincentivizing the selection of trademarks that—in the Government's view—are "disparaging" by denying federal recognition of such marks and thereby "diminish[ing] the[ir] effectiveness." *Sorrell*, 564 U.S. at 565; *see also* Br. of United States 28.

Although this viewpoint-based restriction on speech should be subject to strict scrutiny—or, at a minimum, heightened judicial scrutiny—Section 2(a) cannot survive any standard of First Amendment review.

II. SECTION 2(a)'S ANTI-DISPARAGEMENT PROVISION IS NOT A PERMISSIBLE REGULATION OF "COMMERCIAL SPEECH."

The Government devotes only a sentence in its brief to justifying Section 2(a) on the basis of the more "limited form of First Amendment protection" that this Court has applied to "commercial speech." Br. of

United States 48 (quoting *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 535 (1987)). The brevity of the Government's argument is among the best evidence that this Court's commercial-speech precedents do not apply to this case. But several judges on the Federal Circuit did argue that the constitutionality of the anti-disparagement provision should be evaluated under the commercial-speech doctrine, and they are supported by several of the Government's *amici* in this Court.

Those arguments are misplaced. Classifying all trademarks as commercial speech—including those that the Government finds to be "disparaging"—would represent a significant and unwarranted expansion of the commercial-speech doctrine that ignores the reason for the doctrine in the first place.

A. "Commercial Speech" Is A Narrow Category Limited To Speech Proposing A Commercial Transaction.

The First Amendment standards that apply to commercial speech, *see Cent. Hudson*, 447 U.S. at 562–63, are the constitutional *exception*, not the rule. As this Court has emphasized, the category of "commercial speech" is narrow. It encompasses only speech that does "*no more* than propose a commercial transaction," *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976) (emphasis added), and that "relate[s] *solely* to the economic interests of the speaker and its audience." *Cent. Hudson*, 447 U.S. at 561 (emphasis added); *see also Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 455 (1978) (commercial speech is "[e]xpression concerning purely commercial transactions"). The commercial-speech doctrine is manifestly inapplicable to most trademarks.

As an initial matter, no one seriously disputes that Mr. Tam's *message* is fully protected speech on a matter of public concern: By labeling himself and his bandmates "Slants," he seeks to make a statement about racial and ethnic identity, and to marginalize racism by—as he puts it—"reclaiming" a slur. He advocates social change and challenges perceptions of people of Asian descent. *See* Pet. App. 10a, 24a.

Mr. Tam could not achieve his goals as effectively using a similar mark that would fall outside Section 2(a)'s prohibition on registering "disparaging" marks. Mr. Tam's mark is designed to provoke and challenge his audience in a very particular way that could not be replicated by another mark the Government considers less objectionable. Just as authors and artists make particular choices about words, imagery, or design in order to convey a specific meaning—and sometimes in order to disquiet or shock their audience—trademark holders choose the words and symbols by which they identify themselves in order to convey particular messages or promote certain values.

If Mr. Tam wanted to stand with his bandmates on a sidewalk under a banner reading "The Slants" in order to provoke a conversation about racial identity, any government restriction on the content of that expression would be subject to strict scrutiny. *Cf. Snyder v. Phelps*, 562 U.S. 443, 457–59 (2011) (applying strict scrutiny and overturning a tort judgment based on the viewpoint expressed in speech on matters of public concern adjacent to public streets). Likewise, if Mr. Tam chose to publish his views on racial stereotypes as a pamphlet authored by "The Slants," the pamphlet would indisputably receive full First Amendment protection. *Cf. Near v. Minnesota*, 283

U.S. 697, 702, 721–22 (1931) (striking down an ordinance prohibiting publications that are "malicious, scandalous and defamatory"). Indeed, the Government concedes that Mr. Tam's right to promote his message through his chosen medium, a dance-rock album, is fully protected by the First Amendment. *See* Br. of United States 26.

The Government and its *amici* nevertheless assert that, because Mr. Tam and other trademark holders have decided to enter the commercial realm, their otherwise-fully-protected expression should be reduced to the status of commercial speech. As explained below, that proposition finds no support in this Court's precedent.

B. The Government May Not Engage In Viewpoint Discrimination Simply Because The Speaker Has An Economic Interest In A Message.

The First Amendment protection that attaches to a trademark holder's speech is not diminished because the speaker is both engaging in expression and seeking to make a profit. Judge Reyna, dissenting from the Federal Circuit's opinion below, asserted that "commercial speech does not transform into core political speech with full First Amendment protections simply because it 'links a product to a current public debate.'" Pet. App. 111a. But that gets it precisely backward: Speech with cultural, social, or political content is not transformed into "commercial speech" with diminished First Amendment protections just because the speaker disseminates her message in the commercial marketplace. *See Sorrell*, 564 U.S. at 579 ("The commercial marketplace, like other spheres of our social and cultural life, provides a forum where ideas and information flourish.").

Mr. Tam's use of "The Slants" goes far beyond proposing a commercial transaction to the public. He proposes instead to engage his audience in a discussion about racial identity and racial stereotypes, *see* Pet. App. 10a, 24a, both of which are matters of genuine public concern. And he is not remotely the first trademark holder to disseminate a message that transcends commerce. Section 2(a)'s anti-disparagement provision targets trademarks that invariably have an expressive purpose that goes beyond conveying purely commercial information. The holders of these marks choose them in order to distinguish themselves, and to convey something about who they are, what they do, how they do it, and what they believe.

The trademarked names and imagery of the National Association for the Advancement of Colored People, the Human Rights Campaign, and other advocacy groups plainly communicate far more than a commercial message. And this is equally true of trademarks used by for-profit businesses. Pepsi-Cola, for example, first adopted its iconic red, white, and blue color scheme for its bottles during World War II in order to express support for the troops. *See* PepsiCo, *The Pepsi-Cola Story* 7.[2] That color scheme is still today incorporated into several of PepsiCo's registered trademarks. Trademarks used by for-profit companies can invoke the sense of a place (real or imagined), like the "Patagonia" clothing company or the "Atlantis" Bahamas resort. They can inspire (the San Diego "Chargers"), rally a community together ("DC United" soccer club), or boast ("Seattle's Best Coffee," "The ultimate driving machine"). The trademarked slogans of Nike ("Just do it"), Apple ("Think different"), and

---

[2] *Available at* http://www.pepsi.com/PepsiLegacy_Book.pdf.

Royal Caribbean cruise line ("Get out there") urge listeners to adopt a certain lifestyle. And the name "Google" was chosen by its founders as "a play on the word 'googol,' a mathematical term for the number represented by the numeral 1 followed by 100 zeros," in order to "reflect[ ] [the founders'] mission to organize a seemingly infinite amount of information on the web." Google Co., *Our history in depth*.[3]

These trademarks were not created solely to propose a commercial transaction or to generate increased revenue. They were chosen because they expressed a company's values and embodied its vision. Trademarks often play a key role in a company's branding precisely because they link a product with a particular idea or lifestyle. In those cases, even if the company's *ends* are predominantly commercial, its chosen means of expression are not.

The Government's disapproval of "disparaging" trademarks thus goes well beyond regulating "advertising," *Cent. Hudson*, 447 U.S. at 563, which rests at the heart of the commercial-speech doctrine. In fact, Section 2(a)'s anti-disparagement provision is not about advertising at all. The Government seeks to discourage holders of allegedly "disparaging" trademarks from *calling themselves* by those names and from using those names in any setting connected with their operation, not merely from including those names on commercial advertising.

Nor can most trademarks be reasonably described as "expression related *solely* to the economic interests of the speaker and its audience." *Cent. Hudson*, 447

---

[3] *Available at* https://www.google.com/about/company/history/.

U.S. at 561 (emphasis added). In his dissenting opinion, Judge Reyna contended that trademarks are commercial speech because they are "necessarily tools of commerce used with an 'economic motive,'" and that the benefits of trademark registration are purely commercial because registration allows its owner to gain "a competitive advantage in the marketplace" where "the interests of both the owner and competitor are fundamentally commercial in nature." Pet. App. 111a–12a & n.1.

This view vastly understates the expressive value of trademarks, for Mr. Tam specifically and for many of *amicus*'s members more broadly. Most trademark holders have more than a mere commercial interest in selecting the names by which they identify themselves. And registering those names for trademark protection provides many "substantial" benefits to the holder, not all of which are economic. *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1310 (2015). Among other things, registration is a prerequisite for a mark to become "incontestable," and "[i]ncontestability is a powerful protection." *Id.* (quoting 15 U.S.C. § 1065). Registration is also an indispensable tool to prevent others from adopting confusingly similar identifiers, which allows a speaker to express his unique views more clearly.

Trademark holders rely on these protections to ensure that their message is not undermined by imitators or detractors who might drown out or distort the holders' message. Trademark registration advances those expressive interests even if the trademark holder also relies on his trademark rights to facilitate increased sales of products in the marketplace. And, of course, the financial benefits that may accompany trademark registration increase the resources a holder has to promote his mark and message.

Moreover, speakers generally have the same type of "economic interest" in registering a copyright as in registering a trademark: In both cases, registration allows the owner to gain "a competitive advantage in the marketplace." Pet. App. 112a (Reyna, J., dissenting). If the bare fact of those motives sufficed to trigger the commercial-speech doctrine, then the Government could refuse to grant copyright protection to books and films it labels "disparaging." The Government's brief does not defend that extraordinary contention, *see* Br. of United States 47–48, and with good reason—it would come dangerously close to authorizing government-imposed burdens on offensive books. But just as copyright applicants seek both economic and non-economic benefits of registration for their expression, trademark applicants nearly always have more than a singular commercial motive for registering the labels they use to express themselves.

Affording full First Amendment protection to trademarks that the Government finds "disparaging" is the only approach consistent with the reasoning that underlies this Court's commercial-speech precedents. This Court has held that constitutional protection for commercial speech derives from "the informational function of advertising," *Cent. Hudson*, 447 U.S. at 563, and that "'commercial speech can be subject to greater governmental regulation than noncommercial speech'" because of "the government's legitimate interest in protecting consumers from 'commercial harms,'" *Sorrell*, 564 U.S. at 579 (quoting *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 426 (1993)).

Section 2(a)'s anti-disparagement provision, however, is not about improving the informational function of advertising or protecting consumers against

commercial harms. The statutory goal of the trademark-registration program is to avoid confusion in the marketplace, *see B & B Hardware*, 135 S. Ct. at 1299, but barring "disparaging" trademarks has nothing to do with that objective. In any event, trademarks that the Government deems "disparaging" express the views and values of the holder. They are not only contributions to the commercial marketplace but also contributions to the marketplace of ideas, and therefore warrant full constitutional protection. *See Bigelow v. Virginia*, 421 U.S. 809, 820–21 (1975) (holding that full First Amendment protection would apply to an advertisement that "'communicated information, expressed opinion, recited grievances, protested claimed abuses, and sought financial support on behalf of a movement whose existence and objectives are matters of the highest public interest and concern'") (quoting *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 266 (1964)).

In his dissent below, Judge Reyna relied on *Friedman v. Rogers*, 440 U.S. 1 (1979), and *San Francisco Arts & Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522 (1987), but neither case supports his view that Section 2(a)'s anti-disparagement provision should be examined under the commercial-speech doctrine. In *Friedman*, this Court stated that *some* trade-name users, like the plaintiff there, "do[ ] not wish to editorialize on any subject, cultural, philosophical, or political," and have "strictly business" purposes. 440 U.S. at 11 (internal quotation marks omitted). But that statement clearly does not apply to Mr. Tam or many other trademark holders with an expressive message. In any event, that aside was not part of the central reasoning of the decision, which upheld the regulation because of the State's "substantial and well demonstrated" interest in "protecting the

public from the deceptive and misleading use of optometrical trade names." *Id.* at 15. *Friedman* provides no support for the idea that the Government can regulate trade names because it disapproves of the message they convey.

Similarly, *San Francisco Arts* held that the restriction at issue applied to commercial speech "[*t*]*o the extent that*" it applied to speech made "for the purpose of trade or to induce the sale of any goods or services." 483 U.S. at 535 (emphasis added). But that likewise does not describe "The Slants," which is a trademark that seeks to do far more than promote record sales. More broadly, distinguishing between "strictly business" trademarks and those that convey an editorial, cultural, philosophical, or political purpose—as Judge Dyk proposed in his opinion, *see* Pet. App. 89a–90a—would only lead courts into hopeless line-drawing exercises that are virtually certain to produce arbitrary results. It is not clear how a court would ever be able to determine that a specific trademark carries no expressive purpose whatsoever other than proposing a commercial transaction. And in a situation where commercial speech is intertwined with fully protected, noncommercial speech, this Court has made clear that "the entirety must . . . be classified as noncommercial" speech in order to ensure full protection for noncommercial expression. *Sorrell*, 564 U.S. at 571 (quoting *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 474 (1989)).

Furthermore, even if it were possible to distinguish "strictly business" trademarks from trademarks that convey a noncommercial message, Section 2(a)'s anti-disparagement provision invariably targets trademarks with expressive, noncommercial characteristics, rather than those that simply identify the sources of goods and services in commerce. As the

Federal Circuit explained, "*every time* the [Patent and Trademark Office ('PTO')] refuses to register a mark under § 2(a), it does so because it believes the mark conveys an expressive message." Pet. App. 25a. Because Section 2(a)'s anti-disparagement provision is directly targeted at trademark holders' *expression*, not their economic motives, it must be examined under the same demanding First Amendment standards as all other restrictions on noncommercial expression.

C. Even If Trademarks Are Commercial Speech, Section 2(a)'s Anti-Disparagement Provision Is Still Subject To Heightened Judicial Scrutiny.

Section (2)(a)'s anti-disparagement provision would not escape stringent constitutional scrutiny even if all trademarks were properly classified as commercial speech. This Court has traditionally determined the constitutionality of a restriction on commercial speech by applying the standard articulated in *Central Hudson*, which provides that, if the speech "concern[s] lawful activity" and is not "misleading," then the Government must have a "substantial" interest in the regulation, the regulation must "directly advance[ ] the government interest asserted," and the regulation must not be "more extensive than is necessary to serve that interest." 447 U.S. at 566. If trademarks are commercial speech, however, then Section 2(a)'s anti-disparagement provision must be examined with "heightened judicial scrutiny."

In *Sorrell*, this Court reaffirmed that "[t]he First Amendment requires heightened judicial scrutiny 'whenever the government creates a regulation of speech because of disagreement with the message it conveys,'" and "[c]ommercial speech is no exception." 564 U.S. at 566 (quoting *Ward*, 491 U.S. at 791). The

Court held that the Vermont regulation at issue, which restricted the sale, disclosure, and use of pharmacy records for marketing purposes, *id.* at 557, was content- and speaker-based because it had been enacted with the express purpose of "diminish[ing] the effectiveness of marketing by manufacturers of brand-name drugs," *id.* at 565. The Court emphasized that laws that "burden[ ] disfavored speech by disfavored speakers" are particularly offensive to the interests in free and open expression that animate the First Amendment, and therefore trigger additional judicial scrutiny. *Id.* at 564.

As explained above, Section 2(a) is a viewpoint-based restriction on speech. *See supra* Part I. If, for example, another band wanted to register the trademark "No Slurs" in order to convey their message that racial slurs should be banished from the lexicon rather than "reclaimed," that band's trademark would not have violated Section 2(a) and would have been registered by the PTO. Mr. Tam was denied registration based solely on the distinct viewpoint communicated by his mark. That is viewpoint-based regulation of speech, pure and simple.

III. SECTION 2(a)'S ANTI-DISPARAGEMENT PROVISION IS UNCONSTITUTIONAL UNDER ANY STANDARD OF SCRUTINY.

Whether examined under strict scrutiny, heightened scrutiny, or even *Central Hudson*, Section 2(a)'s anti-disparagement provision is unconstitutional because the Government lacks any legitimate interest in burdening speech that it deems to be "disparaging." The Government has no valid justification for deciding whether terms that some people may find "disparaging"—or even that almost everyone finds "disparaging"—belong in the commercial marketplace. The

anti-disparagement provision exists to do *precisely* what the First Amendment forbids: It "seek[s] to suppress a disfavored message." *Sorrell*, 564 U.S. at 572.

The Government attempts to insulate the anti-disparagement provision from First Amendment scrutiny by characterizing it as a condition on a government subsidy program, but it fundamentally misunderstands this Court's "subsidy" decisions. The Government also ignores the serious burden that the anti-disparagement provision imposes on the First Amendment rights of those trademark holders who, at the whim of a PTO examiner, are forced to choose between changing their business's name or forgoing essential trademark protections.

A. The Trademark Registration Program Is Not A Government Subsidy.

Much of the Government's brief is devoted to arguing that it is has no obligation to "subsidize" disparaging speech. But the federal trademark system is not a subsidy program.

This Court's subsidy cases have almost always involved either distributing funds to beneficiaries or granting them a tax exemption. *See, e.g.*, *Regan v. Taxation Without Representation of Wash.*, 461 U.S. 540, 545 (1983) (upholding denial of tax-exempt status to organizations engaged in lobbying); *Rust v. Sullivan*, 500 U.S. 173, 193–94 (1991) (upholding a regulation prohibiting the use of federal family-planning funds to provide abortion-related counseling); *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 572–73 (1998) (upholding a statute directing a panel awarding federal arts grants to consider "decency and respect for the diverse beliefs and values of the American public"); *United States v. Am. Library Ass'n*, 539

U.S. 194, 204–05 (2003) (upholding a condition requiring public libraries that receive federal subsidies for Internet access to use software that filters Internet pornography).

The Government's attempt to analogize the trademark registration program to these "subsidy" cases fundamentally misunderstands trademark law in the United States. Unlike the congressionally created rights that federal law affords to the beneficiaries of a subsidy program, "[t]rademark rights arise through use of the mark in commerce, not by operation of federal law." Br. of United States 10. The purpose of the federal registration system is merely to help maintain the channels of commerce through a system of orderly administration that provides notice of who is using which marks and for what purpose. *See B & B Hardware*, 135 S. Ct. at 1299 (trademarks "can help distinguish a particular artisan's goods from those of others"). That is not a "subsidy" for persons who hold trademark rights under the common law any more than making the courts available for contract disputes is a subsidy for commercial enterprises.

Moreover, even if the trademark registration program could be characterized as a government subsidy, Section 2(a)'s anti-disparagement provision would still be unconstitutional. The Court has explained that the Government does not have authority to attach "conditions that seek to leverage funding to regulate speech outside the contours of the program itself." *Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013). In *Agency for International Development*, this Court struck down a restriction on a grant program to combat the spread of HIV/AIDS where the restriction limited funds to organizations that had policies expressly opposing prostitution and sex-trafficking. *Id.* at 2230. The Court

held that, once the Government establishes a program, it may not restrict eligibility based on the viewpoint of would-be beneficiaries. *Id.* But that is precisely what Section 2(a)'s anti-disparagement provision does by permitting the Government to deny trademark holders federal registration based on their expression of points of view that the Government considers "disparaging."

B. Registration Is Critically Important To Trademark Holders.

The Government also makes an extended effort to minimize the importance of federal trademark registration, but none of its arguments diminishes the serious First Amendment deficiencies in Section 2(a)'s anti-disparagement provision.

According to the Government, there is nothing particularly significant about denying federal registration to a trademark because the holder is still entitled to use the mark in commerce and to sue to prevent others from using it. Br. of United States 20–21, 26–28. But the Government's argument significantly understates the importance to a business—especially a small business—of federal registration for a trademark. Registration is a great equalizer that enables even a small company to prevent a well-funded usurper from infringing its mark. In the absence of registration, trademark litigation would be prohibitively expensive for many small entities because it would turn on potentially complex factual questions about commercial acceptance of the mark in various product markets around the country. And as the Federal Circuit explained, "[i]n the absence of federal registration, if a trademark owner has any common law rights, they are limited to the territory in which the mark is known and recognized by those in the defined

group of potential customers." Pet. App. 36a (internal quotation marks and citation omitted).

In light of the burdens that accompany the denial of these federal protections to trademark holders whose marks are deemed "disparaging," the anti-disparagement provision must withstand the same First Amendment scrutiny as an outright prohibition on "disparaging" speech. It is well settled that "[l]awmakers may no more silence unwanted speech by burdening its utterance than by censoring its content." *Sorrell*, 564 U.S. at 566. "[T]he 'distinction between laws burdening and laws banning speech is but a matter of degree,'" and "the 'Government's content-based burdens must satisfy the same rigorous scrutiny as its content-based bans.'" *Id.* at 565–66 (quoting *Playboy*, 529 U.S. at 812). That is why this Court held in *Simon & Schuster, Inc. v. Members of the New York State Crime Victims Board*, 502 U.S. 105 (1991), that the Government may not single out a particular kind of speech for imposition of "a financial burden," even where the regulation does not rise to the level of an outright ban. *See id.* at 123 (applying strict scrutiny and striking down a statute that prohibited an accused or convicted criminal from earning income from works describing his crime).

The Government conceives of Section 2(a)'s anti-disparagement provision as the denial of a protective benefit to certain speech, rather than a restriction on speech. Br. of United States 20–25. But that is just another way of saying that Section 2(a) submits the equal protection of law to a heckler's veto: Because the PTO concluded that a substantial portion of the public was likely to regard Mr. Tam's speech as "disparaging," the Government has refused to provide his speech with the protections that federal trademark

registration affords trademark holders against ideological or commercial opponents. If Mr. Tam wanted to stage a march advocating his views regarding racial equality—even a provocative march that uses "reclaimed" racial slurs—the Constitution would not allow the Government, on the basis of his viewpoint, to deny him equal protection of the law against detractors who would like to shut down his speech. *See, e.g.*, *Edwards v. South Carolina*, 372 U.S. 229 (1963) (police could not constitutionally shut down an anti-segregation march for fear of a riot based on the marchers' viewpoint); *Cox v. Louisiana*, 379 U.S. 536 (1965) (police could not refuse to provide protection for a civil-rights protest). For the very same reason, the Government may not deny Mr. Tam the protection of the trademark laws based on the viewpoint expressed in the mark he submitted for federal registration.

The Government offers no legitimate—let alone compelling—interests to justify these serious burdens on First Amendment rights. In particular, the anti-disparagement provision is not supported by the Government's interest in disassociating itself from offensive speech. This case is unlike *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2248–49 (2015), in every salient respect, including that there is no "history" of trademarks being regarded as "communicat[ing] messages" from the Government, and a trademark is not "'closely identified in the public mind with the [State].'" *Id.* at 2248. Quite the contrary, a mark "identifie[s]" the holder, and there is no need for the Government to disassociate itself from offensive trademarks because no reasonable person would believe that registered trademarks carry the imprimatur of the federal government. As

the Federal Circuit explained, "the PTO routinely registers marks that no one can say the government endorses." Pet. App. 43a (citing examples).

In this respect, there is again no material difference between the registration systems for trademarks and copyrights. If the nebulous possibility of negative association justified Section 2(a)'s anti-disparagement provision, then it would also justify the Government's refusal to provide copyright protection to "disparaging" works of literature, film, or other art. Copyright registrations, like trademark registrations, also come in the form of "certificates issued in the name of the United States," along with "recordation" in a federal database. Br. of United States 49. The Government would not take the radical position that it could refuse to register a copyright for offensive (or even hateful) expression. Its position in this case is equally odious to the First Amendment.

* * *

Recent events provide a reminder why the founding generation was wise to withhold from government bureaucrats the power to decide what constitutes "disparaging" speech. Many citizens, including those at America's elite universities, appear to regard the prevention of disparagement as a flexible tool for suppressing speech. For example, during the presidential election, some students complained about seeing "Trump 2016" written in chalk on the sidewalks of their campus, which led the president of the university to call the chalk messages "perceived intimidation" and to affirm that the offended students had heard "a message, not about political process or candidate choice, but instead about values regarding diversity and respect that clash with [the university's]

own." *Someone wrote 'Trump 2016' on Emory's campus in chalk. Some students said they no longer feel safe*, The Washington Post (Mar. 24, 2016).[4]

Other universities have seen students complain that the American flag is an offensive and anti-inclusive symbol that "has been flown in instances of colonialism and imperialism," and successfully resolve to have the flag removed from various locations on campus. *American flag banned by Calif. university students to create 'inclusive' atmosphere*, The Washington Times (Mar. 7, 2015).[5]

Today's political-science majors will be legislators tomorrow. This Court should reaffirm that they cannot deny protection to ideas they find "disparaging."

---

[4] *Available at* https://www.washingtonpost.com/news/grade-point/wp/2016/03/24/someone-wrote-trump-2016-on-emorys-campus-in-chalk-some-students-said-they-no-longer-feel-safe/?utm_term=.1fea8d99e785

[5] *Available at* http://www.washingtontimes.com/news/2015/mar/7/university-california-irvine-students-vote-ban-ame/.

CONCLUSION

For the foregoing reasons, the judgment should be affirmed.

Respectfully submitted.

LILY FU CLAFFEE
KATE COMERFORD TODD
WARREN POSTMAN
U.S. CHAMBER LITIGATION CENTER
1615 H Street, N.W.
Washington, D.C. 20062
(202) 463-5337

EUGENE SCALIA
Counsel of Record
AMIR C. TAYRANI
MICHAEL R. HUSTON
GIBSON, DUNN & CRUTCHER LLP
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036
(202) 955-8500
escalia@gibsondunn.com

Counsel for Amicus Curiae

December 16, 2016

RECORD AND BRIEFS.

No. 15-1293

Supreme Court, U.S.
FILED
DEC 14 2016
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

—v.—

SIMON SHIAO TAM,

Respondent.

ON A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR *AMICI CURIAE* CONSTITUTIONAL LAW PROFESSORS IN SUPPORT OF THE RESPONDENT

RODNEY A. SMOLLA
4601 Concord Pike
Wilmington, Delaware 19803
(302) 477-2278

FLOYD ABRAMS
Counsel of Record
FRIA KERMANI
KATHLEEN E. FARLEY
CAHILL GORDON
& REINDEL LLP
80 Pine Street
New York, New York 10005
(212) 701-3000
fabrams@cahill.com

Counsel for Amici Curiae

TABLE OF CONTENTS

PAGE

IDENTITY AND INTERESTS OF THE *AMICI* 1

SUMMARY OF ARGUMENT 1

ARGUMENT 5

I. SECTION 1052(A) IS A BRAZEN EXERCISE IN CONTENT AND VIEWPOINT DISCRIMINATION 5

II. TRADEMARK REGISTRATION IS NOT GOVERNMENT SPEECH 9

A. Treating Trademark Registration as Government Speech Contradicts the Rationales Underlying the Government Speech Doctrine 9

B. Treating Trademark Registration as Government Speech is Contrary to the Government Speech Doctrines Emanating from *Summum* and *Walker* 12

III. DENIAL OF TRADEMARK REGISTRATION IS NOT A LIMITATION ON THE CONFERRAL OF A GOVERNMENT BENEFIT ESSENTIAL TO DEFINING THE CONTOURS OF A GOVERNMENT PROGRAM 15

IV. SECTION 1052(A) CANNOT BE SUSTAINED AS A VALID REGULATIONOF COMMERCIAL SPEECH 21

CONCLUSION 29

APPENDIX: List of *Amici Curiae* Constitutional Law Professors A1

TABLE OF AUTHORITIES

PAGE(S)

Cases

Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.,
133 S. Ct. 2321 (2013) 16, 19-20

Arizona Free Enterprise Club's Freedom Club PAC v. Bennett,
564 U.S. 721 (2011) 8

Ass'n of Private Sector Colls. & Univs. v. Duncan,
681 F.3d 427 (D.C. Cir. 2012) 23

B & B Hardware, Inc. v. Hargis Indus., Inc.,
135 S. Ct. 1293 (2015) 13-14, 17

Bd. of Regents of Univ. of Wis. Sys. v. Southworth,
529 U.S. 217 (2000) 11

Bigelow v. Virginia,
421 U.S. 809 (1975) 25

Bob Jones Univ. v. United States,
461 U.S. 574 (1983) 18

Bolger v. Youngs Drug Prods. Corp.,
463 U.S. 60 (1983). 27

Brandenburg v. Ohio,
395 U.S. 444 (1969) 11

Carey v. Population Servs. Int'l,
431 U.S. 678 (1977) 26-27

Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n,
447 U.S. 557 (1980) 21-22

Christian Legal Soc'y Chapter of the Univ. of Cal. v. Martinez,
561 U.S. 661 (2010) 18

City of Cincinnati v. Discovery Network, Inc.,
507 U.S. 410 (1993) 28

FCC v. League of Women Voters,
468 U.S. 364 (1984) 16, 19

Greater New Orleans Broad. Ass'n., Inc. v. United States,
527 U.S. 173 (1999) 26

Grove City Coll. v. Bell,
465 U.S. 555 (1984) 18

Healy v. James,
408 U.S. 169 (1972) 16-17

Legal Services Corp. v. Velazquez,
531 U.S. 533 (2001) 10, 16, 21

Lorillard Tobacco Co. v. Reilly,
533 U.S. 525 (2001) 28

Minneapolis Star & Tribune Co. v. Minnesota Comm'r of Revenue,
460 U.S. 575 (1983) 8

N.Y. Times Co. v. Sullivan,
376 U.S. 254 (1964) 25

Nike, Inc. v. Kasky,
539 U.S. 654 (2003) 24

In re Old Glory Condom Corp.,
26 U.S.P.Q.2d 1216 (T.T.A.B. 1993) 14

In re Orthopedic Bone Screw Prods. Liab. Litig.,
193 F.3d 781 (3d Cir. 1999) 23-24

Perry v. Sindermann,
408 U.S. 593 (1972) 16

Pleasant Grove City v. Summum,
555 U.S. 460 (2009) 9-10, 12

R.A.V. v. City of St. Paul,
505 U.S. 377 (1992) 7-8

Radiance Found., Inc. v. NAACP,
786 F.3d 316 (4th Cir. 2015) 22

Reed v. Town of Gilbert,
135 S. Ct. 2218 (2015) 6-7, 26

Regan v. Taxation With Representation,
461 U.S. 540 (1983) 19

Riley v. Nat'l Fed'n of the Blind of N.C., Inc.,
487 U.S. 781 (1988) 23

Rosenberger v. Rector and Visitors of Univ. of Va.,
515 U.S. 819 (1995) 7, 16-17

Rumsfeld v. Forum for Acad. and Institutional Rights, Inc.,
547 U.S. 47 (2006) 19

Rust v. Sullivan,
500 U.S. 173 (1991) 10, 19

Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.,
502 U.S. 105 (1991) 8, 28

Snyder v. Phelps,
562 U.S. 443 (2011) 6, 11

Sorrell v. IMS Health Inc.,
564 U.S. 552 (2011) 8, 25-26

In re Tam,
808 F.3d 1321 (Fed. Cir. 2015) 2, 7, 9

Texas v. Johnson,
491 U.S. 397 (1989) 5, 11

Thompson v. W. States Med. Ctr.,
535 U.S. 357 (2002) 26

In re Trade-Mark Cases,
100 U.S. 82 (1879) 13

United States v. Alvarez,
132 S. Ct. 2537 (2012)
(plurality opinion) 6

United States v. Stevens,
559 U.S. 460 (2010) 6, 11

United States v. United Foods, Inc.,
533 U.S. 405 (2001) 25

Virginia v. Black,
538 U.S. 343 (2003) 11

W. Va. State Bd. of Educ. v. Barnette,
319 U.S. 624 (1943) 12

Walker v. Texas Division, Sons of Confederate Veterans, Inc.,
135 S. Ct. 2239 (2015) ..... *passim*

Statutes

15 U.S.C. § 1052(a) ..... *passim*

Other Authorities

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th ed. 2016) 20

Jennifer E. Rothman, *Commercial Speech, Commercial Use, and the Intellectual Property Quagmire*, 101 Va. L. Rev. 1929 (2015) 23

IDENTITY AND INTERESTS OF THE *AMICI*

Amici are scholars who regularly engage in legal writing and litigation germane to the First Amendment, including the intersection of the freedom of speech and intellectual property. Their interest in this litigation is to offer their views regarding the principles to be applied in determining whether the disparagement provision of the Lanham Act, 15 U.S.C. § 1052(a), violates the First Amendment, principles which have led them to conclude that the provision is inconsistent with the First Amendment.[1]

SUMMARY OF ARGUMENT

Section 1052(a) is a brazen exercise in content and viewpoint discrimination. On its face and as its animating purpose, it exists to discriminate against expression perceived by the government to be disparaging and offensive. Under the strict scrutiny standard applicable to content or viewpoint discrimination, the law cannot stand in light of the bedrock principle underlying the First Amendment that government may not penalize speech merely because it is deemed offensive or disagreeable. These principles apply to laws that burden speech just as they apply to laws that fully censor it.

---

[1] Pursuant to Rule 37.6, *amici* affirm that no counsel for a party authored this brief in whole or in part and that no person other than *amici* and their counsel made a monetary contribution to its preparation or submission. Petitioner's and Respondent's consent to the filing of amicus briefs is filed with the Clerk. *Amici's* institutional affiliations are provided only for purposes of identification.

Section 1052(a) is plainly unconstitutional unless some alternative First Amendment doctrine is applicable exempting the statute from the normal strictures forbidding content and viewpoint discrimination. Several have been posited. One claim, asserted by the United States in argument to the Court of Appeals, *In re Tam*, 808 F.3d 1321, 1345 (Fed. Cir. 2015), but all but abandoned in this Court, is that trademark registration is "government speech" and thus outside the coverage of the First Amendment. A second argument is that trademark registration is a government benefit, not a right, and that what appears to be content and viewpoint discrimination is merely the government acting to shape the contours of a benefit program. And finally, it may be claimed that regulation of disparaging trademarks constitute a valid regulation of commercial speech. None of these arguments is sound.

Denial of trademark registration does not fit either the theoretical justifications that support the government speech doctrine, or the doctrinal tests that have emerged to define the doctrine's contours. The core theoretical justification for the government speech doctrine is that voters may invoke a political check to approve or disapprove of the positions taken by government in the exercise of its own speech. Trademark registration is not an exercise of the government "speaking" as an incident to its acts of governing, however, for the government possesses no general governing power to police offensive or disparaging speech. More fundamentally, the entire purpose of the First Amendment is to prevent the government from exercising its political will to burden private expression. To treat denial of The Slants' trademark registration as not even implicating the First Amendment, on the ground that

it is some sort of government speech, is thus to turn First Amendment principle on its head.

Trademark registration is similarly outside the doctrinal definition of government speech. Trademarks are understood in society as the identifiers of private speakers. Trademarks are not created by the government, aligned with the government, used as "government IDs," or used as platforms for government expression. The government does not exercise control or approval of a trademark's design or composition. Rather, trademark is private expression. If the refusal to grant trademark registration were deemed government speech, then the government speech doctrine could effectively swallow virtually all free speech law, for any action by the government penalizing disfavored topics could simply be recast as the government itself speaking, thereby avoiding the proscriptions of the First Amendment.

The doctrine of unconstitutional conditions bars the government from denying government benefits to speakers on the condition that those speakers surrender First Amendment rights they would otherwise enjoy. While the unconstitutional conditions doctrine does not bar government from using the leverage of a public benefits program to prevent discriminatory conduct (as, for example, with gender discrimination provisions of Title IX), Section 1052(a) is not an anti-discrimination provision, and The Slants do not stand accused of any discriminatory conduct. Similarly, the unconstitutional conditions doctrine does not bar the government from restricting funding in a manner incident to the shaping of a spending program. Section 1052(a) is not such a spending program, however, but rather a classic example of what the unconstitutional conditions

doctrine most unambiguously forbids: using the leverage of the grant or denial of a government benefit to penalize viewpoints the government finds offensive.

Finally, Section 1052(a) cannot be defended as a valid regulation of commercial speech. It is entirely the non-commercial elements of the communication that Section 1052(a) regulates, the elements deemed by the government to be culturally and politically offensive. The refusal to register the mark The Slants sought is thus not in any authentic sense commercial regulation at all, and ought not be analyzed under commercial speech doctrine.

Even if the rules governing regulation of commercial speech were applied, the refusal to register the mark The Slants sought remains unconstitutional. One of the most powerful themes of modern commercial speech law is that the government may not invoke, as its "substantial interest" justifying regulation, the perceived offensiveness of the message communicated. The government is disqualified from invoking the false cover of commercial speech regulation to do no more than penalize expression it deems to be "scandalous," for such a paternalistic purpose is *per se* excluded from the interests that may be invoked to justify regulation.

With no plausible exception to classic free speech principles available to defend it, the emperor has no clothes, and Section 1052(a) is exposed for what it is: a naked exercise in unconstitutional content and viewpoint discrimination.

ARGUMENT

I. SECTION 1052(A) IS A BRAZEN EXERCISE IN CONTENT AND VIEWPOINT DISCRIMINATION

Section 1052(a) of the Lanham Act is a brazen exercise in content and viewpoint discrimination. The statute denies trademark registration to marks that meet all the normal requirements for trademark registration, but "[c]onsist[] of or comprise[] immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." 15 U.S.C. § 1052(a). Expression that is "immoral" or "scandalous" or that disparages or brings into contempt or disrepute "persons, living or dead, institutions, beliefs, or national symbols" is normally what freedom of speech is all about. "If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." *Texas v. Johnson*, 491 U.S. 397, 414 (1989). This commitment to freedom of speech protects graphic displays of offensive speech far more intense than the mark The Slants sought. As the Court explained in upholding First Amendment protections for the hatefully disparaging speech of the Westboro Baptist Church in its calculated verbal assaults on fallen American soldiers callously presented near military funerals:

> Speech is powerful. It can stir people to action, move them to tears of both joy and sorrow, and—as it did here—inflict great pain. On the facts before us, we cannot react

> to that pain by punishing the speaker. As a Nation we have chosen a different course—to protect even hurtful speech on public issues to ensure that we do not stifle public debate. That choice requires that we shield Westboro from tort liability for its picketing in this case.

Snyder v. Phelps, 562 U.S. 443, 460-61 (2011); *see also United States v. Stevens*, 559 U.S. 460, 471-72 (2010) (striking down a federal law prohibiting depictions of animal cruelty, such as "crush videos," observing that First Amendment doctrine does not permit punishment of "any speaker so long as his speech is deemed valueless or unnecessary, or so long as an ad hoc calculus of costs and benefits tilts in a statute's favor"); *United States v. Alvarez*, 132 S. Ct. 2537, 2543 (2012) (plurality opinion) (striking down federal law prohibiting false claims of military honors, observing that "[s]tatutes suppressing or restricting speech must be judged by the sometimes inconvenient principles of the First Amendment").

As a paradigmatic example of content and viewpoint discrimination, Section 1052(a) must—but cannot—withstand strict scrutiny. As this Court recently re-emphasized in *Reed v. Town of Gilbert*, the strict scrutiny standard is triggered by laws that either discriminate on their face on the basis of content, or that are motivated by a governmental purpose to penalize disfavored views. 135 S. Ct. 2218, 2228-31 (2015). There can be no dispute that Section 1052(a) is, by its very nature, content based, rooted in disapproval of language that is "scandalous" and the like. The brief of law professors as *amici curiae* submitted in support of petitioners emphasizes the content-based nature of the statute, as if that advanced the convention that the law met

constitutional standards. Br. of *Amici Curiae* Law Profs. in Supp. of Pet'rs 4-12. But the Federal Circuit in its opinion below was correct in concluding that it was "beyond dispute" that the consequence of the content-based nature of the statute was that strict scrutiny must be applied in assessing its constitutionality. *In re Tam*, 808 F.3d 1321, 1335 (Fed Cir. 2015). By requiring marks to be assessed for their supposedly "scandalous" nature or the like, Section 1052(a) "target[s] speech based on its communicative content" and is thus "presumptively unconstitutional." *Reed*, 135 S. Ct. at 2226.

Moreover, Section 1052(a) is on its face, a quintessential example of viewpoint-based legislation. Such laws that target particular views taken by speakers on a subject are a particularly "egregious" sub-type of content discrimination, *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819, 828-29 (1995), and are thus addressed with greatest skepticism under the First Amendment.

Consider, for example, the ordinance struck down in *R.A.V. v. City of St. Paul*, 505 U.S. 377 (1992), which read:

> Whoever places on public or private property a symbol, object, appellation, characterization or graffiti, including, but not limited to, a burning cross or Nazi swastika, which one knows or has reasonable grounds to know arouses anger, alarm or resentment in others on the basis of race, color, creed, religion or gender commits disorderly conduct and shall be guilty of a misdemeanor.

Id. at 380 (citation and internal quotation marks omitted). The Court held that the "ordinance goes

even beyond mere content discrimination, to actual viewpoint discrimination." *Id.* at 391.

Section 1052(a) of the Lanham Act engages in the same form of viewpoint discrimination as the law struck down in *R.A.V.*, and should be held unconstitutional for precisely the same reasons. The statute's sweeping prohibition on marks that disparage "persons, living or dead, institutions, beliefs, or national symbols" is breathtakingly overbroad, and cannot be distinguished from the *R.A.V.* ordinance proscribing "anger, alarm or resentment on the basis of race, color, creed, religion, or gender." So too, the government's *motive* in passing Section 1052(a) is constitutionally illicit—manifestly grounded in disagreement with the message communicated by the mark.

These viewpoint discrimination principles apply to laws that burden speech just as they apply to laws that fully censor it. "Lawmakers may no more silence unwanted speech by burdening its utterance than by censoring its content." *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011) (citing *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 115 (1991) (content-based financial burden); *Minneapolis Star & Tribune Co. v. Minnesota Comm'r of Revenue*, 460 U.S. 575, 591-92 (1983) (speaker-based financial burden)); *see also Arizona Free Enterprise Club's Freedom Club PAC v. Bennett*, 564 U.S. 721, 742 (2011) (striking down matching fund provisions that did not directly restrict speech, noting "that does not mean that the matching funds provision does not burden speech").

Section 1052(a) is plainly unconstitutional unless some alternative First Amendment doctrine is applicable exempting the statute from the normal

strictures forbidding content or viewpoint discrimination. We turn separately to the three dominant arguments offered at one time or another by the government. Arguing before the *en banc* Court of Appeals, the government (as the court put it) "appear[ed] to argue that trademark registration and the accouterments of registration . . .amount to government speech." *In re Tam*, 808 F.3d 1321, 1345 (Fed. Cir. 2015). That contention was addressed and squarely rejected by the Court of Appeals. In this Court, the government all but abandons, by its silence, this argument. However, because it continues to rely on *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015), the very case that focused most recently on what is and is not government speech, we therefore address it.

II. TRADEMARK REGISTRATION IS NOT GOVERNMENT SPEECH

A. Treating Trademark Registration as Government Speech Contradicts the Rationales Underlying the Government Speech Doctrine

This Court's decisions in *Pleasant Grove City v. Summum*, 555 U.S. 460 (2009), and in *Walker* set forth the guiding principles for determining whether expression should be classified as government speech. The Court's observation in *Summum* is apt here: "There may be situations in which it is difficult to tell whether a government entity is speaking on its own behalf or is providing a forum for private speech, but this case does not present such a situation." *Summum*, 555 U.S. at 470.

In *Summum*, the Court recognized "the legitimate concern that the government speech doctrine not be

used as a subterfuge for favoring certain private speakers over others based on viewpoint." *Id.* at 473. This is precisely the subterfuge at work here, as Section 1052(a) all but hijacks the government speech doctrine to penalize a viewpoint deemed offensive.

The government speech doctrine exists to enable the government to express its own viewpoint as it engages in the process of governance. Under the doctrine, "government statements (and government actions and programs that take the form of speech) do not normally trigger the First Amendment rules designed to protect the marketplace of ideas." *Walker*, 135 S. Ct. at 2245-46. The government may also impose viewpoint restrictions on speech made possible by a government program, so long as the program was designed to promote a governmental message. But if the program was enacted to facilitate private speech, the government may not impose viewpoint restrictions on that private speech. *Compare Rust v. Sullivan*, 500 U.S. 173, 194 (1991) (upholding restrictions on medical providers regarding abortion counseling) *with Legal Services Corp. v. Velazquez*, 531 U.S. 533, 548-49 (2001) (striking down restrictions on the litigation choices of legal services lawyers). These principles are in large part pragmatic, as it is difficult to imagine how government could operate if its own speech and its own programmatic initiatives were required to be viewpoint neutral. "Were the Free Speech Clause interpreted otherwise, government would not work." *Walker*, 135 S. Ct. at 2246.

The government speech doctrine is anchored by the theory that the political process provides a sufficient check on the government's expression. If voters disagree with the speech of the government, as expressed by the officials who comprise it, they may

elect different officials. The doctrine thus "in part reflects the fact that it is the democratic electoral process that first and foremost provides a check on government speech." *Id.* at 2245 (citing *Bd. of Regents of Univ. of Wis. Sys. v. Southworth*, 529 U.S. 217, 235 (2000)).

None of these rationales apply to a decision by the government to withhold trademark registration for disparaging marks. Such a decision cannot be speech incident to governance, because policing offensive speech in the general marketplace is not within the provenance of the government in the first place. To assume so turns the First Amendment on its head.

While the government speech doctrine is grounded in the notion that the democratic process serves as a check—if citizens don't like the speech of officials uttered in the name of the government they may vote the officials out—the whole point of the First Amendment's guarantee of freedom of speech is to *insulate* expression from the popular will. Most Americans find deeply offensive the desecration of the American flag, *see Johnson*, 491 U.S. at 414; or the Ku Klux Klan's burning of crosses, *see Virginia v. Black*, 538 U.S. 343, 367 (2003); *Brandenburg v. Ohio*, 395 U.S. 444, 448-49 (1969); or depictions of animal cruelty in "crush videos," *see Stevens*, 559 U.S. at 469; or the homophobic cries of the Westboro Baptist Church near military funerals, *see Snyder*, 562 U.S. at 460-61. But the First Amendment takes out of the hands of government the authority to channel those entirely rational majoritarian sensibilities into law. "The very purpose of a Bill of Rights was to withdraw certain subjects from the vicissitudes of political controversy, to place them beyond the reach of majorities and officials and to establish them as legal principles to be applied by the

courts." *W. Va. State Bd. of Educ. v. Barnette*, 319 U.S. 624, 638 (1943).

B. Treating Trademark Registration as Government Speech is Contrary to the Government Speech Doctrines Emanating from *Summum* and *Walker*

If it is theoretically incoherent to treat a refusal to grant trademark registration to disparaging marks as government speech, such treatment is also doctrinally unsound. In *Summum*, the government speech consisted of decisions by a city as to what permanent monuments it would display in a city park. 555 U.S. at 470. The Court drew on traditions going back thousands of years to support the notion that the selection of what monuments to include or exclude on government property are quintessentially exercises in expression by the government itself. *Id.* ("Governments have long used monuments to speak to the public. Since ancient times, kings, emperors, and other rulers have erected statues of themselves to remind their subjects of their authority and power. Triumphal arches, columns, and other monuments have been built to commemorate military victories and sacrifices and other events of civic importance.").

Building on *Summum*, the Court in *Walker* cited numerous reasons for treating the specialty license plate program in Texas as government speech. "First, the history of license plates shows that, insofar as license plates have conveyed more than state names and vehicle identification numbers, they long have communicated messages from the States." *Walker*, 135 S. Ct. at 2248. States, the Court observed, "have used license plate slogans to urge action, to promote tourism, and to tout local industries." *Id.* Secondly, the Court reasoned, Texas license plate designs were

often closely identified in the public mind with the State of Texas, including the facts that the state placed the name "TEXAS" in large letters at the top of every plate, that Texas vehicle owners are required by law to display license plates, and that all Texas license plates are issued by the State. *Id.* Texas license plates, the Court concluded, are "essentially, government IDs." *Id.* at 2249. Moreover, the private person or entity seeking a specialty plate, the Court reasoned, was likely to be intentionally playing on the suggestion that Texas had endorsed the message on the plate. *Id.* The Court in *Walker* also heavily emphasized the degree of direct control Texas maintained over the messages conveyed on its specialty plates, citing rules on design and the fact that the DMV "Board must approve every specialty plate design proposal before the design can appear on a Texas plate," an authority that had been actively exercised. *Id.*

In contrast, trademark registration, like copyright registration, has not historically been understood in our culture or our law as "government speech," or to use the parlance of *Walker*, as "government IDs." Trademark is a common law right that comes into existence through use by private parties. *See In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879). "The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan's goods from those of others." *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015). As the United States Patent and Trademark Office Trademark Trial and Appeal Board has observed, "[j]ust as the issuance of a trademark registration by this Office does not amount to a government endorsement of the quality of the goods to which the

mark is applied, the act of registration is not a government imprimatur or pronouncement that the mark is a 'good' one in an aesthetic, or any analogous, sense." *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1219-20 n.3 (T.T.A.B. 1993).

Trademark registration, like trademark itself, is the bestowal of certain legal benefits to private individuals and entities regarding the private expression of those individuals and entities. *B & B Hardware, Inc.*, 135 S. Ct. at 1300. It may be understandable that a license plate required by the government to be affixed to a vehicle, bearing the government's name and logo, and serving a government function regarding vehicle registration and law enforcement, is treated as a form of "government speech." The government manufactures plates and has an interest in limiting the number of variants that exist, lest their value as "government IDs" be diluted. No similar interest attaches to the millions of trademarks generated in the private sector. Indeed, the whole purpose of trademark law is to protect the association between the mark and the private business that uses it; the source of the speech is the source of the goods. That purpose would be upended if the mark were instead associated with the government as speaker.

To treat the registration of the millions and millions of private trademarks in the for-profit and non-profit sectors as the government speaking is therefore nonsensical. Such a view of the government speech doctrine would turn *any* viewpoint-based action by the government denying a benefit to a speaker, from refusal to recognize a student organization to denying a parade permit, into government speech. In the context of trademarks, the government would have carte blanche to use its

trademark registration power to pursue any policy on its agenda: it could deny registration to "Coke" and "Pepsi" to discourage soda consumption, to "Budweiser" to discourage drinking beer, or to "Camel" to discourage smoking. Call these actions "government subsidy," "government assistance," or "government speech," and the inconvenient First Amendment is out of the picture.

If the Patent and Trademark Office were to publish a press release criticizing The Slants for using their mark, *that* would be government speech. The denial of trademark registration, however, is not the "government speaking" in any plausible sense, but simply the government discriminating against private speech of which it disapproves.

III. DENIAL OF TRADEMARK REGISTRATION IS NOT A LIMITATION ON THE CONFERRAL OF A GOVERNMENT BENEFIT ESSENTIAL TO DEFINING THE CONTOURS OF A GOVERNMENT PROGRAM

The government is not free to attach unconstitutional conditions, such as the surrender of First Amendment rights, to the receipt of government benefits:

> For at least a quarter-century, this Court has made clear that even though a person has no "right" to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech.

> For if the government could deny a benefit to a person because of his constitutionally protected speech or associations, his exercise of those freedoms would in effect be penalized and inhibited.

Perry v. Sindermann, 408 U.S. 593, 597 (1972).

The unconstitutional conditions doctrine has often been applied to prevent the government from restricting free speech rights as an incident to bestowing government benefits. *See, e.g., Healy v. James*, 408 U.S. 169 (1972) (striking down a state university's refusal to grant official student group recognition to the Students for a Democratic Society based on the university's concerns over SDS positions regarding violent protest); *FCC v. League of Women Voters*, 468 U.S. 364 (1984) (striking down a restriction on public broadcasters barring broadcasters from editorializing as a condition of federal funding); *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819 (1995) (striking down a University of Virginia policy denying funding to student groups who used the funds for religious proselytizing); *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533 (2001) (striking down restrictions on the advocacy of legal services lawyers); *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321 (2013) (striking down a provision of a federal law requiring recipients of funds to adopt a policy stating that they oppose sex trafficking and prostitution).

An important theme of these cases is that it is no defense for the government to claim that speakers are not directly prevented from speaking. The students in the SDS chapter in *Healy* were allowed to express their views; they were just denied the benefits of recognition as a student group. Similarly, the

students in *Rosenberger* were not prevented from proselytizing, they were simply barred from participation in the University's funding program for student groups and publications if they engaged in such proselytizing.

It is thus no answer for the United States to maintain that The Slants remain free to register a non-disparaging mark while continuing to "use . . .a racial slur . . .[as] . . .suitable means of 'reappropriating' the slur." Pet'r Br. 33 (citation omitted). Notwithstanding all the efforts of the United States to minimize the import of trademark registration, such registration is of major import, substantial benefits flow from federal registration of the mark, and the unconstitutional conditions cases stand for the proposition that those benefits may not be denied on the basis of content or viewpoint. As this Court has recently observed:

> Registration is significant. The Lanham Act confers "important legal rights and benefits" on trademark owners who register their marks. . . . Registration, for instance, serves as "constructive notice of the registrant's claim of ownership" of the mark. It also is "prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate." And once a mark has been registered for five years, it can become "incontestable."

B & B Hardware, Inc., 135 S. Ct. at 1300 (internal citations omitted). In sum, the entire thrust of the

unconstitutional conditions doctrine is that government may not deny to citizens the legal protections for their expression that they would otherwise enjoy merely because the government disagrees with the message conveyed by that expression.

This Court has on a number of occasions permitted government restraints on discriminatory *conduct* as a condition placed on the receipt of federal benefits. Title IX prohibits university recipients of federal aid from discriminating on the basis of gender. *See Grove City Coll. v. Bell*, 465 U.S. 555 (1984). The Internal Revenue Service may deny tax exempt status to entities that discriminate on the basis of race. *See Bob Jones Univ. v. United States*, 461 U.S. 574 (1983). And a state law school may condition student group recognition on adherence to a nondiscrimination policy with regard to eligible members. *Christian Legal Soc'y Chapter of the Univ. of Cal. v. Martinez*, 561 U.S. 661 (2010). The Slants do not stand accused of discriminatory conduct, in the palpable sense illustrated by *Grove City*, *Bob Jones*, or *Martinez*. Rather, they are being penalized for the perceived offensiveness of the expression alone.

Moreover, even when policing discriminatory conduct, the Court has made clear that the First Amendment principles governing viewpoint discrimination still apply. In *Martinez*, for example, the Court emphasized that no viewpoint discrimination existed, noting that student groups remained free to "express any viewpoint they wish—including a discriminatory one." *Id.* at 696 n.26. The Court elaborated that the decision "thus continues this Court's tradition of 'protect[ing] the freedom to express "the thought that we hate." '" *Id.* (internal citations omitted).

Another exception to the unconstitutional conditions doctrine, somewhat less sharply defined, permits the government to direct its limited resources by placing restrictions on government spending programs as an incident to shaping the contours of those programs. This "shaping of spending" exception, however, remains substantially counterbalanced by the larger unconstitutional conditions doctrine. *See Alliance*, 133 S. Ct. at 2328. "At the same time, however, we have held that the government '"may not deny a benefit to a person on a basis that infringes his constitutionally protected . . . freedom of speech even if he has no entitlement to that benefit."'" *Id.* (quoting *Rumsfeld v. Forum for Acad. and Institutional Rights, Inc.*, 547 U.S. 47, 59 (2006)). This Court in *Alliance* harmonized its prior decisions in this arena by emphasizing the critical distinction between limits that define the contours of a program and limits that "seek to leverage funding to regulate speech outside the contours of the program itself." *Alliance*, 133 S. Ct. at 2328. To illustrate the difference, this Court contrasted its holding in *Rust v. Sullivan*, 500 U.S. 173 (1991), which upheld a restriction imposed on federal funding of reproductive services banning abortion counseling, and its holding in *Regan v. Taxation With Representation*, 461 U.S. 540 (1983), which upheld a federal law forbidding groups seeking nonprofit status from engaging in substantial efforts to influence legislation, with its holding in *League of Women Voters*, 468 U.S. at 364, which struck down limits on the editorializing of stations receiving public broadcasting. *Alliance*, 133 S. Ct. at 2328-2329.

This Court in *Alliance* acknowledged that "the distinction drawn in these cases—between conditions that define the federal program and those that reach

outside it—is not always self-evident." *Alliance*, 133 S. Ct. at 2330. That there are at times close and difficult cases, however, does not render the Lanham Act's disparaging marks provision a close or difficult case.

The government's attempt to cast Section 1052(a) as a permissible restriction that does not reach beyond the contours of the government program to regulate speech outside the program is disingenuous. Its proffered solution—that The Slants register a second, non-disparaging mark (which they do not desire to do) while simultaneously still identifying themselves with a "racial slur" — illustrates how deeply into protected speech the government's approach takes it. The government actually proposes that for the band to be permitted to vindicate its desire to mock societal disparagement of individuals of Asian ancestry it must recharacterize itself with a "non-disparaging" name. To create trademark rights in this second name, The Slants would need to use it as a source identifier that provides a prime method for advertising and selling their goods. 1 & 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §§ 3:2, 16:4 (4th ed. 2016). Closely identifying their band with a non-disparaging mark in this fashion will fundamentally dilute and vitiate the very message of reappropriation The Slants have sought to convey since 2006. This proposed solution of registering a different "non-disparaging" mark only reinforces how pervasively Section 1052(a) impermissibly regulates fully protected speech under the First Amendment. *See Alliance*, 133 S. Ct. at 2328.

Applying the unconstitutional conditions body of law, Section 1052(a) is plainly at odds with the First Amendment. Congress has not sought to impose any

limitation on discriminatory conduct. Nor is trademark registration a federal spending program, with Section 1052(a) functioning to define the limits of federal largess. An attempt to cast Section 1052(a) as a limit on a government spending program, much like the attempt to cast it as government speech, is mere wordplay. "Congress cannot recast a condition on funding as a mere definition of its program in every case, lest the First Amendment be reduced to a simple semantic exercise." *Velazquez*, 531 U.S. at 547. Rather, Section 1052(a) is a classic example of what the doctrine of unconstitutional conditions flatly forbids: using the leverage of the grant or denial of a government benefit to penalize viewpoints the government determines to be offensive.

IV. SECTION 1052(A) CANNOT BE SUSTAINED AS A VALID REGULATION OF COMMERCIAL SPEECH

The refusal of the Patent and Trademark Office to grant registration to disparaging marks is not a permissible form of regulation of "commercial speech." Commercial speech jurisprudence has long been anchored in the *Central Hudson* test:

> At the outset, we must determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading. Next, we ask whether the asserted governmental interest is substantial. If both inquiries yield positive answers, we must determine whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest.

Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n, 447 U.S. 557, 566 (1980). Because trademarks are themselves aspects of trade and commerce, a court might be tempted to assume that all regulation of trademarks is regulation of "commercial speech." Trademarks are, after all, commercial identifiers, the symbols and words by which companies distinguish and identify their brands.

It does not follow, however, that all government regulation of trademarks is properly reviewed under the *Central Hudson* standard. There is nothing *commercial* that triggers the Section 1052(a) ban on immoral, scandalous, disparaging, or contemptuous material. The statute thus carries embedded within it the concession that some trademarks function *both* as commercial identifiers and as expressions conveying political, artistic, cultural, or religious meanings—the very meanings that may render them immoral, scandalous, disparaging, or contemptuous. The regulation of *those offending aspects* of trademarks, including the disparagement restriction invoked to refuse registration of the mark The Slants sought, is the regulation of a political and social message, nothing more or less.

As the Fourth Circuit has recently noted, "[t]he Lanham Act and First Amendment may be in tension at times, but they are not in conflict so long as the Act hews faithfully to the purposes for which it was enacted." *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 321-22 (4th Cir. 2015). "The risk of impinging on protected speech is much greater when trademarks serve not to identify goods but rather to obstruct the conveyance of ideas, criticism, comparison, and social commentary." *Id.* at 322. Trademark law, in short, may not be co-opted to operate as a vehicle for the

speech police. To advance down this road would be dangerous business.

Trademark registration is often granted to groups that exist for associational and expressive purposes. *See* Jennifer E. Rothman, *Commercial Speech, Commercial Use, and the Intellectual Property Quagmire*, 101 Va. L. Rev, 1929, 1939 & n. 25 (2015) (noting the wide range of non-profit groups that have obtained trademark protection, including such provocative registrations as "Dykes on Bikes," Registration No. 3323803). Across the political and cultural spectrum, such trademarks are often intentionally provocative.

When commercial and noncommercial elements of a message are intertwined, the appropriate constitutional response is to ratchet up the level of constitutional protection, not ratchet down, treating the entirety of the message as protected by the First Amendment's demanding strict scrutiny standard. *Riley v. Nat'l Fed'n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988) ("But even assuming, without deciding, that such speech in the abstract is indeed merely 'commercial,' we do not believe that the speech retains its commercial character when it is inextricably intertwined with otherwise fully protected speech. . . . Thus, where . . . the component parts of a single speech are inextricably intertwined. . .we apply our test for fully protected expression.") (internal citations omitted); *see also Ass'n of Private Sector Colls. & Univs. v. Duncan*, 681 F.3d 427, 456 (D.C. Cir. 2012) ("Thus, when the government seeks to restrict inextricably intertwined commercial and noncommercial speech, courts must subject the restriction to the test 'for fully protected expression.'") (citation omitted); *In re Orthopedic Bone Screw Prods. Liab. Litig.*, 193 F.3d 781, 793 (3d

Cir. 1999) ("Where the commercial and noncommercial elements of speech are 'inextricably intertwined,' the court must apply the 'test for fully protected expression.'").

On this point, *amici* commend to this Court the dissenting opinion of Justice Breyer, joined by Justice O'Connor, from the dismissal of the writ of certiorari in *Nike, Inc. v. Kasky*, 539 U.S. 654 (2003), which involved the question of whether Nike's public statements on labor and employment conditions in third-world factories could be regulated as "commercial speech." Justice Breyer observed that the First Amendment "favors application of the . . . public-speech principle, rather than the . . . commercial-speech principle." *Nike*, 539 U.S. at 676 (Breyer, J., dissenting). He noted that "the communications at issue are not purely commercial in nature. They are better characterized as involving a mixture of commercial and noncommercial (public-issue-oriented) elements." *Id.* He then noted that even the least political of the statements at issue in the case involved commercial and noncommercial elements that were "inextricably intertwined." *Id.* at 677. After examining the form, content, and regulatory regime, Justice Breyer concluded that heightened scrutiny, not commercial speech intermediate scrutiny, should apply. *Id.* at 678-79.

The government should not be permitted to have it both ways, seeking to regulate only the non-commercial elements of communication, yet invoking the intermediate scrutiny standard designed to grant government greater latitude in the regulation of commercial expression.

Even the stripped-down elements of a trademark—its function as an identifier of a company's identity,

goods, or services—is far from invisible to the First Amendment. In *Sorrell v. IMS Health Inc.*, 564 S. Ct. 552 (2011), this Court considered "data mining" and "detailing," practices which assisted pharmaceutical manufacturers in promoting their drugs. The state of Vermont sought to limit this practice, through legislation providing that absent the prescriber's consent, prescriber-identifying information could not be sold by pharmacies and similar entities. There were certain limited exceptions, such as a carve-out for "health care research." *Id.* at 559. Vermont argued that Act 80 was not a regulation of speech, but a commercial restriction on trafficking in a "commodity." This Court roundly rejected the state's argument, holding that the law prohibited the sale of information subject to exceptions that were based in large part on the content of a purchaser's speech. *Id.* at 563-65. The Court in *Sorrell* observed that the creation of information, including commercial information, is protected by the First Amendment, even when that information is devoid of advocacy, and is simply a collection of "facts." *Id.* at 569-70.

In doing so, the Court in *Sorrell* suggested that that the information being disseminated by the data mining firms might well be entitled to the heightened scrutiny applicable to political speech, observing that "[w]hile the burdened speech results from an economic motive, so too does a great deal of vital expression." *Id.* at 567 (citing *Bigelow v. Virginia*, 421 U.S. 809, 818 (1975); *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 266 (1964); *United States v. United Foods, Inc.*, 533 U.S. 405, 410-11 (2001)). In fact, virtually all of the Court's discussion of the controlling First Amendment principles in *Sorrell* invoked the classic doctrines forbidding content-based and speaker-based discrimination, doctrines that form the backbone of

modern First Amendment doctrines protecting political speech. *Id.* ("Both on its face and in its practical operation, Vermont's law imposes a burden based on the content of speech and the identity of the speaker."). The Court's more recent ruling in *Reed v. Town of Gilbert*, goes still further in this direction, relying on *Sorrell*—a case involving commercial speech—frequently in a case involving non-commercial discourse. 135 S. Ct. 2218, 2227-28, 2235 (2015).

In the end, in *Sorrell* it did not matter whether the speech was reviewed as political or commercial speech, because the law was unconstitutional under either test. *Sorrell*, 564 U.S. at 571 ("As in previous cases, however, the outcome is the same whether a special commercial speech inquiry or a stricter form of judicial scrutiny is applied." (citing *Greater New Orleans Broad. Ass'n., Inc. v. United States*, 527 U.S. 173, 184 (1999))).

As in *Sorrell*, even if the rules governing regulation of commercial speech were applied, the refusal to register the mark The Slants sought remains unconstitutional. One of the most powerful themes of modern commercial speech law is that the government may not invoke, as its "substantial interest" justifying regulation, paternalistic manipulation of the marketplace of ideas. "Those who seek to censor or burden free expression often assert that disfavored speech has adverse effects. But the 'fear that people would make bad decisions if given truthful information' cannot justify content-based burdens on speech." *Id.* at 577 (quoting *Thompson v. W. States Med. Ctr.*, 535 U.S. 357, 374 (2002)). In *Carey v. Population Servs. Int'l*, the Court rejected the position that commercial speech regulation could be justified by the government's

interest in suppressing offensive expression, noting that it had "consistently held that the fact that protected speech may be offensive to some does not justify its suppression." 431 U.S. 678, 701 (1977). Elaborating, the Court made the very point being emphasized by *amici* here:

> Appellants suggest no distinction between commercial and noncommercial speech that would render these discredited arguments meritorious when offered to justify prohibitions on commercial speech. On the contrary, such arguments are clearly directed not at any commercial aspect of the prohibited advertising but at the ideas conveyed and form of expression the core of First Amendment values.

Id. at 701 n.28. Similarly, in *Bolger v. Youngs Drug Prods. Corp.*, the Court stated that "we have consistently held that the fact that protected speech may be offensive to some does not justify its suppression," adding that the Court had "specifically declined to recognize a distinction between commercial and noncommercial speech that would render this interest a sufficient justification for a prohibition of commercial speech." 463 U.S. 60, 71-72 (1983) (citation and internal quotation marks omitted). The government is disqualified from invoking the false cover of commercial speech regulation to do no more than penalize expression it finds offensive, for such a purpose is *per se* disqualified as the type of interest that may be invoked to justify regulation.

Finally, even if the paternalistic interest in policing trademarks deemed immoral, disparaging, scandalous, or contemptuous could qualify as a

substantial governmental interest, Section 1052(a) would still fail the *Central Hudson* test, for mere refusal to register the marks would not prevent them from still being used by their owners, thus accomplishing little, if any, of the government's paternalistic purpose. Refusal to register marks under Section 1052(a) would thus fail the requirement that the regulation at issue "directly and materially advance" the government's asserted interest. *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 555 (2001) (citation and internal quotation marks omitted).

This infirmity once again exposes the fundamental lack of alignment between the government's purpose and the commercial nature of trademarks. Policing the perceived racial disparagement that resides in the mark The Slants sought has nothing to do with the commercial nature of trademarks. *See City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 424 (1993) ("Not only does Cincinnati's categorical ban on commercial newsracks place too much importance on the distinction between commercial and noncommercial speech, but in this case, the distinction bears no relationship *whatsoever* to the particular interests that the city has asserted." (citing and quoting *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 120 (1991) (distinction drawn by Son of Sam law between income derived from criminal's descriptions of his crime and other sources "'has nothing to do with'" state's interest in transferring proceeds of crime from criminals to victims))).

CONCLUSION

For the reasons set forth, *amici* respectfully urge this Court to affirm the decision of the Court of Appeals.

Respectfully submitted,

RODNEY A. SMOLLA
4601 Concord Pike
Wilmington, DE 19803
(302) 477-2278
(302) 477-2282 (fax)
rodsmolla@gmail.com

FLOYD ABRAMS
Counsel of Record
FRIA KERMANI
KATHLEEN E. FARLEY
CAHILL GORDON
& REINDEL LLP
80 Pine Street
New York, NY 10005
(212) 701-3000
fabrams@cahill.com

Counsel for Amici Curiae Constitutional Law Professors

December 14, 2016

APPENDIX

LIST OF *AMICI CURIAE* CONSTITUTIONAL LAW PROFESSORS

(Affiliations provided for identification purposes only.)

1. Rodney Smolla is the Dean and Professor of Law at Widener University Delaware Law School.
2. Floyd Abrams has been a Lecturer in Law at the Yale and Columbia Law Schools.
3. Eric M. Freedman is the Siggi B. Wilzig Distinguished Professor of Constitutional Rights at the Maurice A. Deane School of Law at Hofstra University.
4. Alan E. Garfield is a Professor of Law at Widener University Delaware Law School.
5. James Gibson is a Professor of Law at the University of Richmond School of Law.
6. James R. May is a Distinguished Professor of Law at Widener University Delaware Law School.
7. Mary-Rose Papandrea is a Professor of Law at the University of North Carolina School of Law.
8. Suzanna Sherry is the Herman O. Loewenstein Professor of Law at Vanderbilt University Law School.
9. Nadine Strossen is the John Marshall Harlan II Professor of Law at New York Law School.

10. William Van Alstyne is the William R. and Thomas L. Perkins Professor Emeritus of Law at the Duke University School of Law and the Lee Professor Emeritus of Law at the Marshall-Wythe School of Law at the College of William and Mary.

11. Timothy Zick is the Mills E. Godwin, Jr. Professor of Law at Marshall-Wythe School of Law at the College of William and Mary.

RECORD AND BRIEFS

No. 15-1293

IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHAIO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

AMICUS BRIEF OF LAW PROFESSORS GREGORY DOLIN, TARA J. HELFMAN, IRINA D. MANTA AND KRISTEN JACOBSEN OSENGA IN SUPPORT OF RESPONDENT

GREGORY DOLIN
UNIVERSITY OF BALTIMORE SCHOOL OF LAW
1420 North Charles Street
Baltimore, MD 22101
(410) 837-4610

MATTHEW J. DOWD
Counsel of Record
DOWD PLLC
1717 Pennsylvania Ave, NW
Suite 1025
Washington, DC 20006
(202) 573-3853
mjdowd@dowdpllc.com

Counsel for Amicus Curiae

December 16, 2016

269918

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES iii

INTEREST OF AMICUS CURIAE 1

SUMMARY OF THE ARGUMENT 3

ARGUMENT 3

I. Any Ban On The Registration Of Offensive Marks Is Impermissible Viewpoint Discrimination 3

A. Third–Party Participation is Irrelevant for the Purposes of the Analysis 4

1. First Amendment law does not differentiate between the Government's suppression of speech and the Government's enforcement of the heckler's veto 5

2. Because of the nature of a trademark, the Government always has to evaluate the public's reaction, but the ultimate decision rests with the Government 9

B. The First Amendment Equally Prohibits Suppression of Speech and Disqualification for Government Favors 10

II. Invalidating § 2(a) Does Not Call Into Question Other Requirements Of The Lanham Act 14

A. No Other Sections of the Lanham Act Discriminate on the Basis of Viewpoint 14

B. Other § 2 Exclusions Survive Intermediate Scrutiny 18

III. Holding For The Petitioner Will Threaten The Rest Of The Intellectual Property Regime.....25

A. All the Arguments Against Trademark Registration Apply to Copyright Registration 25

B. Patents Will Also Be Threatened.....28

IV. Upholding § 2(a) Threatens Settled Property Rights.....33

CONCLUSION 35

TABLE OF AUTHORITIES

CASES **Page**

44 Liquormart, Inc. v. Rhode Island,
517 U.S. 484 (1996) 18, 19

Allen v. National Video, Inc.,
610 F. Supp. 612 (S.D.N.Y. 1985) 16

Arizona Free Enterprise Club's Freedom Club PAC v. Bennett,
564 U.S. 721 (2011) 13

Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.,
457 F.3d 1062 (9th Cir. 2006) 27

Bachellar v. Maryland,
397 U.S. 564 (1970) 6, 21

Bible Believers v. Wayne County, Michigan,
805 F.3d 228 (6th Cir. 2015) 5

Board of Supervisors for Louisiana State University of Agriculture & Mechanical College v. Smack Apparel Co.,
550 F.3d 465 (5th Cir. 2008) 16-17

Bolger v. Youngs Drug Products Corp.,
463 U.S. 60 (1983) 6

Bonito Boats, Inc. v. Thunder Craft Boats, Inc.,
489 U.S. 141 (1989) 29

Brewer v. Lichtenstein,
278 F. 512 (7th Cir. 1922) 31

Brown v. Entertainment Merchants Association,
564 U.S. 786 (2011) 30

Brownstein v. Lindsay,
742 F.3d 55 (3d Cir. 2014) 25

Carey v. Population Services International,
431 U.S. 678 (1977) 6

Central Hudson Gas & Electric Corp. v. Public Service Commission of New York,
447 U.S. 557 (1980) 18

Clinton E. Worden & Co. v. California Fig Syrup Co.,
187 U.S. 516 (1903) 33

Cohen v. California,
403 U.S. 15 (1971) 27

College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board,
527 U.S. 666 (1999) 34

Florida Bar v. Went For It, Inc.,
515 U.S. 618 (1995) 6, 18

Forsyth County, Georgia v. Nationalist Movement,
505 U.S. 123 (1992) 5, 10

Friedman v. Rogers,
440 U.S. 1 (1979) 24

General Adjustment Bureau, Inc. v. General Insurance Adjustment Co., 258 F. Supp. 535 (N.D. Okla. 1966) 19

Gertz v. Robert Welch, Inc., 418 U.S. 323 (1974) 8

Homemakers Home & Health Care Services, Inc. v. Chicago Home for Friendless, 484 F.2d 625 (7th Cir. 1973) 20

Hurley v. Irish–American Gay, Lesbian and Bisexual Group of Boston, Inc., 515 U.S. 557 (1995) 14

Hutchinson, Pierce & Co. v. Loewy, 217 U.S. 457 (1910) 33

In re International Flavors & Fragrances, Inc., 183 F.3d 1361 (Fed. Cir. 1999) 33

Ex parte Murphy, 200 U.S.P.Q. 801 (B.P.A.I. 1977) 31

In re Nalbandian, 661 F.2d 1214 (C.C.P.A. 1981) 30

Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844 (1982) 17

Juicy Whip, Inc. v. Orange Bang, Inc., 185 F.3d 1364 (Fed. Cir. 1999) 31

Kaiser Aetna v. United States, 444 U.S. 164 (1979) 34

Kaplan v. Helenhart Novelty Corp.,
182 F.2d 311 (2d Cir. 1950) 12

Kathreiner's Malzkaffee Fabriken Mit Beschraenkter Haftung v. Pastor Kneipp Med. Co.,
82 F. 321 (7th Cir. 1897) 16

National Automatic Device Co. v. Lloyd,
40 F. 89 (N.D. Ill. 1889) 31

National Endowment for the Arts v. Finley,
524 U.S. 569 (1998) 14

New Kids on the Block v. News America Publishing, Inc.,
971 F.2d 302 (9th Cir. 1992) 24

Old Dominion Branch No. 496, National Association of Letter Carriers, AFL-CIO v. Austin,
418 U.S. 264 (1974) 8

Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.,
469 U.S. 189 (1985) 15

Pleasant Grove City v. Summum,
555 U.S. 460 (2009) 22

Prestonettes, Inc. v. Coty,
264 U.S. 359 (1924) 24

Pro-Football, Inc. v. Blackhorse,
112 F. Supp. 3d 439 (E.D. Va. 2015) 33

R.A.V. v. City of St. Paul, Minnesota,
505 U.S. 377 (1992) 20

Roux Laboratories, Inc. v. Clairol, Inc.,
427 F.2d 823 (C.C.P.A. 1970) 9

San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee,
483 U.S. 522 (1987) 19

Satellite Broadcasting & Communications Association v. FCC,
275 F.3d 337 (4th Cir. 2001) 20

Schultze v. Holtz,
82 F. 448 (N.D. Cal. 1897) 31

Sentell v. New Orleans & Carrollton Railroad Co.,
166 U.S. 698 (1897) 31

Shelley v. Kraemer,
334 U.S. 1 (1948) 10

Silverman v. CBS Inc.,
870 F.2d 40 (2d Cir. 1989) 24

Simon & Schuster, Inc. v. Members of State Crime Victims Board,
502 U.S. 105 (1991) 7

Sinclair & Carroll Co. v. Interchemical Corp.,
325 U.S. 327 (1945) 32

Sorrell v. IMS Health Inc.,
564 U.S. 552 (2011) 18

Stanley v. Georgia,
394 U.S. 557 (1969) 30, 32

Texas v. Johnson,
491 U.S. 397 (1989) 5, 14

Turner Broadcasting System, Inc. v. FCC,
512 U.S. 622 (1994) 6, 20

Two Pesos, Inc. v. Taco Cabana, Inc.,
505 U.S. 763 (1992) 16

U.S. Healthcare, Inc. v. Blue Cross of Greater Philadelphia,
898 F.2d 914 (3d Cir. 1990) 24

United States v. Eichman,
496 U.S. 310 (1990) 5

United States v. Playboy Entertainment Group, Inc.,
529 U.S. 803 (2000) 30

Virgin Enterprises Ltd. v. Nawab,
335 F.3d 141 (2d Cir. 2003) 9

Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.,
425 U.S. 748 (1976) 19

Volkswagenwerk Aktiengesellschaft v. Wheeler,
814 F.2d 812 (1st Cir. 1987) 33-34

Walker v. Texas Division, Sons of Confederate Veterans, Inc.,
135 S. Ct. 2239 (2015) 22, 23

Wal-Mart Stores, Inc. v. Samara Brothers,
529 U.S. 205 (2000) 17

CONSTITUTIONS

U.S. Const. Amend. I ..... *passim*

U.S. Const., Art. I, § 8, cl. 8 ..... 2, 30

STATUTES

15 U.S.C. § 1052(a) (§ 2(a), 60 Stat. 428) ..... *passim*

15 U.S.C. § 1052(b) 15

15 U.S.C. § 1052(c) 15

15 U.S.C. § 1052(d) 15

15 U.S.C. § 1052(e) 15

15 U.S.C. § 1052(f) 17

15 U.S.C. § 1057(b) 11

15 U.S.C. § 1065 11

15 U.S.C. § 1068 7

15 U.S.C. § 1072 11

15 U.S.C. § 1117 11

15 U.S.C. § 1117(a) 12

15 U.S.C. § 1121 11

15 U.S.C. § 1124 ..... 11, 12

17 U.S.C. § 502 26

17 U.S.C. § 503 26

17 U.S.C. § 504 26

17 U.S.C. § 505 26

17 U.S.C. § 602 26

35 U.S.C. § 3 7

35 U.S.C. § 101 28-29

35 U.S.C. § 171 29

RULES AND REGULATIONS

19 C.F.R. § 133.1(a) 12

OTHER SOURCES

Andrew Beckerman–Rodau, *Design Patent Evolution: From Obscurity to Center Stage*, 32 Santa Clara High Technology Law Journal 53 (2016) 29

Ann Bartow, *Pornography, Coercion, and Copyright Law 2.0*, 10 Vanderbilt Journal of Entertainment & Technology Law 799 (2008) 31

Barry P. McDonald, *Government Regulation or Other "Abridgements" of Scientific Research: The Proper Scope of Judicial Review Under the First Amendment*, 54 Emory Law Journal 979 (2005) 31

David A. J. Richards, *Free Speech and the Politics of Identity* (1999). 22

Douglas B. Holt, *How Brands Become Icons: The Principles of Cultural Branding* (2004) 27

Judy Scales–Trent, *On Being Like a Mule, in The Social Construction of Race and*

Identity in the United States (Joan Ferrante & Prince Brown, Jr. eds., 1998). 4

Lee Ann W. Lockridge, *Abolishing State Trademark Registrations*, 29 Cardozo Arts & Entertainment Law Journal 597 (2011). 11

Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 Trademark Reporter 797 (2016) 13

Mark Tracy, *The Most Offensive Team Names in Sports: A Definitive Ranking*, Slate.com (Oct. 9, 2013) 21-22

Michael Klein, *Chink's Steaks Changing Its Name*, Philly.com (Mar. 28, 2013), http://www.philly.com/philly/food/Chinks–Steaks–changing–its–name.html 21

Model State Trademark Act § 1(c) (2007) 13

Offensive Racial Images Used for Marketing, The Root, Feb. 20, 2014, http://www.theroot.com/articles/culture/2014/02/seriously_racist_products/ 22

Press Release, National Collegiate Athletic Association, *NCAA Executive Committee Issues Guidelines for Use of Native American Mascots at Championship Events* (Aug. 5, 2005) 21

Ralph D. Clifford & Richard J. Peltz–Steele, *The Constitutionality of Design Patents*, 14 Chicago–Kent Journal of Intellectual Property 553 (2015) 30

Restatement (Third) of Unfair Competition (1995) 11, 13

Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 Trademark Reporter 661 (1993) 12-13

U.S. Patent and Trademark Office, *Manual of Patent Examining Procedure* (Nov. 2015), https://www.uspto.gov/web/offices/pac/mpep/ 29

U.S. Patent and Trademark Office, *Trademark Manual of Examining Procedure* (Oct. 2016), https://mpep.uspto.gov/RDMS/TMEP/current 4, 9, 10

William McGeveran & Mark P. McKenna, *Confusion Isn't Everything*, 89 Notre Dame Law Review 253 (2013) 25

INTEREST OF *AMICI CURIAE*[1]

Amici curiae Professor Gregory Dolin (University of Baltimore School of Law), Professor Tara J. Helfman (Syracuse University College of Law), Professor Irina D. Manta (Maurice A. Deane School of Law at Hofstra University), and Professor Kristen Jacobsen Osenga (University of Richmond School of Law) are scholars and teachers of intellectual property law and constitutional law.

Amici have no direct stake in the outcome of the present litigation. *Amici* submit this brief in support of the reasoning and decision of the Court of Appeals for the Federal Circuit. *Amici* also highlight likely detrimental consequences on the U.S. intellectual property system as a whole if the Government's and certain *amici*'s arguments concerning § 2(a) of the Lanham Act are accepted.

SUMMARY OF THE ARGUMENT

The United States Constitution protects the citizenry's ability to speak even in a crude, derogatory, and demeaning manner without being penalized by the Government. The Constitution does not permit the Government to suppress or disadvantage offensive commercial speech any more than it does offensive non–commercial speech.

---

[1] Petitioner has filed its consent to the filing of amicus curiae briefs in support of either party or of neither party on November 14, 2016. Respondent filed its blanket consent September 30, 2016. Amici and their counsel represent that no party to this case nor their counsel authored this brief in whole or in part, and that no person other than amici paid for or made a monetary contribution toward the preparation and submission of this brief.

Section 2(a) of the Lanham Act violates and cannot co–exist with these simple principles.

The trademark system is designed to allow a merchant to secure the goodwill of his business by identifying his wares. But trademarks also allow merchants and consumers to construct their identities based on the goods bought and sold, markets targeted, and logos displayed. The non–disparagement provisions of § 2(a) significantly limit the ability of merchants and consumers to engage in this expressive conduct.

Reversal of the decision below would effectively transform the United States Patent and Trademark Office from an agency whose purpose is to "promote the Progress of Science and useful Arts," U.S. Const., Art. I, § 8, cl. 8, into a panel of moral censors tasked with purging putatively "offensive" speech from the marketplace of ideas. This represents constitutionally impermissible overreach by the political branches into the spheres of political and economic liberty. Section 2(a) of the Lanham Act unconstitutionally confers upon the PTO the power to suppress speech that it deems offensive by denying it trademark protection. Not only does this contravene established First Amendment doctrine, but it also compromises the very foundations of intellectual property law. The Government may not prohibit speech, be it commercial or non–commercial, on the ground that some listeners may find it offensive. Doing so would create a heckler's veto on property rights by leaving trademark applicants without any means under the law to protect their exclusive legal interest in their own ideas. Adopting Petitioner's argument will have a destructive ripple

effect into all areas of intellectual property law and adverse consequences on long established and valuable property rights.

ARGUMENT

I. Any Ban On The Registration Of Offensive Marks Is Impermissible Viewpoint Discrimination

The provisions of § 2(a) of the Lanham Act, 15 U.S.C. 1052(a), unconstitutionally discriminate against speech based on the viewpoint of the speaker. On its face, § 2(a) discriminates against certain speech not only because of the topic discussed, but because of the messaged conveyed. At bottom, the statute permits the Government to accord benefits to speech on a variety of controversial topics such as race, gender, sexuality, and the like based on whether the speaker expresses a popular and "acceptable" viewpoint on the topic, or unpopular and disfavored viewpoints. Trademark registration is not denied to applicants who seek to identify their goods with particular race, gender, or ethnicity, but is denied if such an identification raises the ire of some portion of the populace. Thus, marks such as such as *Yid Dish*,[2] *Dykes on Bikes*,[3] *The Guidos of*

---

[2] Registration No. 4131892 (registered April 24, 2012) (for "newsletters featuring news and feature articles concerning dating, relationships").

[3] Registration No. 3323803 (registered Oct. 30, 2007) (for "[e]ducation and [e]ntertainment [s]ervices in the nature of organizing, conducting, and promoting . . . parties and rallies to support, organize and motivate women motorcyclists . . . .").

Comedy,[4] and *Mulata*[5] have been registered and enjoy the benefits of such registration, while SLANTS and REDSKINS (among other marks), *see* Pet. App. 23a, have been denied registration and its benefits.

A. Third–Party Participation is Irrelevant for the Purposes of the Analysis

Under the statute, the Patent and Trademark Office ("PTO") will deny registration to a mark if the mark is disparaging. In analyzing whether this prohibition is triggered, the PTO determines whether the proposed mark "refer[s] to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group." PTO, *Trademark Manual of Examining Procedure* (*"TMEP"*) § 1203.03(b)(i) (Oct. 2016), https://mpep.uspto.gov/RDMS/TMEP/current. This reliance on third–party views of the mark is seen as a matter of constitutional significance by the Government and by some *amici*. *See* Brief of Law Professors at 9–12 (hereinafter "Tushnet Brief").

---

[4] Registration No. 4508998 (registered April 8, 2014) (for "[e]ntertainment services in the nature of comedy shows").

[5] Registration No. 5048032 (registered Sept. 27, 2016) (for "[e]ntertainment services in the nature of comedy shows"). The registration explains that the "English translation of 'Mulata' in the mark is 'Mulatto Woman.'" *Id.* "Mulatto," especially given its etymology (from Spanish and Portuguese for "mule") is often considered pejorative. *See* Judy Scales-Trent, *On Being Like a Mule, in The Social Construction of Race and Identity in the United States* 287 (Joan Ferrante & Prince Brown, Jr. eds., 1998).

Under either First Amendment or Trademark law, however, the distinction between the Government's disapproval of speech and the Government's enforcement of a third party's disapproval of speech is irrelevant.

1. First Amendment law does not differentiate between the Government's suppression of speech and the Government's enforcement of the heckler's veto

This Court has held, time and again, that the First Amendment does not permit the Government to ban speech because a listener might find it offensive. *See Bible Believers v. Wayne County, Mich.*, 805 F.3d 228, 248 (6th Cir. 2015) (en banc), *cert. denied*, 136 S. Ct. 2013 (2016) ("A review of Supreme Court precedent firmly establishes that the First Amendment does not countenance a heckler's veto."). "'If there is a bedrock principle underlying the First Amendment, it is that the Government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.'" *United States v. Eichman*, 496 U.S. 310, 319 (1990) (quoting *Texas v. Johnson*, 491 U.S. 397, 414 (1989)).

This Court has been clear that the Government is not permitted to privilege the feelings or viewpoints of one group over the viewpoints of another group. *See Forsyth County, Ga. v. Nationalist Movement*, 505 U.S. 123, 134 (1992). "[I]t is firmly settled that under our Constitution the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to

some of their hearers, or simply because bystanders object . . . ." *Bachellar v. Maryland*, 397 U.S. 564, 567 (1970). That the Government itself may have no objection to the speech is not relevant. What is relevant is whether the Government uses its considerable power to suppress speech because some portion of the populace finds that particular expression offensive. Simply put, "offensiveness was 'classically not [a] justificatio[n] validating the suppression of expression protected by the First Amendment. At least where obscenity is not involved, . . . the fact that protected speech may be offensive to some does not justify its suppression.'" *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 72 (1983) (quoting *Carey v. Population Services International*, 431 U.S. 678, 701 (1977)). On this issue, the Court has never differentiated between commercial and non–commercial speech. *Id.*

Contrary to the assertion of some *amici*, the fact that the mark's perception may change with the times—and thus its offensiveness or lack thereof is not static—makes the prohibitions contained within § 2(a) more, not less, constitutionally suspect. The ever–shifting perception of offensiveness and the ever–changing cohort of people who may find something offensive can serve as a perfect cover to government officials intent on ridding the market of words, phrases, or images of which it disapproves. *See Fla. Bar v. Went For It, Inc.*, 515 U.S. 618, 639 (1995) ("[T]he State is doing nothing more . . . than manipulating the public's opinion by suppressing speech . . . ."); *Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622, 641 (1994) ("Laws of this sort pose the inherent risk that the Government seeks not to

advance a legitimate regulatory goal, but to suppress unpopular ideas or information or manipulate the public debate through coercion rather than persuasion. These restrictions 'rais[e] the specter that the Government may effectively drive certain ideas or viewpoints from the marketplace.'" (quoting *Simon & Schuster, Inc. v. Members of State Crime Victims Bd.*, 502 U.S. 105, 116 (1991))). The decision to refuse to register or cancel a registered mark that, in the Government's opinion, is or has become "disparaging" will always be shaped by the prevailing political winds rather than by some "'neutral' assessment of a non–government perspective–in this case, a 'substantial composite of the referenced group,'" Pet. App. 99a (Dyk, J., concurring and dissenting), even if such "neutral assessment" were possible. The ultimate decision whether to cancel a trademark's registration rests with the Director of the Patent and Trademark Office. 15 U.S.C. § 1068. The Director, of course, is a political appointee, appointed by and serving at the pleasure of the President. 35 U.S.C. § 3. One need not be a conspiracy theorist to surmise that the Director might be more likely to uphold disparagement claims that are made by groups with which a given Administration is trying to curry favor. In the final analysis, then, the decision to refuse to register or cancel a mark is entirely political and based on what type of speech the Government wishes to suppress at present.

The Government's power to regulate speech depending on prevailing political winds illustrates why § 2(a) is, contrary to the claims of some of the *amici*, inapposite to restrictions on defamatory

speech. *See* Tushnet Br. 8–12. Defamatory speech remains defamatory irrespective of time or place, because the *sine qua non* of defamation is the falsity of the statement. *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 370 (1974) (White, J. dissenting) ("Under typical state defamation law, the defamed private citizen had to prove only a false publication that would subject him to hatred, contempt, or ridicule."); *Old Dominion Branch No. 496, Nat. Ass'n of Letter Carriers, AFL–CIO v. Austin*, 418 U.S. 264, 283 (1974) ("The *sine qua non* of recovery for defamation . . . is the existence of falsehood. . . . [T]here must be a false statement of fact."). The truth or falsity of a fact, of course does not vary depending on prevailing societal attitudes. A falsehood uttered or printed today will not become true with passage of time; nor will a true statement lose its veracity when read by subsequent generations. And while it is possible that false statements may have different reputational effects depending on prevailing societal norms, the evolution of societal views only affects the compensation due to the victim of false statements. It is the falsity of the statement rather that the evolution of societal views that serves as a constitutional basis for prohibiting such speech in the first place. *See Gertz*, 418 U.S. at 340 ("[T]here is no constitutional value in false statements of fact. Neither the intentional lie nor the careless error materially advances society's interest in uninhibited, robust, and wide–open debate on public issues. They belong to that category of utterances which are no essential part of any exposition of ideas, and are of such slight social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and

morality.") (internal citations and quotations omitted)).

2. Because of the nature of a trademark, the Government must always evaluate the public's reaction, but the ultimate decision rests with the Government

A trademark by its very nature is a device meant to impart information to the public regarding the source of goods. "The purpose for which the trademark law accords merchants the exclusive right to the use of a name or symbol in their area or commerce is *identification*, so that . . . the consuming public can rely on a mark as a guarantee that the goods or services so marked come from the merchant who has been found to be satisfactory in the past." *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 147 (2d Cir. 2003) (emphasis in original). Necessarily then, in order to evaluate any application for registering a mark, the PTO has to view the application from the perspective of the consuming public. *See* TMEP § 1202.04 ("The critical inquiry in determining whether a slogan or term functions as a trademark or service mark is how the proposed mark would be perceived by the relevant public."); *Roux Labs., Inc. v. Clairol, Inc.*, 427 F.2d 823, 825 (C.C.P.A. 1970) ("A principal way of determining whether a particular expression is 'merely descriptive' [and therefore not registerable as a trademark] as applied to the goods is to ascertain the reaction of those to whom it is directed—the consumers."). It is therefore unsurprising that the Government looks at a trademark application through the eyes of a third party; doing anything else is simply impossible if the

identification purposes of the Lanham Act are to be preserved.

While the Government has to assume the perspective of private parties in order to determine "whether a slogan or term functions as a trademark," TMEP § 1202.04, the Government is not thereby transformed into a private party unbound by First Amendment constraints. When the Government assumes the power to enforce private viewpoints, its ability to act is circumscribed by the Constitution. *Cf. Shelley v. Kraemer*, 334 U.S. 1 (1948). The government cannot discriminate against trademarks it finds "disparaging" by claiming to be a mere ventriloquist for private parties.

B. The First Amendment Equally Prohibits Outright Suppression of Speech and Disqualification for Government Favors

It is true that denial of trademark registration does not in and of itself ban the applicant from using his chosen device to mark his goods. However, "[s]peech cannot be financially burdened, any more than it can be punished or banned, simply because it might offend a hostile mob." *Forsyth County*, 505 U.S. at 134–35. Without question, denial of trademark registration places financial burdens on the holder of the mark. Trademark registration is not a mere cataloguing of the trademarks currently in existence. An owner of a registered trademark possesses a much more valuable commodity than an owner of an unregistered one.

Registering a mark provides a number of benefits to the registrant. Such benefits include: 1) serving

as a constructive nationwide notice of ownership, 15 U.S.C. § 1072; 2) providing *prima facie* evidence of validity and a right to exclusive nationwide use of the mark, *id.* § 1057(b); 3) guaranteeing federal court jurisdiction for trademark infringement without an amount in controversy or diversity requirement, *id.* § 1121; 4) making the mark eligible for treble damages and attorney's fees in an infringement suit, *id.* § 1117; 5) securing incontestability of the mark after five years of registration, *id.* § 1065; and 6) empowering the owner to prevent importation of counterfeit goods bearing the mark into the United States, *id.* § 1124.

By contrast, the owner of an unregistered trademark has much higher barriers to enforcing his mark. First, in any litigation he bears the burden of proof that he has acquired and continues to hold valid trademark rights. In satisfying the burden, an owner of unregistered trademark cannot simply point to the fact of registration, but must show "dates of first use of the mark, and perhaps the manner and frequency of use of the mark; which persons or entities use the mark (if the mark is used by licensees or other related entities); inherent or acquired distinctiveness of the mark; and other facts relevant to validity and ownership." Lee Ann W. Lockridge, *Abolishing State Trademark Registrations*, 29 Cardozo Arts & Ent. L.J. 597, 601 (2011). Second, the owner of such a mark must prove the geographic reach of his rights, which may not be national in scope. *See id.*; *Restatement (Third) of Unfair Competition* § 19 (1995). The owner may not be eligible to present his proof in federal court, because an owner of an unregistered

trademark would be subject to the diversity and the amount in controversy requirements. *Kaplan v. Helenhart Novelty Corp.*, 182 F.2d 311, 312 (2d Cir. 1950). Even if the owner of an unregistered trademark could invoke the jurisdiction of federal courts and prove ownership, geographic reach, and infringement, he still would not be able to avail himself of the same remedies that an owner of the registered mark would. For example, an owner of a registered mark is able to collect treble damages from an adjudged infringer, whereas an owner of an unregistered mark is only able to do so if he proves that the infringement was willful. *See* 15 U.S.C. § 1117(a). Nor can the owner of an unregistered trademark easily exclude counterfeit goods from the United States. While the statute does grant the U.S. Customs and Border Protection authority to exclude goods infringing both registered and unregistered marks, *see id.* § 1124, Customs limits its enforcement only to registered marks, *see* 19 C.F.R. § 133.1(a) (extending eligibility for enforcement only to "[t]rademarks registered by the U.S. Patent and Trademark Office").

More fundamentally, it is not even certain that an applicant to whom federal registration was denied on the grounds of "disparagement" can maintain any common law rights in his unregistered mark. "It is conceivable that a court, applying broad equitable principles, might refuse to protect a trademark that it believes is scandalous, immoral, or disparaging by holding that such marks are inherently unprotectible [*sic*] because their use contravenes public policy." Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of*

Scandalous and Immoral Trademarks, 83 Trademark Rep. 661, 676 (1993). As the Federal Circuit pointed out, "[t]he government has not pointed to a single case where the common law holder of a disparaging mark was able to enforce that mark, nor could we find one. The government's suggestion that [the applicant] has common law rights to his mark appears illusionary." Pet. App. 38a–39a. In fact, the unavailability of common law protection to marks denied registration under the disparagement provision seems to be the consensus view. *See Restatement (Third) of Unfair Competition* § 32 (1995) ("If a designation used as a trademark . . . is deceptive, or if its use is otherwise in violation of public policy . . . the owner may be barred in whole or in part from the relief that would otherwise be available . . . ."); *Model State Trademark Act* § 1(c) (2007) ("The term 'mark' as used herein includes any trademark or service mark, entitled to registration under this Act whether registered or not.") Indeed, *amici* signatories to the Tushnet Brief recognize as much. *See* Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 Trademark Rep. 797, 862–64 (2016).

In short, denial of registration, while not an outright prohibition on speech, is a sufficient disincentive that is likely to cause the trademark owner to forego speech that meets with Government's opprobrium. The only way a trademark holder can avoid losing the ability to protect his property and goodwill is by "chang[ing his] message . . . or refrain[ing] from speaking altogether . . . ." *Arizona Free Enter. Club's Freedom Club PAC v. Bennett*, 564 U.S. 721, 739 (2011).

However, "forcing that choice– . . . change your message, or do not speak–certainly contravenes 'the fundamental rule of protection under the First Amendment, that a speaker has the autonomy to choose the content of his own message.'" *Id.* (quoting *Hurley v. Irish–American Gay, Lesbian and Bisexual Group of Boston, Inc.*, 515 U.S. 557, 573 (1995)). In essence, the principle "that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable," *Johnson*, 491 U.S. at 414, "applies not only to affirmative suppression of speech, but also to disqualification for government favors," and therefore "Congress is generally not permitted to pivot discrimination against otherwise protected speech on the offensiveness or unacceptability of the views it expresses," *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 601 (1998) (Souter, J., dissenting).

II. Invalidating § 2(a) Does Not Call Into Question Other Requirements Of The Lanham Act

In support of the Petitioner's position, the Tushnet Brief contends that affirming the judgment below would call into question the entirety of Lanham Act, because all requirements for trademark registration are content–based restrictions. These concerns are overwrought and should not preclude this Court's affirmance.

A. No Other Sections of the Lanham Act Discriminate on the Basis of Viewpoint

The Lanham Act imposes several limitations on the applicant's ability to register his trademark.

Specifically, in addition to the "disparagement" bar, the Act denies registration to marks that comprise of 1) "immoral, deceptive, or scandalous matter," 15 U.S.C. § 1052(a); 2) geographical indications inconsistent with the WTO Agreement, *id.*; 3) flags, coat of arms, and other symbols of a political entity, *id.* § 1052(b); 4) "name, portrait, or signature identifying a particular living individual except by his written consent," *id.* § 1052(c); as well as marks that are either 5) sufficiently similar as to be confusing to a previously used mark, *id.* § 1052(d); or 6) are merely descriptive, *id.* § 1052(e). None of these restrictions save for ones on "disparaging," "immoral" or "scandalous" matters are problematic from the First Amendment point of view.

Unlike the prohibitions on "disparaging," "immoral" or "scandalous" matter which target the applicant's viewpoint, *see* Part I, *ante*, the remaining restrictions are viewpoint neutral. A trademark applicant will be denied registration for a mark containing the American flag irrespective of whether that flag is proudly fluttering in the wind or is micturated upon. Similarly, an application for a merely descriptive mark will be refused irrespective of whether the description is laudatory or derogatory.

Furthermore, these restrictions, unlike the prohibitions on "disparaging," "immoral," or "scandalous" matter serve the very purpose of trademark law. The purpose of trademark law is to allow a merchant to identify for the public the source of goods and to capture the goodwill that accrues to him as a result of his efforts. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) ("The Lanham Act provides national protection of

trademarks in order to secure to the owner of the mark the goodwill of his business . . . ."). Allowing someone to use a flag or similar symbol, or to improperly describe geographical origin of goods, or to affix someone else's name or portrait to the goods would result in the merchant capturing not his own goodwill, but the goodwill of the jurisdiction whose flag is used, or of the person whose likeness graces the mark, or of the region misidentified on the label. In other words, these symbols would not serve as trademarks because they would not identify for consumers the true source of the goods. *See Kathreiner's Malzkaffee Fabriken Mit Beschraenkter Haftung v. Pastor Kneipp Med. Co.*, 82 F. 321, 325 (7th Cir. 1897) (holding that where "the name, the portrait, and the facsimile signature of [another are] employed," it can be concluded that the merchant is appropriating "the good will of a trade which belonged to another," and the public is deceived "into the belief that [the] goods were . . . prepared with the knowledge and under the sanction" of the pictured individual); *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 628–29 (S.D.N.Y. 1985) (explaining that evocation of another's persona may cause the public to believe that the referenced person "is somehow involved in or approves of their product").

Similarly, "[m]arks which are merely descriptive of a product . . . do not inherently identify a particular source, and hence cannot be protected." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992). A merely descriptive mark simply does not work as a mark "because it does not inherently identify a particular source of the product." *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll.*

v. Smack Apparel Co., 550 F.3d 465, 475 (5th Cir. 2008). However, if "in the minds of the public, the primary significance of [an otherwise descriptive mark] is to identify the source of the product rather than the product itself," *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 211 (2000) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851, n.11 (1982)), it may be able to serve the proper function of a trademark and be eligible for registration, *see* 15 U.S.C. § 1052(f).

In contrast, a "disparaging" mark can serve as an identifier of the source of goods. By choosing the name "The Slants," Respondent does not seek to capture the goodwill (or for that matter ill-will) towards a particular geographic region, another musician, or someone else's goods. Similarly, by choosing the name Redskins, the Washington football club is not leading consumers to believe that the product comes from anywhere other than the football club. In fact, in suggesting that Mr. Tam would retain common law rights to his trademark under § 43(a) (whatever the merits of that argument may be, *see* Part I.B, *ante*), Petitioner recognizes the "disparaging" marks work as a mark. Thus, the prohibitions on "disparaging," "immoral" or "scandalous" serve an entirely different function and have an entirely different result than other prohibitions in § 2.

Fundamentally, prohibitions on "disparaging," "immoral" or "scandalous" matter are different in kind than the other exclusions contained in § 2 of the Lanham Act, and therefore the Court need not be concerned that affirming the judgement below will undermine the trademark regime.

B. Other § 2 Exclusions Survive Intermediate Scrutiny

Even if this Court were to view other exclusions of § 2 with the same skepticism as the prohibitions on "disparaging," "immoral" or "scandalous" matter, only the former but not the latter would survive intermediate scrutiny applicable to the restrictions on commercial speech. *See Fla. Bar*, 515 U.S. at 623.

Under the intermediate scrutiny standard, "government laws and regulations may significantly restrict speech, as long as they also 'directly advance' a 'substantial' government interest that could not 'be served as well by a more limited restriction.'" *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 583 (2011) (quoting *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 564 (1980)). When the Government "regulates commercial messages to protect consumers from misleading, deceptive, or aggressive sales practices, or requires the disclosure of beneficial consumer information, the purpose of its regulation is consistent with the reasons for according constitutional protection to commercial speech," *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 501 (1996), and the regulation survives intermediate scrutiny. *Sorrell*, 564 U.S. at 583. As discussed in Part II.A, *ante*, the prohibitions on the use of flags, portraits of living individuals, improper geographic designations, and marks likely to cause confusion in the eyes of the consuming public exist precisely in order to "protect consumers from misleading [and] deceptive . . . sales practices." *44 Liquormart*, 517 U.S. at 501. Similarly, the requirement that goods not be geographically misidentified is simply a "disclosure of beneficial

consumer information," *id.*, which allows a consumer to know that a bottle of Cognac comes from France, while Vidalia onions are from the state of Georgia, and Darjeeling tea is from India.

The prohibition on registering a merely descriptive mark also satisfies intermediate scrutiny. A merely descriptive mark is "not indicative of particular goods or services, but of their nature." *Gen. Adjustment Bureau, Inc. v. Gen. Ins. Adjustment Co.*, 258 F. Supp. 535, 538 (N.D. Okla. 1966), *aff'd*, 381 F.2d 991 (10th Cir. 1967). "To permit exclusive appropriation of such terms would be to permit monopolization of a common term and would constitute an infringement upon common speech." *Id.* Absent the ability of everyone to use common descriptive terms to describe their wares, "fair and open competition might be impaired, the available vocabulary of descriptive words would be reduced, advertisers could not freely describe their products, and the public might be deprived of information necessary to make purchase decisions." *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 565 n.27 (1987) (internal quotations omitted).

The restrictions on registering merely descriptive words can therefore be justified on two grounds. First, by maintaining that exclusion, the public is provided with "beneficial consumer information" which is "necessary to make purchase decisions" — an entirely permissible way to regulate commercial speech. *See 44 Liquormart*, 517 U.S. at 501; *cf. Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 757 (1976) (holding that there is a First Amendment "right to receive . . .

advertising."). Second, by denying monopoly rights to common words, the Government safeguards the remaining public against "substantial infringement upon common speech." *Homemakers Home & Health Care Servs., Inc. v. Chicago Home for Friendless*, 484 F.2d 625, 628 (7th Cir. 1973). Preservation of a multiplicity of voices in the market place is an important government interest under the intermediate scrutiny analysis applicable to commercial speech. *See, e.g., Turner Broad. Sys.*, 520 U.S. at 213; *Satellite Broad. & Commc'ns Ass'n v. FCC*, 275 F.3d 337, 364–65 (4th Cir. 2001).

In contrast, restrictions on "disparaging," "immoral," or "scandalous" matter cannot be justified on any constitutional grounds. Three potential justifications are advanced by the Petitioner and the Tushnet Brief: 1) reducing "the likelihood that 'underrepresented groups in our society' will be 'bombarded with demeaning messages in commercial advertising,'" Pet. Br. 48; 2) disassociation from hateful messages, Pet. Br. 37–41; and 3) protecting the ability of others to speak more freely, Tushnet Br. 13–15. None of these justifications are consistent with this Court's jurisprudence.

Reduction in "the likelihood that 'underrepresented groups in our society' will be 'bombarded with demeaning messages in commercial advertising'" while laudable, cannot be achieved by restrictions on commercial speech. This Court explicitly held that "a State may not prohibit only that commercial advertising that depicts [certain groups] in a demeaning fashion." *R.A.V. v. City of St. Paul, Minn.*, 505 U.S. 377, 389 (1992). "[I]t is firmly settled that under our Constitution the public

expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers, or simply because bystanders object to peaceful and orderly demonstrations." *Bachellar*, 397 U.S. at 567.

Nor is this protection even necessary as the free market is able to police the truly disparaging marks and force the owners to change. For example, an iconic Philadelphia cheesesteak shop chose to change its name from Chink's Steaks to Joe's Steaks + Soda Shop after it was "chastised by Asian Americans in a series of Philadelphia Daily News articles, and in 2008, [seeing] the Philadelphia Bar Association t[ake] the unusual step of issuing a resolution critical of the name." Michael Klein, *Chink's Steaks Changing Its Name*, Philly.com (Mar. 28, 2013), http://www.philly.com/philly/food/Chinks-Steaks-changing-its-name.html. FAGS candy cigarettes changed its name to FADS because the former terms (though still used as a slang for "cigarette butts" in a number of Commonwealth countries) became associated with a pejorative term for gay men. https://en.wikipedia.org/wiki/FADS_Fun_Sticks.

Other examples abound. The NCAA, a private entity, banned (with some exceptions) name and mascots associated with Native Americans. Press Release, Nat'l Collegiate Athletic Ass'n, *NCAA Executive Committee Issues Guidelines for Use of Native American Mascots at Championship Events* (Aug. 5, 2005). In 1962, concomitant with their move to California the then Philadelphia Warriors abandoned their logo which consisted of a caricature of a Native American. Mark Tracy, *The Most Offensive Team Names in Sports: A Definitive*

Ranking, Slate.com (Oct. 9, 2013). In 1971, as a result of public pressure, Fritos abandoned the use of Frito Bandito. https://en.wikipedia.org/wiki/Frito_Bandito. In 1955, in a state not then–known for its liberal views on race, the Aughinbaugh Canning Co. of Mississippi renamed its "Nigger Head Brand" oysters to "Negro Head Brand" after repeated pressure from the NAACP. *Offensive Racial Images Used for Marketing*, The Root, Feb. 20, 2014, http://www.theroot.com/articles/culture/2014/02/seriously_racist_products/. If the public perceives The Slants to be an offensive term, Mr. Tam will bear the consequences of lower tickets sales and fewer performances booked.[6]

Petitioner's analogy to *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015), is inapt. True, the Government can, consistent with the First Amendment, decline to give its imprimatur to speech that it finds problematic. *See id.* Thus, the Government can decline to exhibit certain monuments in a public park, *Pleasant Grove City v. Summum*, 555 U.S. 460 (2009), or refuse to issue license plates with a design of which it doesn't approve, *Walker*, 135 S. Ct. 2239. The reason Government can do so is that in those cases it is itself a speaker, *id.* at 2251, or is perceived as such by a reasonable observer, *Summum*, 555 U.S. at 471.

---

[6] Indeed, some scholars have argued that silencing hate speech actually undermines equal respect because it denies minorities that spark for protest so essential to the right of conscience. David A. J. Richards, *Free Speech and the Politics of Identity* 126–50 (1999).

In registering a trademark, the Government neither engages in "expressive conduct," nor can be reasonably perceived to do so. Issuing a trademark registration to a disparaging mark is no different than registering a deed to real property belonging to a hate group. An applicant for trademark registration is akin not to the Respondent in *Walker*, but to an individual who wishes to apply for a state-issued license plate for a car bearing a confederate plate bumper sticker. Taken to its logical conclusion, the Petitioner's argument would allow a state to deny license plates to such applicants because the plates would enable these individuals to display the Confederate flag, *e.g.*, the General Lee, on public roads. Petitioner's argument would also mean that the Government could refuse to provide an Employer Identification Number or refuse to issue various licenses to engage in business activities to corporations having "disparaging" names, because such numbers and licenses, much like trademarks, also appear on government registers. This cannot be the law.

Finally, the argument advanced in the Tushnet brief also provides no justification for § 2(a) strictures. The Tushnet Brief argues that by denying registration to disparaging marks, the Government actually promotes rather than restricts speech. Denial of registration, the argument goes, denies the applicant the ability to suppress speech of others. Tushnet Br. 13–15. This argument is truly puzzling. An exclusive right to a trademark in one party does not actually preclude anyone from speaking. When used in commerce, a trademark "is a form of commercial speech and nothing more."

Friedman v. Rogers, 440 U.S. 1, 11 (1979). "Requiring [other] commercial speaker[s] to choose words and labels that do not confuse or deceive protects the public and does not impair expression," *Silverman v. CBS Inc.*, 870 F.2d 40, 48 (2d Cir. 1989), and therefore does not suppress anyone's speech. To the extent other members of the public wish to use the trademarked word or symbol for non–commercial purposes such as parody, criticism, comparison to own goods, non–deceptive description of own services, and the like, the First Amendment and the Lanham Act protect their right to do so. *See New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (holding that the doctrine of fair use protects speakers who use the mark of another "to refer to a particular product for purposes of comparison, criticism, point of reference or any other such purpose."). "When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth. It is not taboo." *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924). The only reduction in speech that trademark registration contemplates is the reduction in deceptive and misleading commercial speech, *i.e.*, speech that has "no First Amendment value." *U.S. Healthcare, Inc. v. Blue Cross of Greater Philadelphia*, 898 F.2d 914, 928 n.15 (3d Cir. 1990).

Anyone who wishes to use the term Slants as a racial slur, to describe (or criticize) the band, and even to sell own products so long as the use is not misleading is free to do so irrespective of whether the term is or is not a registered trademark, and at least one of the signatories to the Tushnet Brief recognizes

as much. *See* William McGeveran & Mark P. McKenna, *Confusion Isn't Everything*, 89 Notre Dame L. Rev. 253, 288–91 (2013) (noting that "[m]ost courts" to consider third party uses of trademarks in their own expressive conduct "have adopted some variety of a so–called 'First Amendment defense.'"). On the other hand, denying the registration to a disfavored term makes it nearly impossible for the applicant to use that term to describe his own goods irrespective of how much the public associates the term with his goods and how much goodwill he has acquired.

III. Holding For The Petitioner Will Threaten The Rest Of The Intellectual Property Regime

Trademarks are not the only intellectual property rights that could be threatened if the Government prevails in this case. Copyrights, utility patents, and design patents could all be denied to the creators of works the Government deems "disparaging."

A. All the Arguments Against Trademark Registration Apply to Copyright Registration

As is the case with trademarks, a creative work need not be registered with the Copyright Office in order to receive copyright protection. *See Brownstein v. Lindsay*, 742 F.3d 55, 67 (3d Cir. 2014) ("[C]opyright registration does not establish the copyright, which attaches at the moment of creation."). Needless to say, an untold number of copyrighted works use racial, sexist, homophobic, and other degrading epithets in order to convey their message. These epithets can be found anywhere

from popular music, to hit Hollywood shows such as *The Sopranos*, to classic American novels such as *To Kill a Mockingbird*. All of these works have engendered controversy, protests, and criticism for their crude depiction of "underrepresented groups in our society." Under the Government's approach, it could deny copyright registration to the authors of these works because registration "would cause the work to be published on the [Copyright Catalog]; would cause a certificate for the [work] to be issued "in the name of the United States (which may be transmitted to foreign countries)," Pet. Br. 39, and would allow the registrant access to other governmental benefits such as the ability to stop importation of infringing works. 17 U.S.C. §§ 502–505, 602. If access to these benefits in the context of trademarks is sufficient to "associate" the Government with the speech of the mark's owners, it is equally sufficient to "associate" it with the much more extensive (and often more vulgar) speech of the copyright applicant.

The Tushnet Brief argues that a copyright cannot be analogized to a trademark because, in the words of the signatories, "to mandate that a work of authorship be non–disparaging or non–obscene to get protection would be to target the content of the work itself as a condition of the benefits of protection," while trademark law "protects only the source identification function of a symbol and not the symbol itself." Tushnet Br. 30. This is an odd distinction because in trademark, as elsewhere, "words are often chosen as much for their emotive as their cognitive force." *Cohen v. California*, 403 U.S. 15, 26 (1971).

> Customers value some products as much for what they symbolize as for what they do. For brands like Coke, Budweiser, Nike, and Jack Daniel's, customers value the brand's stories largely for their identity value. Acting as vessels of self–expression, the brands are imbued with stories that consumers find valuable in constructing their identities.

Douglas B. Holt, *How Brands Become Icons: The Principles of Cultural Branding* 3 (2004). *See also Au–Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d 1062, 1067 (9th Cir. 2006) ("Consumers sometimes buy products bearing marks such as the Nike Swoosh, the Playboy bunny ears, the Mercedes tri–point star, the Ferrari stallion, and countless sports franchise logos, for the appeal of the mark itself, without regard to whether it signifies the origin or sponsorship of the product.").

The use of "Slants" allows both the producer and consumer to construct their identities—that of an Asian band (and their devotees) both of whom hold particular set of political views. Thus, the Tushnet Brief's suggestion that Mr. Tam can protect his commercial interest if he were to "choose[] some other symbol to make the link between itself and its goods and services," Tushnet Br. 30, just would not do. It is akin to suggesting that the cult classic *The*

Big Lebowski could receive copyright registration only for the edited–for–TV version where the famous phrase "This is what happens when you fuck a stranger in the ass" is replaced by the anodyne, albeit nonsensical, phrase "This is what happens when you find a stranger in the Alps."

All of the arguments the Tushnet Brief raises with respect to trademarks are applicable to copyright as well. If it is true that the denial of trademark registration does not prevent anyone from speaking and allows the mark owner to continue to use the mark, just without the additional benefits of registration, then it is equally true that a denial of copyright registration also does not preclude anyone from speaking and allows the author to continue publishing his work, just without the benefit of federal copyright registration. If it is true that denial of trademark registration increases speech by denying the mark owner the ability to suppress the speech of others, then it is equally true that the denial of copyright registration will increase speech because it will deny the author the ability to suppress the speech of others. Both trademarks and copyrighted works have a significant expressive component to them, and their treatment cannot but rise and fall together.

B. Patents Will Also Be Threatened

The Patent Act offers protection to inventors of new and useful products and designers who create new and original ornamental designs. 35 U.S.C. §§ 101, 171. "[D]esign patents explicitly cover expressive content in the form of an ornamental design applied to a product or the ornamental shape

of a product." Andrew Beckerman–Rodau, *Design Patent Evolution: From Obscurity to Center Stage*, 32 Santa Clara High Tech. L.J. 53, 90 (2016). "To qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone, and must satisfy the other criteria of patentability." *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989). Of course, what's "aesthetically pleasing" to some is revolting to others, or as Latin maxim teaches, *de gustibus non est disputandum.* And yet, the PTO refuses applications "which could be deemed offensive to any race, religion, sex, ethnic group, or nationality, such as those which include caricatures or depictions" as "as nonstatutory subject matter." PTO, *Manual of Patent Examining Procedure* ("MPEP") § 1504.01(e) (Nov. 2015), https://www.uspto.gov/web/offices/pac/mpep/ (citing 35 U.S.C. § 171).[7] Though the restrictions on design patents are not part of the present case, they are *in pari materia*, for in both the trademark and design patent context the PTO takes upon itself the function of an arbiter of what is offensive and to whom. "Under our Constitution, 'esthetic and moral judgments about art and literature . . . are for the individual to make, not for the Government to decree, even with the mandate or approval of a majority.'" *Brown v. Ent. Merchants Ass'n*, 564 U.S. 786, 790 (2011) (quoting

---

[7] Unlike the Lanham Act, the Patent Act itself does not exclude offensive subject matter, and the exclusion is a result of the PTO rule only. *Compare* 35 U.S.C. § 171 (allowing anyone who "invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor"), *with* MPEP § 1504.01(e).

United States v. Playboy Entertainment Group, Inc., 529 U.S. 803, 818 (2000)).

Because "the clear purpose of the design patent law is to promote progress in the 'art' of industrial design," *In re Nalbandian*, 661 F.2d 1214, 1216 (C.C.P.A. 1981), it follows that denying such patents would advantage and advance some ideas that the Government prefers and disadvantage and stifle those it opposes, even if the proponents of those ideas would technically remain able to promote them. Reversing the judgment below would allow the PTO to retain the authority to discriminate not only in the field of trademarks, but also in the field of design patents, which in turn would endow the government with the power to favor only those viewpoints that it itself finds "aesthetically pleasing," and will deprive the citizenry of their "right to receive information and ideas, regardless of their social worth," which "is fundamental to our free society." *Stanley v. Georgia*, 394 U.S. 557, 564 (1969).

But design patents would not alone be threatened by reversing the judgment below. Utility patents, and with them "the Progress of Science and useful Arts," U.S. Const., Art. I, § 8, cl. 8, would also be in peril. Although utility patents are not often thought of as having a First Amendment "expressive" function, *see, e.g.*, Ralph D. Clifford & Richard J. Peltz–Steele, *The Constitutionality of Design Patents*, 14 Chi.-Kent J. Intell. Prop. 553, 598 (2015), certain inventions can be viewed as immoral by either the Government or the members of the general public, *see* Ann Bartow, *Pornography, Coercion, and Copyright Law 2.0*, 10 Vand. J. Entm't & Tech. L. 799, 830 (2008). Prior to the modern First

Amendment doctrine, "courts invalidated patents . . . on the ground that they were immoral." *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 1367 (Fed. Cir. 1999) (citing *Brewer v. Lichtenstein*, 278 F. 512 (7th Cir. 1922), *Schultze v. Holtz*, 82 F. 448 (N.D. Cal. 1897), and *Nat'l Automatic Device Co. v. Lloyd*, 40 F. 89 (N.D. Ill. 1889)). Thankfully, the practice has been abandoned decades ago. *See Ex Parte Murphy*, 200 U.S.P.Q. 801 (B.P.A.I. 1977). Adopting the Petitioner's position would, however, permit the Government to discriminate against inventors whose inventions the Government deems to be as injurious to public morals. Thus, a politically conservative Director might deny a patent to contraceptives, a pacifist Director might deny a patent to weapons, a teetotaling Director to new method of making beer, and so on. While the Government has a right to ban the possession or manufacture of some inventions, *see, e.g.*, *Sentell v. New Orleans & Carrolton R.R. Co.*, 166 U.S. 698, 704 (1897) (noting that the Government can "in a bona fide exercise of its police power, may interfere with private property, and even order its destruction"), it cannot ban the scientific inquiry into questions that it disfavors, *see generally* Barry P. McDonald, *Government Regulation or Other "Abridgements" of Scientific Research: The Proper Scope of Judicial Review Under the First Amendment*, 54 Emory L.J. 979 (2005).

If the Court were to accept the argument that the consequence of trademark registration shows the Government's endorsement of the mark, *see* Pet.

Br. 39,[8] or the argument that the denial of trademark registration does not suppress speech because it does not preclude anyone from speaking, *see* Tuhsnet Br. 30, it would follow that the Government could also deny patents to inventors of products that the Government disapproves of. After all, the inventors would not be prohibited from speaking in other manner (for example, through scientific publications and the like). However, "[t]he primary purpose of our patent system is . . . disclosure of advances in knowledge which will be beneficial to society . . . ." *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 330–31 (1945). Limiting patent availability necessarily means less disclosure, and necessarily impedes the public's "right to receive information and ideas." *Stanley*, 394 U.S. at 564.

The resolution of how exactly the First Amendment applies to and constrains the Patent Act should be left for another day. Nonetheless, the Court's decision here will resonate throughout all of the intellectual property regimes. The Court should err on the side of equal access to intellectual property protection for all comers and let the free market sort

---

[8] All of the arguments the Government advances in support of its position in the trademark arena would be applicable to patents as well. Issuance of a patent "would cause the [patent] to be published [i]n the [Official Gazette]; would cause a certificate for the [patent] to be issued 'in the name of the United States' . . . ; and would entitle [patentee to mark his product with a patent number] to convey to the public that the [patent] has an official status." *See* Pet. Br. 39.

out, as it always has, the offensive from the respectable, and the moral from the dissolute.

IV. Upholding § 2(a) Threatens Settled Property Rights

It is beyond dispute that trademarks are property of the trademark holder. *See, e.g., Clinton E. Worden & Co. v. Cal. Fig Syrup Co.*, 187 U.S. 516, 530 (1903) (holding that there exists a "right of property in a trade–mark, name, or symbol in connection with a particular manufacture or vendible commodity"); *Hutchinson, Pierce & Co. v. Loewy*, 217 U.S. 457, 459 (1910) ("The rule is well established that a trademark, word, or symbol has the elements of a property right."). Although the federal registration itself is not a property right, *In re Int'l Flavors & Fragrances, Inc.*, 183 F.3d 1361, 1366 (Fed. Cir. 1999) ("The federal registration of a trademark does not create an exclusive property right in the mark. The owner of the mark already has the property right established by prior use."), the denial of federal registration pursuant to § 2(a) may lead to the abrogation of all property rights in a trademark, irrespective of how long it may have existed, *see* Part I.B, *ante*.

The danger in § 2(a) depriving individuals of their long held property rights can be seen in the ongoing litigation over the Washington Redskins' trademark. The Redskins have used their name since 1933, *see Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 448 (E.D. Va. 2015), *appeal filed*, No. 15–1874 (4th Cir. filed Aug. 4, 2015) and therefore have acquired the property right to those marks at that time, *see Volkswagenwerk*

Aktiengesellschaft v. Wheeler, 814 F.2d 812, 815 (1st Cir. 1987) ("The right to trademark and service mark rights is based on prior use, or the one who first uses the marks in connection with a peculiar line of business."). Allowing the PTO to cancel these marks (or refuse registration on the grounds that they are "disparaging" or "scandalous") may preclude the owner from enforcing the mark either in state or federal court. *See* Part I.B, *ante*. In other words, the owner of the mark may be unable to prevail in an infringement action against any imitator or purveyor of counterfeit goods, because neither state nor federal courts will recognize his right to enforce the mark and exclude others from using the same. Necessarily, this would mean that the owner of the Redskins mark would lose all his property interest in that mark, because "[t]he hallmark of a protected property interest is the right to exclude others. That is 'one of the most essential sticks in the bundle of rights that are commonly characterized as property.'" *Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 673 (1999) (quoting *Kaiser Aetna v. United States*, 444 U.S. 164, 176 (1979)). It is the right to exclude others that makes trademarks property. *Id.* And consequently, the loss of the right to exclude others deprives the owners of their property.

Should this Court reverse the judgment below, countless settled and valuable property rights, from professional sport teams like the Chicago Blackhawks, the Cleveland Indians, and the Atlanta Braves, to food products like Aunt Jemima, Uncle Ben's, and Uncle Tom's, to cast iron elements such as FAG, may end up being destroyed at the whim of the

government. These property rights, often worth millions of dollars will be completely destroyed simply because the Government disapproves of the message the right–holders are sending. With the same logic being applicable to copyright and patent rights, *see* Part III, *ante*, unpopular speakers will perpetually be at the mercy of the Government if it is permitted to dispense and withdraw its benefits based on its evaluation of how offensive the speech is.

It may well be that the time has come for some of these property owners to abandon their property and rebrand their products. But that is a decision to be made by the property owners and their customers, rather than by the Government.

CONCLUSION

For these reasons, the Court should affirm the judgment below and hold that the non–disparagement clause of § 2(a) of the Lanham Act is unconstitutional.

Respectfully submitted,

Gregory Dolin
University of Baltimore
School of Law
1420 N. Charles Street
Baltimore, MD 22101
(410) 837–4610
gdolin@ubalt.edu

Matthew J. Dowd
Counsel of Record
Dowd PLLC
1717 Pennsylvania Ave, NW
Suite 1025
Washington, D.C. 20006
(202) 573–3853
mjdowd@dowdpllc.com

Counsel for Amicus Curiae

December 16, 2016

AND
BRIEFS

DEC 16 2016

No. 15-1293

IN THE
SUPREME COURT OF THE UNITED STATES

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ of Certiorari
To the United States Court of Appeals
For the Federal Circuit

BRIEF OF FIRST AMENDMENT LAWYERS ASSOCIATIONAS *AMICUS CURIAE* IN SUPPORT OF RESPONDENT

Marc J. Randazza
Counsel of Record
Randazza Legal Group, PLLC
4035 S. El Capitan Way
Las Vegas, NV 89147
(702) 420-2001
ecf@randazza.com

TABLE OF CONTENTS

TABLE OF AUTHORITIES III

INTEREST OF AMICUS CURIAE 1

SUMMARY OF ARGUMENT 3

ARGUMENT 4

1.0 INTRODUCTION 4

2.0 SECTION 2(A) IS A VIEWPOINT-BASED RESTRICTION ON RECEIPT OF A GOVERNMENT BENEFIT IN VIOLATION OF THE UNCONSTITUTIONAL CONDITIONS DOCTRINE BECAUSE IT BARS REGISTRATION (AND ENFORCEMENT) OF TRADEMARKS BASED ON THEIR CONTENT AND VIEWPOINT 6

2.1 Trademarks are protected commercial speech 7

2.2 Trademark registration confers significant benefits, and a Section 2(a) refusal or revocation causes significant harm 10

2.3 Section 2(a) is a viewpoint-based restriction on protected speech 13

3.0 SECTION 2(A) FAILS TO PROMOTE ANY SUBSTANTIAL GOVERNMENT INTEREST 17

3.1 Discouraging the use of "immoral" or "scandalous" marks 18

3.2 Occupying the "time, services, and use of funds of the federal government" 20

3.3 Trademarks are not government speech 21

4.0 SECTION 2(A) IS VOID FOR VAGUENESS 23

CONCLUSION 25

TABLE OF AUTHORITIES

CASES

Bad Frog Brewery v. New York State Liquor Authority, 134 F.3d 87 (2d Cir. 1998) 6, 17, 21

Bangkok Bangkok Imp. & Exp. Jamtan African Am. Mkt. Corp., 2016 U.S. Dist. LEXIS 81245 (S.D.N.Y. June 17, 2016) 11

Bolger v. Youngs Drug Products Corp, 463 U.S. 60 (1983) 19

Burwell v. Hobby Lobby, 573 U.S.___, 134 S.Ct. 2751 (2014) 9

Central Hudson Gas & Electric v. Public Service Commission, 447 U.S. 557 (1980) 6

Cohen v. California, 403 U.S. 15 (1971) ..... *passim*

Doyle v. Continental Ins. Co., 94 U.S. 535 (1876) 6

Edenfield v. Fane, 507 U.S. 761 (1993) 5, 14, 17

FCC v. Pacifica Found., 438 U.S. 729 (1978) 19

Florida Bar v. Went for It, Inc., 515 U.S. 618 (1995) 17, 18, 21

Friedman v. Rogers, 440 U.S. 1 (1979) 7

Home Ins. Co. of New York v. Morse,
87 U.S. 445 (1871) 6

In re Boulevard,
334 F.3d 1336 (Fed. Cir. 2003) 16, 25

In re Fox,
702 F.3d 633 (Fed. Cir. 2012) 11, 14, 15, 24

In re Mavety Media Group,
33 F.3d 1367 (Fed. Cir. 1994) ..... *passim*

In re McGinley,
660 F.2d 481 (1981) 6, 10, 20, 21

In re Old Glory Condom Corp.,
26 U.S.P.Q.2d 1216 22

In re Riverbank Canning Co.,
95 F.2d 327 (CCPA 1938) 13

In re RK Netmedia, Inc.,
2009 TTAB LEXIS 389 (T.T.A.B. May 21, 2009) 8

In re Tam,
No. 85472044 (Fed. Cir. Apr. 20, 2015) 11

Lawrence v. Texas,
539 U.S. 558 (2003) 18

Miller v. California,
413 U.S. 15 (1973) 21, 24

Perry Ed. Assn. v. Perry Local Educators' Assn.,
460 U.S. 37 (1983) 13

Pro-Football, Inc. v. Blackhorse,
112 F. Supp. 3d 439 (E.D. Va. 2015) 22

R.A.V. v. St. Paul,
505 U.S. 377 (1992) 13

Renna v. County of Union,
88 F.Supp.3d 310 (D.N.J. 2014) 11

Rosenberger v. Rector & Visitors of the Univ. of Va.,
515 U.S. 819 (1995) 13, 15

Roth v. United States,
354 U.S. 476 (1957) 7, 23

Rumsfeld v. Forum for Academic & Institutional Rights, 547 U.S. 47 (2006) 6

Simon & Schuster v. New York State Crime Victims Bd.,
502 U.S. 105 (1991) 12

Thrifty Rent-a-Car System v. Thrift Cars, Inc.,
831 F.2d 1177 (1987) 11

Turner Broadcasting System, Inc., v. FCC,
512 U.S. 622 (1994) 13

Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, 425 U.S. 748 (1976) 7, 8, 9

Weiner King, Inc. v. Wiener King Corp.,
615 F.2d 512 (1980) 11

STATUTES

15 U.S.C. § 1052 11

15 U.S.C. § 1052(a) ..... *passim*

15 U.S.C. § 1125 11

15 U.S.C. §1057 10

15 U.S.C. §1072 10

15 U.S.C. §1117 10

15 U.S.C. §1121 10

15 U.S.C. §1124 10

INTEREST OF AMICUS CURIAE[1]

Amicus First Amendment Lawyers Association ("FALA") is a national, non-profit organization of approximately 200 members who represent the vanguard of First Amendment lawyers. Its central mission is to uphold and defend the First Amendment. Founded in the late 1960s, *Amicus'* members were involved in many landmark cases upholding significant First Amendment rights, including *United States v. Stevens*, 559 U.S. 460 (2010); *Ashcroft v. Free Speech Coalition*, 535 US. 234 (2002); *United States v. Playboy Entertainment Group*, 529 U.S. 803 (2000); *Toffoloni v. LFP Publishing Group LLC*, 483 Fed. Appx. 561 (11th Cir. 2012); *United States v. Extreme Associates, Incorporated*, 431 F.3d 150 (3d Cir. 2005); *United States v. Stagliano et al.*, 693 F. Supp. 2d 25 (D.D.C. 2010); *United States v. Little*, 2008 WL 2959751 (M.D. Fla. 2008); *Alameda Books v. City of Los Angeles*, 222 F.3d 719 (9th Cir. 2000), *rev'd*, 535 U.S. 425 (2002), and *United States v. Investment Enterprises*, 10 F.3d 263 (5th Cir. 1993).

FALA's members often represent adult entertainment companies' interests in trademark matters, which underlies this suit. The instant dispute concerns the constitutionality of Lanham Act § 2(a) as it represents an infringement upon First Amendment rights. This question is central to the demon-

---

[1]The First Amendment Lawyers Association submits this brief as *amicus curiae* pursuant to Supreme Court Rule 37. No party or party's counsel authored the brief in whole or in part or contributed money intended to fund preparing or submitting it and no person other than *amicus curiae* contributed money intended to fund its preparation or submission. Counsel for both parties filed letters of consent to the filing of *amicus curiae* briefs, and are on file with the Clerk.

strated interests and activities of FALA's membership. FALA therefore has both a substantial interest in the subject matter and significant knowledge that the Court should find useful in evaluating the future of Section 2(a).

SUMMARY OF ARGUMENT

This appeal concerns the issue of the constitutionality of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a). This provision of the Lanham Act violates the First Amendment of the United States Constitution in that it is a viewpoint-based restriction on protected speech because it deprives citizens of a federal benefit based upon the content and the viewpoint of their speech. No articulable government interest exists to justify this restriction. Even if such an interest did exist, Section 2(a) is not sufficiently narrowly tailored to materially advance the interest. Section 2(a) is also void for vagueness because it does not warn trademark holders of what marks will be deemed immoral, scandalous, or disparaging and it does not warn trademark holders that their trademark may be revoked if it later becomes immoral, scandalous, or disparaging.

ARGUMENT

1.0 Introduction

The case-in-chief deals with the "disparaging" portion of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), and *amicus* sees no reason to engage in a full discussion of that section, which has been well briefed by the parties, and presumably will be well briefed by other *amici*. The First Amendment Lawyers' Association uses this opportunity to educate the Court on the unconstitutionality of the *entirety* of the "morality clause" of Section 2(a).

The unconstitutional restrictions on trademarks containing "immoral . . . or scandalous matter; or matter which may disparage" imposed by Section 2(a) impede trademark applicants and owners from receiving the benefits of federal trademark protection on the sole basis that their marks consist of speech that the government has decided to disfavor based on – nothing.

The general narrative put forth by the government and fans of Section 2(a) is the somewhat flippant argument that a § 2(a) denial does not restrict one's right to *use* the trademark in question, it merely restricts one's right to *register* the trademark – and all the benefits that come from *registration*. First, a rejection or cancellation under Section 2(a) actually does deprive the mark owner of significant rights – and not just a pretty piece of paper from the USPTO. It arguably deprives the owner of the *right* to enforce the mark and inarguably limits the owner's *ability* to enforce it, as well as other important statutory rights. The glib view that "well, you can still use it" is insufficient under the First Amendment, lacks a foundation in logic, and is more

"immoral and scandalous" than any trademark. Analogies abound, but imagine if the federal government allowed public demonstrations on public land, and provided security and porta potties to all demonstrators – unless the banners at the demonstration used cuss words. **Those shouting "*I prefer not to be drafted*" would get all of these benefits, but those shouting "*Fuck the Draft*" would not.**

Though trademarks are limited in their ability to be "distasteful," at least compared to copyrightable works, the ones that are potentially "immoral" or "scandalous" still embody the notion that "one man's vulgarity is another's lyric." *See Cohen v. California*, 403 U.S. 15, 25 (1971). Trademarks convey the kind of speech the First Amendment abides being circulated into the "marketplace of ideas;" trademark holders have financial incentives to make their name acceptable to the public, and the public has the power to reject those trademarks if it doesn't like them. *Edenfield v. Fane*, 507 U.S. 761, 766-67 (1993) (discussing, in general, the incentive for sellers to attract certain buyers by educating them about a product and the buyer's incentive to explore and compare products. "The commercial marketplace . . . provides a forum where ideas and information flourish . . . . the speaker and the audience, not the government, assess the value of the information presented"). By imposing unconstitutional conditions to the registration and enforcement of "immoral and "scandalous" words, Section 2(a) impermissibly infringes upon free speech and commercial expression.

"Minimal information, conveyed in the context of a proposal of commercial transaction suffices to

invoke the protection for commercial speech articulated in *Central Hudson*." *Bad Frog Brewery v. New York State Liquor Authority*, 134 F.3d 87, 97 (2d Cir. 1998). The Supreme Court in *Central Hudson* determined that, where protected commercial speech is restricted, the court must determine "whether the asserted government interest is substantial . . . whether the regulation directly advances the government interest asserted, and whether it is not more extensive than is necessary to serve that interest." *Central Hudson Gas & Electric v. Public Service Commission*, 447 U.S. 557, 566 (1980). Section 2(a) violates the First Amendment because it is an arbitrary viewpoint-based restriction on protected speech that does not advance any substantial government interest.

2.0 Section 2(a) Is a Viewpoint-Based Restriction on Receipt of a Government Benefit in Violation of the Unconstitutional Conditions Doctrine Because It Bars Registration (and Enforcement) of Trademarks Based on Their Content and Viewpoint

Under the unconstitutional conditions doctrine, the government may not condition the availability of a government benefit on an individual's agreement to surrender a constitutional right. *See Home Ins. Co. of New York v. Morse*, 87 U.S. 445, 451 (1871); *Doyle v. Continental Ins. Co.*, 94 U.S. 535, 543 (1876); *Rumsfeld v. Forum for Academic & Institutional Rights*, 547 U.S. 47 (2006). Trademark registration is designed to provide government benefits to trademark registrants. *See In re McGinley*, 660 F.2d 481, 486 n.12 (1981) ("What is denied are the benefits provided by the Lanham Act which

enhance the value of a mark."). Not only does the government assert that it may deny these benefits under § 2(a), but also that it may take away these benefits if the interpretation of a trademark changes. As a viewpoint-based restriction on protected speech, Section 2(a) violates this doctrine.

2.1 Trademarks are protected commercial speech

The First Amendment protects "[a]ll ideas having even the slightest redeeming social importance." *Roth v. United States*, 354 U.S. 476, 484 (1957). This includes commercial speech, which proposes a commercial transaction. *See Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748, 762 (1976). Trademarks are commercial speech[2] because they convey messages about the type, cost, and quality of the products or services associated with the mark. *See Friedman v. Rogers*, 440 U.S. 1, 11 (1979). Trademarks help consumers identify the quality of a certain good or service so the consumer can choose whether or not to repeat their purchasing experience. "Society [ ] has a strong interest in the free flow of commercial information, both because the efficient allocation of resources depend upon informed consumer choices," and because such information is of general public interest. *Id.* Thus, protection of trademarks supports not only the speaker, but also the consumer's right to "receive information and ideas." *See Virginia State Bd.*, 425 U.S. at 756.

---

[2] *Amicus* does not argue that all trademarks are by necessity commercial speech, but rather that at least some of them are. Even under the more liberal commercial speech analysis, Section 2(a) is unconstitutional.

In *Virginia State Bd.*, the Virginia Consumer Council argued for limiting price advertising for pharmacies because it had an interest in maintaining professionalism in the pharmacy industry. The Court denied this argument, stating that any pharmacist acting against his customers' interest would not only lose his license, but customers would likely stop going to that pharmacist. *Id.* The First Amendment "is designed and intended to remove governmental restraints from the arena of public discussion, putting the decision as to what views shall be voiced largely into the hands of each of us." *Cohen v. California*, 403 U.S. 16 (1971). Trademarks are one of the simplest places to apply this kind of market-based control. Like consumers who choose a pharmacist who has their interests in mind, consumers who do not approve of the name or message sent by a trademark will refrain from patronizing that company. For example, the pornography-consuming public *might* be shocked and scandalized at a website called CUMFIESTA. *See In re RK Netmedia, Inc.*, 2009 TTAB LEXIS 389 (T.T.A.B. May 21, 2009) (affirming refusal of CUMFIESTA and CUMGIRLS for adult oriented internet material). If a competitor sold similar goods under the hypothetical mark EFFLUVIA PARTY, and the pornography-consuming public liked the tasteful nature of that name better, then the market would speak to the former – "change your name if you want our money." There is a problem, however, when the consuming public has no problem with a term such as CUMFIESTA, but a government bureaucrat does and decides to substitute the judgment of consumers with his own – thereby depriving the mark owner of a governmental benefit, only because of the message in the mark.

Allowing the *market* to regulate what speech is favored and what speech is disfavored is the American way. But the government cannot place an unconstitutional condition on the registration and enforcement of otherwise valid trademark rights simply because a trademark examiner applied a vague and outdated standard to deem it too shocking for the public to handle.

Trademarks provide consumers with information concerning the ideals and philosophical underpinnings of a company. "Advertising, however tasteless and excessive it sometimes may seem, is nonetheless dissemination of information," and this information can be vital to consumers in determining what companies to purchase from. *Virginia State Bd.*, 425 U.S. at 765. In the aforementioned hypothetical, perhaps pornography purchasers would look at the competing publications and say to themselves "you know, CUMFIESTA has just the right level of whimsy and sexuality for me, that's what I want." Why should the government place its finger on the scale simply because someone, somewhere, thinks that someone else might be "shocked?"

Trademark holders and company owners use trade names and businesses to promote their personal views and make those views known to their customers. *See e.g. Burwell v. Hobby Lobby*, 573 U.S. __, 134 S.Ct. 2751 (2014). In the end, it is the mark holder's choice to use a mark that may discourage or even alienate certain consumers. Such a decision may even be made for the purpose of scaring away certain customers; promoting a certain viewpoint; to gain notoriety for having a controversial name; or simply because the name has some significance, personally, historically, or otherwise.

Trademarks are speech protected by the First Amendment. Aside from protecting the public from trademarks that are deceptive or concern unlawful activity, the PTO's refusal or revocation of a mark under Section 2(a) and the impairment of the right to enforce the rights under such marks, amounts to a restraint on protected speech that requires substantial justification. No such justification exists here.

2.2 Trademark registration confers significant benefits, and a Section 2(a) refusal or revocation causes significant harm

Trademark registration is not a frivolous act, as suggested by *In re McGinley*, which stated, "refusal to register [an applicant's] mark does not affect his right to use it." *In re McGinley*, 660 F.3d 481, 484 (C.C.P.A. 1981). This statement ignores the many benefits that come with trademark registration and the difficulty in enforcing non-registered marks. The Lanham Act provides numerous statutory benefits to registered marks not similarly conferred on non-registered or state registered marks. For example, a certificate of federal registration (1) is *prima facie* evidence of validity (15 U.S.C. §1057); (2) provides constructive notice of trademark ownership (*Id.*, § 1072); (3) provides protection from certain state requirements for displaying marks (*Id.*, § 1121); (4) allows recovery of statutory damages and attorney fees (*Id.*, § 1117); and (5) provides the ability to prevent importation of infringing goods (*Id.*, § 1124). Aside from the explicit benefits provided by the Lanham Act, registration likely increases income from trademark licensing and helps to generate nation-wide goodwill for the product or service. Revoking a mark has the opposite effect, taking

away government benefits, licensing income, and goodwill.

Since many state trademark laws imitate the Lanham Act, an unsuccessful trademark applicant will likely not receive these benefits under state law, either. *See In re Tam*, No. 85472044 at 8 (Fed. Cir. Apr. 20, 2015) (Moore, J.). Using a mark without registration only permits protected use within the owner's geographic area, and thus the unregistered trademark holder is subject to competition avoided by trademark registrants. *See, e.g. Thrifty Rent-a-Car System v. Thrift Cars, Inc.*, 831 F.2d 1177 (1987); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512 (1980). Even a mark that is widely-known can face protection problems because government enforcement is non-existent.

Despite the many benefits it provides, the Lanham Act is not, in practice, a purely benevolent statute for trademark applicants. Refusal under Section 2 of the Lanham Act can serve as a scarlet letter that precludes enforceability of the mark even under Section 43(a), which protects unregistered marks. *See Renna v. County of Union*, 88 F.Supp.3d 310, 321 (D.N.J. 2014) (finding that mark found unregistrable due to Lanham Act Section 2(b) was not entitled to protection under Section 43(a)); *Bangkok Bangkok Imp. & Exp. Jamtan African Am. Mkt. Corp.*, 2016 U.S. Dist. LEXIS 81245, *10 (S.D.N.Y. June 17, 2016) (same, citing *Renna* as persuasive authority); *and see In re Fox*, 702 F.3d 633, 640 (Fed. Cir. 2012) (subsequent to refusing registration of COCK SUCKER mark on Section 2(a) grounds, stating that the applicant "will be unable, however, to call upon the resources of the federal government in order to enforce the mark"). There-

fore, the Court cannot simply brush aside the notion that registrability is an insignificant benefit.

A 2(a) rejection or revocation has a very significant financial impact upon a rejected or revoked mark owner. "[A] statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech." *Simon & Schuster v. New York State Crime Victims Bd.*, 502 U.S. 105, 115 (1991). Refusals increase costs to trademark applicants seeking to register or use allegedly "immoral" or "scandalous" trademarks; they may endure the cost of a federal registration application, state registration application, appeals, cost in changing their logo or business name to comply with Section 2(a), and costs of the complete loss of trademark eligibility. This creates an even greater financial burden if a long-standing mark is revoked because of a change in culture or sensibilities.

Individuals and businesses refrain from using certain terms as trademarks for fear the PTO might see the terms as immoral, scandalous, or derogatory, in violation of Section 2(a). Such self-censorship narrows the spectrum of speech in the public marketplace. The possibility for revocation of a mark strengthens this effect—trademark holders have reason to be even more cautions with choosing certain terms that could at any time be held to violate 2(a). Section 2(a) denies government benefits and places monetary and legal burdens on applicants with allegedly "immoral" or "scandalous" marks, in violation of the First Amendment.

2.3 Section 2(a) is a viewpoint-based restriction on protected speech

A restriction on speech is content-based when it either seeks to restrict, or on its face restricts, a particular subject matter. *See Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 828 (1995). Any restriction on speech based on the message conveyed is presumptively unconstitutional. *See Turner Broadcasting System, Inc., v. FCC*, 512 U.S. 622, 641-43 (1994). This presumption becomes stronger when a government restriction is based not just on subject matter, but on a particular viewpoint expressed about that subject. *See R.A.V. v. St. Paul*, 505 U.S. 377, 391 (1992). The government cannot be allowed to impose restrictions on speech where the rationale for the restriction is the opinion or viewpoint of the speaker. *See Perry Ed. Assn. v. Perry Local Educators' Assn.*, 460 U.S. 37, 46 (1983).

Section 2(a) prevents registration of "immoral" or "scandalous" marks. A mark is "scandalous" under Section 2(a) if it "is 'shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings . . . [or] calling out [for] condemnation.'" *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (quoting *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (CCPA 1938)).

Section 2(a) is a restriction based on the viewpoint expressed in an applicant's trademark. An impossible to quantify "value" to society provided by the mark should not be relevant to the government's circumvention of First Amendment protection, as

> the commercial marketplace, like other spheres of our social and cultural

> life, provides a forum where ideas and information flourish. Some of the ideas and information are vital, some of slight worth. But the general rule is that the speaker and the audience, not the government, assess the value of the information presented.

Edenfield v. Fane, 507 U.S. 761, 767 (1993). In *Edenfield*, the Court determined that a rule prohibiting CPAs from engaging in in-person solicitation, as applied, violated the First Amendment, finding that the law threatened access to accurate commercial information. *Id.* at 777. Similarly, Section 2(a) restricts consumers' access to accurate commercial information about the business the trademark is affiliated with, as well as to any additional speech conveyed by the trademark itself. As with anyone exercising their First Amendment rights, trademark holders should be permitted to engage in commercial speech with consumers potentially interested in their products or associated ideas. Mark holders should similarly be permitted to continue those relationships after the mark has been established.

In re Fox tells us that trademarks are protected by the First Amendment, and that Section 2(a) is a viewpoint-based restriction on such protected speech. In that case, the Federal Circuit determined that the mark "COCK SUCKER" for rooster-shaped chocolate lollipops was "scandalous" under Section 2(a). *In re Fox*, 702 F.3d at 639–40. In its decision, the court determined that in addition to satisfying the definitions of scandalous, if a mark has *any* "vulgar" meaning it is *per se* scandalous. *Id.* at 635. Thus, the court applied Section 2(a) to determine whether the "public will assign" a scandalous mean-

ing to the mark even if the mark is a double entendre. *Id.* at 636. The applicant in *In re Fox* wanted to use the mark "COCK SUCKER" as a joke, playing off the multiple definitions of the words and their literal meaning as applied to her actual product, rooster-shaped lollipops. *Id.*

Rather than display a sense of humor, the PTO chose a single definition of the terms and found one definition to be "scandalous." One does not look at the mark "Cock sucker" and think "that is quite humorous because it is in reference to 'one who performs an act of fellatio,'" as the court suggested. *See id.* at 635. Instead, it is inherently humorous because we live in a society with "taboo" statements that are not inherently unacceptable. But rather than trust in the public's ability not to faint at the sight of double entendre, the PTO substituted its own judgment in place of the public. Importantly, it did not impose this restriction on speech because the applicant chose to use a mark arguably referring to a sex act, but rather because the applicant expressed a view on this subject using less than clinical terms. *See, e.g., Rosenberger*, 512 U.S. at 831 (recognizing that in the "vast area of inquiry" that is religious discussion, government action based on a "prohibited perspective" was viewpoint-based).

This decision, and the Court's reasoning therein, establishes that trademarks possess elements of speech beyond merely identifying the source of goods and services; indeed, how could speech that merely identifies the source of goods or services be "vulgar" at all, such that it could offend the sensibilities of the PTO? The only effect of Section 2(a) is for the PTO to make a determination that certain terms, which express particular viewpoints about particular

subjects, are off-limits. In practice, Section 2(a)'s "immoral" and "scandalous" provision is applied predominately to the subject matter of sex and bodily functions, and serves to restrict any viewpoint about these subjects that is not sufficiently Victorian.

In a similar case, the Federal Circuit determined "jack-off" to be an immoral and scandalous term in *In re Boulevard*, despite evidence showing that the term was neither. 334 F.3d 1336 (Fed. Cir. 2003). The court interpreted *In re Mavety Media Group*, 33 F.3d 1367 (Fed. Cir. 1994), to say that dictionary definitions alone were insufficient to determine whether a mark was "scandalous," except where there is only one pertinent meaning as applied to the trademark at issue. *Boulevard*, 334 F3d at 1340. The applicants had provided evidence "to show that the term . . . is not immoral or scandalous," but the court found that the declarations in the record "consist[ed] mainly of the personal opinions of the declarants as to the offensiveness of the term." *Id.* at 1341. Once it determined that "masturbation" was *the* definition of the term "jack-off," the court found the term to be offensive and ignored all evidence to the contrary as "wholly irrelevant." *Id.* at 1343. The court picked one definition of the term "jack-off," decided it was "offensive," and then withheld a federal benefit to the applicant based on the viewpoint towards a sexual topic expressed by the applicant's trademark. This is not the kind of determination that courts or the PTO make only when feeling especially authoritarian; this is a determination that *any* trademark examiner *must* make when choosing to refuse registration on Section 2(a) grounds. There simply is no viewpoint-neutral,

much less content-neutral, way to refuse or revoke registration based on Section 2(a).

Because Section 2(a) limits this transfer of information based on the viewpoint expressed by a trademark, it regulates protected speech. In light of this, Section 2(a) must be "narrowly tailored" to serve a substantial government interest. *Florida Bar v. Went for It, Inc.*, 515 U.S. 618, 632 (1995). It is not.

3.0 Section 2(a) Fails to Promote Any Substantial Government Interest

Under the First Amendment, the requirement of a substantial government interest "is not satisfied by mere speculation or conjecture; rather, a governmental body seeking to sustain a restriction on commercial speech must demonstrate that the harms it recites are real and that its restriction will in fact alleviate them to a material degree." *Went for It*, 515 U.S. at 628. Trademarks can facilitate societal change by "providing a forum where ideas and information flourish . . . . [where] the audience, not the government, assess[es] the value of the information presented." *Edenfield*, 507 U.S. at 1798. "Laws restricting commercial speech . . . need only be tailored in a reasonable manner to serve a substantial state interest." *Id.*; *see also, Bad Frog* 134 F.3d at 98. The PTO has not historically articulated any interest that can justify the existence of Section 2(a), and no such interest is even conceivable.

3.1 Discouraging the use of "immoral" or "scandalous" marks[3]

Section 2(a) is a viewpoint-based restriction on speech that the government finds "immoral." The U.S. Supreme Court has stated in no uncertain terms that "[t]he fact that a State's governing majority has traditionally viewed a particular practice as immoral is not a sufficient reason for upholding a law prohibiting the practice." *Lawrence v. Texas*, 539 U.S. 558 (2003). While *Lawrence* dealt with an anti-sodomy law, its reasoning is just as applicable to Section 2(a); the PTO cannot use "morality" to justify the selective restriction and governmental discouragement of protected speech on the basis of its content or message.

The registration and operation of trademarks does not implicate more valid concerns such as the privacy or physical safety of consumers, either. The court in *Went for It* accepted the government's interest in protecting individuals' privacy as a reason to uphold a 30-day solicitation ban for personal injury attorneys because the attorneys had a business incentive to seek out persons who had been in accidents. *Went for It*, 515 U.S. at 625. This interest in privacy was sufficient to sustain a restriction on commercial speech. The general consuming public, however, has a choice to purchase from the trademark holder, and the mere registration of an "offen-

---

[3] Petitioner states in its brief that the government has an interest in protecting minorities from a bombardment of demeaning messages in commercial advertising. (*See* Pet. Brf. at 48.) *Amicus* does not express a viewpoint as to the validity of that purported interest, but notes that such an interest is in no way furthered by the "immoral" and "scandalous" provision of Section 2(a).

sive" trademark can in no way invade the privacy of individuals, just as a jacket stating "fuck the draft" does not invade the privacy of people in a public space. *See Cohen*, 403 U.S. 15. Rather, consumers have a greater ability to "avoid further bombardment of their sensibilities" by not only "simply averting their eyes," but by denying a certain company their business. *Id.* at 21.

A "short, though regular, journey from mail box to trash can" has been found to be an acceptable burden on the consuming public under the Constitution. *Bolger v. Youngs Drug Products Corp*, 463 U.S. 60, 72 (1983). In *Bolger*, the Court held that the intrusion of mail for contraceptives into one's home was acceptable and could not be constitutionally banned. How, then, could the registration of an "immoral" or "scandalous" display in an advertisement or a storefront be so invasive as to justify a restraint on protected speech? Indeed, today we have an even greater ability to avert our eyes from "offensive" material. For instance, there are numerous television channels and radio stations to choose from, certainly more than in the 1970s. During the time of the *FCC v. Pacifica* case courts may have had a stronger rationale to limit indecent speech, but even that case upheld rights under the First Amendment. *FCC v. Pacifica Found.*, 438 U.S. 729, 745–46 (1978) ("Indeed, if it is the speaker's opinion that gives offense, that consequence is a reason for according it constitutional protection. For it is a central tenet of the First Amendment that the government must remain neutral in the marketplace of ideas."). Avoiding going to an offensive store, searching on the Internet, or even having to change the

channel is not a significant burden the Court need relieve the public of.

3.2 Occupying the "time, services, and use of funds of the federal government"

Courts have previously attempted to justify Section 2(a) under the reasoning that this provision reflects "a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government." *McGinley*, 660 F.2d at 486. This reasoning, as with much of *McGinley*, collapses under any logical scrutiny. As the dissent in that case pointed out, "[m]ore public funds are being expended in the prosecution of this appeal than would ever result from the registration of the mark." *See McGinley*, 660 F.2d at 487 (Judge Rich, dissenting). In cases where a mark is initially "acceptable," but times change, and the mark becomes "immoral" to "a substantial composite" of the public, then even more government resources would be consumed by a challenge to the mark's registrability. This danger is particularly likely given the *In re Mavety* court's recognition "of the ever-changing social attitudes and sensitivities. Today's scandal can be tomorrow's vogue. Proof abounds in nearly every quarter, with the news and entertainment media today vividly portraying degrees of violence and sexual activity that, while popular today, would have left the average audience of a generation ago aghast." *In re Mavety*, 33 F.3d at 1371. That 22-year-old observation becomes more accurate as time goes on.

Even if the supposed rationale of "resource scarcity" happened to be sufficient justification for the restrictions on protected speech created by

Section 2(a), the supposed cost-saving purpose of this provision has never been borne out by reality. The time and consideration it takes to determine whether a mark is "immoral" or "scandalous" is burdensome on the PTO, the courts, and mark owners. Opinions on issues of morality change almost daily and also depend on geography, a trait that Section 2(a) shares with determinations on whether speech is "obscene."[4] Thus, a determination of "immorality" or "scandalousness" under Section 2(a) is not one that can easily be made based on "history, consensus, and simple common sense." *Went for It*, 515 U.S. at 628.

Further, "a prohibition that makes only a minute contribution to the advancement of a state interest can hardly be considered to have advanced the interest to a material degree." *Bad Frog*, 134 F.3d at 99. Thus, even if Section 2(a) did manage to net the PTO some small savings, this would be insufficient to justify the Section's existence, as the government must show that "the harms it recites are real and that its restriction will in fact alleviate them to a *material degree*." *Id.* (emphasis in original).

3.3 Trademarks are not government speech

Another suggested government interest in Section 2(a) is that Section 2(a) prevents the public from assuming that the PTO approves of "immoral" trademarks. *See In re McGinley*, 660 F.2d at 844. The government does not, however, have any issue

---

[4] While obscene speech is not afforded protection under the First Amendment, it is difficult to conceive of a trademark that could be considered legally obscene by today's common community standards. *See Miller v. California*, 413 U.S. 15 (1973).

archiving copyrightable works that many find distasteful. This is not colonial England, where citizens had to receive permits to publish their speech. People do not assume that someone can say something only with the government's consent and approval. The same logic applies to the conferral of government benefits for purposes that are wholly unrelated to the content of the benefited speech. Trademark law exists to improve the experience of customers in the marketplace, not to protect people from "immoral" or "scandalous" speech.

While admitting that conferring registration does not communicate government endorsement of a good or service, the government argues that "'[w]hen the symbol for a federally registered trademark, ®, is affixed to a mark, it is a declaration by the federal government that it has approved that mark.'" (Pet. Brf. at 50) (quoting *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 461 (E.D. Va. 2015)). This "approval" only indicates that a mark has satisfied the formal requirements for registration with the PTO. Even if Petitioner's argument is accepted, then, theirs is a self-made problem. By removing the ban on "immoral" and "scandalous" marks, the PTO can affirmatively communicate that it holds no opinion on the moral propriety of a given mark.

But this is beside the point, as there is no guesswork involved in whether the PTO expresses approval of a trademark's message by granting registration. The PTO explicitly denies any approval of the message conveyed by a trademark. *See In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1219–20 ("the act of registration is not a government imprimatur or pronouncement that the mark is a 'good' one in an aesthetic, or any analogous, sense").

Moreover, just as "the mere presumed presence of unwitting listeners or viewers does not serve automatically to justify curtailing all speech capable of giving offense" (*Cohen*, 403 U.S. at 21), the mere presumed presence of people who erroneously consider trademark registration as a government stamp of approval does not justify curtailing all possibly "immoral" or "scandalous" speech.

4.0 Section 2(a) is Void for Vagueness

The multitude of inconsistent Section 2(a) cases show that Section 2(a) does not convey "sufficiently definite warning as to the proscribed conduct when measured by common understanding and practices," as required by the Constitution. *Roth v. United States*, 354 U.S. 467, 491 (1957). In applying Section 2(a), "[t]he determination that a mark comprises scandalous matter is a conclusion of law based upon underlying factual inquiries." *In re Mavety*, 33 F.3d at 1371 (Fed. Cir. 1994). The court in *In re Mavety* noted that analysis for trademark refusal requires the opinions of a "substantial composite of the general public, the context of the relevant marketplace, or contemporary attitudes." *Id.* at 1373. Additionally, the court stated, "we must be mindful of ever-changing social attitudes and sensitivities."

Id. at 1371.[5] This standard is similar to the standard for assessing obscenity, but addresses protected speech. *Cf. Miller v. California*, 413 U.S. 15 (1973). Though *McGinley* specifically rejected this comparison, the Supreme Court has used obscenity law to show that speech enjoys full First Amendment protection where it does not fall under unprotected or significantly less protected categories of speech. *Cohen v. California*, 403 U.S. at 20.

To prove that a mark is scandalous, one "must demonstrate that the mark is 'shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; giving offense to the conscience or moral feelings; or calling out for condemnation," but "a showing that a mark is vulgar is sufficient to establish that it consists of or comprises immoral or scandalous matter within the meaning of section 1052(a)." *In re Fox*, 702 F.3d 633, 635 (Fed. Cir.

---

[5] This admonishment to "keep up with the times" was offered to argue for a more liberal interpretation of previously "immoral" marks. However, consider the converse (as is at issue in this case). A word that has no non-innocent meaning at all can, through cultural shifts, become one that will at least draw laughter, if not scorn. For example, consider the shifting meaning of the word "tea bag." When used as a noun, as it has been for decades, there is no likely concern. However, the verb has a very different meaning. Would a mark that once contained this term be subject to later revocation? Section 2(a) also fails to give appropriate warning if the standard changes. In the past certain marks like "Redskins" was not seen as offensive, or at least there was no action that could correct the issue. Now we see that the PTO can revoke a mark after it has been issued with no § 2(a) objection. The trademark holder thus has to worry both that the mark will be denied under § 2(a) during initial filing and that the mark could be revoked at any later date for a § 2(a) conflict. This danger is more prevalent with an "immoral" or "scandalous" mark, as that portion of § 2(a) does not contain a "may" qualifier.

2012). This standard is said to be "determined from the standpoint of a substantial composite of the general public, and in the context of contemporary attitudes." *Id.*; *In re Boulevard*, 334 F.3d 1336 (Fed. Cir. 2003). However, in reality it is very often determined by the personal sensibilities of a single examining attorney or a few objecting persons. *See, e.g.*, *In re Tam*, Brief of ACLU, Appeal No. 2014-1293 at 4 (June 19, 2015) (comparing the denial of "Uppity Negro" Application No. 86,053,392 with registration of Application No. 78,312,525); *In re Boulevard*, 334 F.3d at 1341 ("[A] number of declarations from academics and business persons . . . attested that the term was not offensive. Those declarations, however, consist mainly of the personal opinions of the declarants."). Courts' recognition that the offensive character of marks changes with time in itself declares Section 2(a) void for vagueness.

CONCLUSION

The Court cannot suppress trademarks without also suppressing the ideas they convey. *See Cohen*, 403 U.S. at 26. Trademarks provide information to potential and current consumers, ranging from information about goods and services to company values, beliefs, and ideas. Therefore, the government cannot use Section 2(a)'s restriction on "immoral . . . or scandalous matter; or matter which may disparage" to suppress the protected speech encompassed by trademarks without adequate justification. While an unsuccessful trademark applicant may indeed continue to use a mark refused or revoked on Section 2(a) grounds, the value of that mark is hobbled and unenforceable, thereby making it less attractive and causing applicants to self-censor their use of potentially "immoral" or "scandalous" marks.

This discourages such speech from the marketplace of ideas, favoring only speech that the PTO and less than a substantial majority of individuals find appropriate and refuses significant enforcement rights. The First Amendment will not abide such arbitrary standards for the burdening of speech with unconstitutional conditions. It does not advance any substantial government interest, and is not narrowly tailored to serve any interest the government ever has, or ever could, put forth to justify it. Courts have allowed Section 2(a) to stand unquestioned for far too long. It is unconstitutional and has done great harm to the marketplace of ideas for decades. That time should end now.

DATED: December 16, 2016.

By: /s/ Marc J. Randazza
Marc J. Randazza
Randazza Legal Group, PLLC
4035 S. El Capitan Way
Las Vegas, NV 89147
(702) 420-2001

RECORD
AND
BRIEFS

No. 15-1293

In the

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE FRED T. KOREMATSU CENTER FOR LAW AND EQUALITY, HISPANIC NATIONAL BAR ASSOCIATION, NATIONAL ASIAN PACIFIC AMERICAN BAR ASSOCIATION, NATIONAL BAR ASSOCIATION, NATIONAL LGBT BAR ASSOCIATION, AND NATIONAL NATIVE AMERICAN BAR ASSOCIATION AS AMICI CURIAE IN SUPPORT OF PETITIONER

ROBERT S. CHANG
FRED T. KOREMATSU CENTER FOR LAW AND EQUALITY
901 12th Avenue
Seattle, WA 98122
(206) 398-4025
changro@seattleu.edu

WILLIAM C. RAVA
Counsel of Record
ELVIRA CASTILLO
DAVID A. PEREZ
CARA WALLACE
DANE WESTERMEYER
PERKINS COIE LLP
1201 Third Avenue, Suite 4900
Seattle, WA 98101-3099
206.359.8000
WRava@perkinscoie.com
Counsel for Amici Curiae

Library of Congress

TABLE OF CONTENTS

Page

Interest of Amici Curiae 1

Summary of Argument 4

Argument 5

A. Congress and this Court have recognized that racial discrimination threatens the government's substantial interest in ensuring the orderly flow of commerce. 5

B. Section 2(a) advances the government's substantial interest in ensuring the orderly flow of commerce. 12

1. Section 2(a) is a content neutral regulation of commercial speech. 13

2. Being denied federal registration has not prevented Tam from continuing to use a racial slur for his band's name. 19

3. The cancellation of the REDSKINS trademark registration illustrates the importance of Section 2(a). 21

Conclusion 30

TABLE OF AUTHORITIES

Page(s)

FEDERAL CASES

Bolger v. *Youngs Drug Prods. Corp.*,
463 U.S. 60 (1983) 12

Broadrick v. *Oklahoma*,
413 U.S. 601 21

Cent. Hudson Gas & Elec. Corp. v. *Pub. Serv. Comm'n of New York*,
447 U.S. 557 (1980) 12

City of Erie v. *Pap's A.M.*,
529 U.S. 277 (2000) 14, 15

City of Renton v. *Playtime Theatres, Inc.*,
475 U.S. 41 (1986) 14

Friedman v. *Rogers*,
440 U.S. 1 (1979) 12, 13

Heart of Atlanta Motel, Inc. v. *United States*,
379 U.S. 241 (1964) 7, 10

In re Tam,
808 F.3d 1321 (Fed. Cir. 2015) 10

Jones v. *City of Boston*,
738 F. Supp. 604 (D. Mass. 1990) 28

Katzenbach v. *McClung*,
379 U.S. 294 (1964) 8

Lyng v. *UAW*,
485 U.S. 360 (1988) 29

Ohralik v. *Ohio State Bar Ass'n*,
436 U.S. 447 (1978) 16

Osborne v. *Ohio*,
495 U.S. 103 (1990) 14

Ostergren v. *Cuccinelli*,
615 F.3d 263 (4th Cir. 2010) 17

Posadas de Puerto Rico Assocs. v.
Tourism Co. of Puerto Rico,
478 U.S. 328 (1986) 16

Pro-Football, Inc. v. *Blackhorse*,
112 F. Supp. 3d 439 (E.D. Va. 2015) 29

R.A.V. v. *City of St. Paul*,
505 U.S. 377 (1992) 17

Regan v. *Taxation With Representation*
of Wash.,
461 U.S. 540 (1983) 29

Regents of Univ. of Cal. v. *Bakke*,
438 U.S. 265 (1978) 17

Sambo's Rests., Inc. v. *City of Ann*
Arbor,
663 F.2d 686 (6th Cir. 1981) 16, 17

Sorrell v. *IMS Health Inc.*,
564 U.S. 552 (2011) 14

Specialized Seating, Inc. v. *Greenwich*
Indus., L.P.,
616 F.3d 722 (7th Cir. 2010) 20

Turner Broad. Sys., Inc. v. *F.C.C.*,
512 U.S. 622 (1994) 15

Va. State Bd. of Pharmacy v. *Va. Citizens Consumer Council, Inc.*, 425 U.S. 748 (1976) 13

Volkswagenwerk Aktiengesellschaft v. *Wheeler*, 814 F.2d 812 (1st Cir. 1987) 20

Ward v. *Rock Against Racism*, 491 U.S. 781 (1989) 13, 14

Ysursa v. *Pocatello Educ. Ass'n*, 555 U.S. 353 (2009) 29

OTHER CASES

In re Johnson, 71 Wash. 2d 245 (1967) 10

FEDERAL STATUTES

15 U.S.C. 1052 16

15 U.S.C. 1125(a) 20

15 U.S.C. 1127 ..... 12, 15

42 U.S.C. 2000a ..... passim

42 U.S.C. 2000e-3(b) 9

42 U.S.C. 3604(c) 9

OTHER STATUTES

Wash. Rev. Code § 49.60 7

LEGISLATIVE MATERIALS

S. REP. NO. 88-872 (1964), *reprinted in* 1964 U.S.C.C.A.N. 2355 ..... 7, 8

Stolen Identities: The Impact of Racist Stereotypes on Indigenous People: Hearing Before the S. Comm. on Indians Affairs 112th Cong. 69 (2011) 27, 28

CONSTITUTIONAL PROVISIONS

U.S. Const. amend. I ..... passim

OTHER AUTHORITIES

A Public Accommodations Challenge to the Use of Indian Team Names and Mascots in Professional Sports, 112 HARV. L. REV. 904 (1999) 24

Adalia Woodbury, *Indiana Lawmaker Admits "No Gays" Signs Will Be Allowed*, POLITICUSUSA (Mar. 30, 2015), http://www.politicususa.com/2015/03/30/connecticut-state-boycottindianas-rfra.html 11

APA Resolution Recommending the Immediate Retirement of American Indian Mascots, Symbols, Images, and Personalities by Schools, Colleges, Universities, Athletic Teams, and Organizations, AM. PSYCHOLOGICAL ASS'N (2005), http://www.apa.org/about/policy/mascots.pdf 28

Donald J. Orth & Roger L. Payne, *Principles, Policies, and Procedures: Domestic Geographic Names*, U.S. BD. OF GEOGRAPHIC NAMES (1997), http://geonames.usgs.gov/docs/pro_pol_pro.pdf 17

Ending the Legacy of Racism in Sports & the Era of Harmful "Indian" Sports Mascots, NAT'L CONG. OF AM. INDIANS (Oct. 2013), http://www.ncai.org/attachments/PolicyPaper_mijApMoUWDbjqFtjAYzQWlqLdrwZvsYfakBwTHpMATcOroYolpN_NCAI_Harmful_Mascots_Report_Ending_the_Legacy_of_Racism_10_2013.pdf 24

Fight over Florida gun store's 'Muslim free zone' is far from over (Dec. 5, 2015), http://wjhl.com/2015/12/05/fight-over-florida-gun-stores-muslim-free-zone-is-far-from-over/ 11

Jennings Brown, Tal Reznik, & Matan Gilat, *Racial Slurs Are Woven Deep Into The American Landscape*, VOCATIV (Oct. 29, 2015), http://www.vocativ.com/news/244179/racial-slurs-are-woven-deep-into-the-american-landscape/ 18

Jonathan Jones, *Foul Language: The NFL is cracking down on the use of the N-word on the football field*, SPORTS ILLUSTRATED (Oct. 26, 2016), http://www.si.com/nfl/2016/10/26/nfl-n-word-penalty-unsportsmanlike-conduct 24

Lawrence R. Baca, What About the Indian Country "N" Word? (Nov. 17, 1998) 24

Letter from Lawrence R. Baca, Chairman, Indian Law Section of the Federal Bar Association, to John Hope Franklin, Chairman, President's Advisory Board on Race Relations (June 30, 1997) 24

Martin Luther King, Jr., *Letter from a Birmingham Jail* (Apr. 16, 1963), *reprinted in* WHY WE CAN'T WAIT (1964) 9

Norimitsu Onishi, *Jail Time for Using South Africa's Worst Racial Slur?*, N.Y. TIMES (Oct. 27, 2016), http://www.nytimes.com/2016/10/28/world/africa/south-africa-hate-speech.html?_r=0 19

Roger Goodell, *2016 Official Playing Rules of the National Football League*, NFL (2016), http://operations.nfl.com/media/2224/2016-nfl-rulebook.pdf 23

Ryan Basen, *Fifty Years Ago, Last Outpost of Segregation in N.F.L. Fell*, N.Y. TIMES (Oct. 6, 2012) 25

Stephanie A. Fryberg, et al., *Of Warrior Chiefs and Indian Princesses: The Psychological Consequences of American Indian Mascots*, 30 BASIC & APPLIED SOC. PSYCHOL. 208 (2008) 27

INTEREST OF AMICI CURIAE[1]

The Fred T. Korematsu Center for Law and Equality ("Korematsu Center"), Hispanic National Bar Association ("HNBA"), National Asian Pacific Americans Bar Association ("NAPABA"), National Bar Association ("NBA"), National LGBT Bar Association ("LGBT Bar"), and National Native American Bar Association ("NNABA"), respectfully submit this brief in support of the petitioner, Michelle Lee.

The Korematsu Center is a nonprofit organization based at Seattle University School of Law and works to advance justice through research, advocacy, and education. The Korematsu Center is dedicated to advancing the legacy of Fred Korematsu who defied military orders during World War II that led to the internment of 110,000 Japanese Americans, and later became an advocate for the civil rights of other victims of excessive government action. The Korematsu Center has a strong interest in ensuring that our courts, laws and government do not become active participants in perpetuating discrimination. The Korematsu Center does not, in this brief or otherwise, represent the official views of Seattle University.

HNBA comprises thousands of Latino lawyers, law professors, law students, legal professionals,

---

[1] No counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than the *amici curiae* or their counsel made a monetary contribution to its preparation or submission. Letters evidencing the parties' blanket consent to the filing of *amicus* briefs have been filed with the clerk.

state and federal judges, legislators, and bar affiliates across the country. The HNBA supports Hispanic legal professionals and is committed to advocacy on issues of importance to the 53 million people of Hispanic heritage living in the United States. The HNBA regularly petitions Congress and the Executive on behalf of all members of the communities it represents.

NAPABA is the national association of Asian Pacific American attorneys, judges, law professors, and law students. NAPABA represents the interests of over 50,000 attorneys and approximately 75 national, state, and local bar associations. Its members include solo practitioners, large firm lawyers, corporate counsel, legal service and non-profit attorneys, and lawyers serving at all levels of government. Since NAPABA's inception in 1988, it has promoted justice, equity, and opportunity for Asian Pacific Americans as the national voice for Asian Pacific Americans in the legal profession. These efforts have included civil rights advocacy on various fronts. In furtherance of its mission to promote justice, equity, and opportunity for Asian Pacific Americans, NAPABA seeks to ensure that the government does not become a partner in advancing harmful racial slurs.

NBA is the nation's oldest and largest national network of predominantly African-American attorneys and judges in the United States. The NBA was founded in 1925 when there were only 1,000 African-American attorneys in the entire country and when other national bar associations, such as the American Bar Association, did not admit African-

American attorneys. Throughout history, the NBA consistently has advocated on behalf of African Americans and other minority populations. The NBA represents approximately 66,000 lawyers, judges, law professors, and law students, and it has over eighty affiliate chapters throughout the world.

LGBT Bar is a non-partisan, membership-based professional association of lawyers, judges, legal academics, law students, and affiliated lesbian, gay, bisexual and transgender legal organizations. The LGBT Bar promotes justice in and through the legal profession for the LGBT community in all its diversity. This case stands to impact our membership both professionally and personally. Our members are of all different races, ethnicities, and religious affiliations. We see this intersectionality of our members every day, and fear a detrimental impact should the respondent be successful in this case.

NNABA is the oldest and largest association of predominantly Native American attorneys in the United States. Founded in 1973 when the first group of Native American attorneys was entering the legal profession, NNABA represents the interests of approximately 2,700 Native American attorneys. NNABA's core mission since its inception has been to promote the development of Native American attorneys who share the communal responsibility of advancing justice for Native Americans. NNABA seeks to ensure that the government does not become a partner in advancing harmful racial slurs.

SUMMARY OF ARGUMENT

Amici know all too well what it means to be excluded from full participation in society. When this exclusion is committed by a private individual or entity, we can explain to our children that these are actions by private actors and we can even see if there is recourse to federal, state, and local laws that might provide some relief. But when the government itself participates in the exclusion by conferring benefits to private actors, we are at a loss as to what to tell our children. Private acts and expressions of racism can be terrible and damaging, but they take on a wholly different meaning and are particularly corrosive to our ideal of an integrated society when they occur with the sanction of government.

Simon Tam would have this Court believe that this case is about political speech—that his re-appropriation project is about "taking on/back" a derogatory term that has been used to demean those of Asian American descent. But that is not what this case is about. This case is about a trademark. To put a more fine point on it: this case is about the registration of a trademark.

Trademarks, by their very nature, propose a commercial transaction that identifies the source of goods or services being offered. It is precisely because of their commercial nature that Congress has authority to regulate the trademark registration system. In doing so, Congress seeks to both protect consumers and to ensure the orderly flow of commerce. But marks that disparage do not further either of these goals. In fact, they do the opposite by discouraging consumers from full market

participation. As this Court well remembers, racial discrimination has a depressing effect on the economy. Thus, while the REDSKINS may be a professed homage to the noble savage for some, it is a painful reminder for Native Americans of their place in American society. *The Slants* is no better. While empowering to a young social justice rock band, that same mark may be debilitating for those who remember life in American internment camps during World War II. At its core, Section 2(a) does not operate as a ban on certain types of speech, but rather a mechanism for dealing with the harmful effects of racial, national origin, and religious discrimination on interstate commerce.

There can be no doubt that even without registration, Simon Tam can still use his mark and his music to "take on" stereotypes about Asian Americans. But what he cannot do is use the government's resources to prevent others from fully participating in the American marketplace. Reversing the decision below would prevent the trademark registration program from transforming what is clearly commercial speech into something more. But it surely will not prevent Mr. Tam from continuing his re-appropriation project.

ARGUMENT

A. Congress and this Court have recognized that racial discrimination threatens the government's substantial interest in ensuring the orderly flow of commerce.

Not too long ago—in fact, within the lifetime of our country's President—businesses were allowed to

freely express racially discriminatory commercial messages. Signs like "WHITE ONLY" affixed outside a business's entrance were not uncommon. In the Southwest, before entering a business one might read a sign that read "NO DOGS NEGROS MEXICANS." In other parts of the country, some businesses discriminated against Native Americans ("NO BEER SOLD TO INDIANS"), and others targeted Filipinos ("POSITIVELY NO FILIPINOS ALLOWED").

The deleterious effects of racism on commerce and individual dignity have been undisputed for the past half-century. Laws banning discrimination in public accommodations, such as Title II of the Civil Rights

Act of 1964[2] and Washington state's Law Against Discrimination,[3] were enacted "to vindicate 'the deprivation of personal dignity that surely accompanies denials of equal access to public establishments.'"[4] These laws were enacted to ensure that state power to regulate commerce was used to combat the effects of racial discrimination, not profit from them.

Title II's legislative history reveals that Congress's primary intent in enacting the law was to address the deleterious effects of racism on commerce and personal dignity.[5] As this Court explained in upholding Title II, the congressional record is "replete with testimony of the burdens placed on interstate commerce by racial discrimination." *Katzenbach* v. *McClung*, 379 U.S. 294, 299 (1964). The Court also cited "many references" to racial discrimination causing "a depressant effect on general business conditions in the respective communities," noting that this discrimination "deterred professional, as well as skilled, people from moving into areas where such practices occurred and thereby caused industry to be

---

[2] 42 U.S.C. 2000a.

[3] Wash. Rev. Code § 49.60.

[4] *Heart of Atlanta Motel, Inc.* v. *United States*, 379 U.S. 241, 250 (1964) (quoting S. REP. NO. 88-872, at 16-17 (1964), *reprinted in* 1964 U.S.C.C.A.N. 2355, 2370); Wash. Rev. Code § 49.60.010 (recognizing that race and sexual orientation discrimination "threatens not only the rights and proper privileges of its inhabitants but menaces the institutions and foundation of a free democratic state").

[5] S. REP. NO. 88-872, at 16-17 (1964), *reprinted in* 1964 U.S.C.C.A.N. 2355, 2370.

reluctant to establish there." *Id.* at 300. The Court thus found "ample basis" to conclude that commerce was adversely "obstructed" "because of [racial] discrimination." *Id.*

As Martin Luther King, Jr. explained in his *Letter from a Birmingham Jail*, racism in commerce inflicts a devastating toll on people of color, who have to explain to their children why they are being treated differently:

> [Y]ou suddenly find your tongue twisted and your speech stammering as you seek to explain to your six-year old daughter why she cannot go to the public amusement park that has just been advertised on television, and see tears welling up in her eyes when she is told that Funtown is closed to colored children, and see the depressing clouds of inferiority begin to form in her little mental sky . . . .[6]

The corrosive impacts of racial discrimination are not limited to conduct in the public accommodations context. Discriminatory *speech* in commerce can have similar impacts. That is why, for example, Title VIII of the Civil Rights Act prohibits advertisements that communicate a discriminatory preference. See 42 U.S.C. 3604(c) (unlawful to "make, print, or publish . . . any notice, statement, or advertisement, with respect to the sale or rental of a dwelling that indicates any preference, limitation, or

---

[6] Martin Luther King, Jr., *Letter from a Birmingham Jail* 6-7 (Apr. 16, 1963), *reprinted in* WHY WE CAN'T WAIT 76 (1964).

discrimination based on race, color, religion, [or] sex"). And Title VII places similar restrictions on job advertisements. See 42 U.S.C. 2000e-3(b) (unlawful "to print or publish . . . any notice or advertisement relating to employment . . . indicating any preference, limitation, specification, or discrimination, based on race, color, religion, sex, or national origin").

Back in the 1960s, in a not-so-distant echo of the arguments being raised in this case, defenders of racial discrimination challenged state and federal laws banning discrimination in commerce under the First Amendment. But none of those challenges succeeded, and by 1964 "the constitutionality of such state statutes [stood] unquestioned."[7]

Dissenting in the opinion in this case below, Judge Reyna poses the hypothetical of a restaurant named "Spics Not Welcome." If the restaurant nevertheless served Latinos, it presumably would not be in violation of Title II. Yet he notes that "[t]he mere use of the demeaning mark in commerce communicates a discriminatory intent as harmful as the fruit produced by discriminatory conduct." *In re Tam*, 808 F.3d 1321, 1380 (Fed. Cir. 2015) (Reyna, J., dissenting), cert. granted sub nom., *Lee* v. *Tam*, No. 15-1293, 2016 WL 1587871 (U.S. Sept. 29, 2016). Judge Reyna is right.

Unfortunately, these examples are not anachronisms or implausible hypotheticals. Recently, gun shops in several states have placed

---

[7] *Heart of Atlanta*, 379 U.S. at 259-60 & n.8 (listing states); see also *In re Johnson*, 71 Wash. 2d 245 (1967) (rejecting constitutional challenges to Washington's statute).

signs on their stores that proclaim that the stores are "Muslim Free Zone[s]."

The owner of one of the stores, Florida Gun Supply, states, "My goal is to make sure they don't feel welcome here so I don't have the need to discriminate in the first place."[8] In this way, the owner is able, through commercial speech, to accomplish that which he could not do through direct denial of service.[9]

The businesses that put up these signs accomplish exactly what they set out to do: they erect, through commercial speech, a discriminatory wall that shuts

---

[8] *Fight over Florida gun store's 'Muslim free zone' is far from over*, WJHL.COM (Dec. 5, 2015), http://wjhl.com/2015/12/05/fight-over-florida-gun-stores-muslim-free-zone-is-far-from-over/.

[9] In a similar fashion, an Indiana legislator conceded that Indiana's Religious Freedom Restoration Act would permit businesses to put up signs that say "No Gays Allowed." Adalia Woodbury, *Indiana Lawmaker Admits "No Gays" Signs Will Be Allowed*, POLITICUSUSA (Mar. 30, 2015), http://www.politicususa.com/2015/03/30/connecticut-state-boycottindianas-rfra.html.

off commerce to a class of individuals on the basis of their race, national origin, or religion. In other words, they accomplish through commercial speech precisely what the Civil Rights Act was designed to root out.

The elders in *amici*'s respective organizations are all too familiar with confronting signs that marked certain parts of the marketplace as being off limits to them and their children. *Amici* have worked too hard to fight for and win the right to fully participate and enjoy the fruits of a desegregated marketplace.

But under the theory espoused by the decision below, blatantly discriminatory signs could not be denied federal registration under the Lanham Act. In fact, if the decision below stands, "Spics Not Welcome" could become a federally protected trademark. And if that happens, the Latino father—like the black father described in Dr. King's letter—would have to explain to his daughter, "tongue twisted and [his] speech stammering," why these signs are not only allowed in modern-day America, but also coated with the legitimacy of a federally approved trademark.

B. Section 2(a) advances the government's substantial interest in ensuring the orderly flow of commerce.

"The intent of [the Lanham Act] is to regulate commerce[.]" 15 U.S.C. 1127. Trademarks are "a form of commercial speech and nothing more." *Friedman* v. *Rogers*, 440 U.S. 1, 11 (1979). Trademarks are used to "propos[e] a commercial transaction" by identifying the source of goods or

services. *Cent. Hudson Gas & Elec. Corp.* v. *Pub. Serv. Comm'n of New York*, 447 U.S. 557, 562 (1980).

Because trademarks are commercial speech, the government can deny or cancel registration if doing so advances a substantial government interest, such as the orderly flow of commerce. See *id.* at 564. By that standard, Section 2(a) easily passes constitutional muster because it is a content neutral regulation that promotes the orderly flow of commerce.

1. *Section 2(a) is a content neutral regulation of commercial speech.*

i. The government can regulate trademarks to promote the orderly flow of commerce because "the Constitution accords less protection to commercial speech than to other constitutionally safeguarded forms of expression." *Bolger* v. *Youngs Drug Prods. Corp.*, 463 U.S. 60, 64-65 (1983). That is why the government can ban deceptive trademarks. *Friedman*, 440 U.S. at 13. And it is precisely because trademarks are commercial speech and the government has a substantial interest in "insuring that the stream of commercial information flow[s] cleanly as well as freely," *Va. State Bd. of Pharmacy* v. *Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 771-72 (1976), that the government can set up a federal trademark registry in the first place.

At its core, a trademark restricts other commercial speech by ensuring that certain speakers

have a limited monopoly over the use of a particular message. That is the essence of a trademark.[10]

ii. But the same interest that gives rise to the government's power to register trademarks—the orderly flow of commerce—also allows the government to regulate trademarks. And that is why Section 2(a) is content neutral. The "principal inquiry" for determining whether a law is content neutral is "whether the government has adopted a regulation of speech because of disagreement with the message it conveys." *Ward* v. *Rock Against Racism*, 491 U.S. 781, 791 (1989). In other words, in determining whether a law is content neutral, "[t]he government's *purpose* is the controlling consideration." *Id.* (emphasis added). See also *Sorrell* v. *IMS Health Inc.*, 564 U.S. 552, 566 (2011) (*Ward* test applies to commercial speech).

In *Ward*, the Court upheld restrictions on sound amplification at an outdoor bandshell, because the "[t]he principal justification for the sound-amplification guideline is the city's desire to control noise levels at bandshell events, in order to retain the character of the [adjacent] Sheep Meadow and its more sedate activities." 491 U.S. at 791. The Court made clear that a regulation that "serves purposes unrelated to the content of expression is deemed

---

[10] The decision below erroneously conflates commercial and political speech, reasoning that if a trademark has any relation to a political message, it must be afforded full First Amendment protections. But that simply creates a giant loophole to the rule that commercial speech is treated differently, and would open the door to companies adopting quasi-political messages to avoid the regulations (e.g., against deceptive advertising) that would normally apply only to commercial speech.

neutral, even if it has an incidental effect on some speakers or messages but not others." *Id.* at 791-92.

Ward built off the Court's decision in *City of Renton* v. *Playtime Theatres, Inc.*, 475 U.S. 41 (1986). The regulation at issue in Renton explicitly treated "adult" movie theaters differently from other theaters, and defined "adult" theaters solely by reference to the content of their movies. *Id.* at 44. Nevertheless, the Court treated the zoning regulation as content neutral because the ordinance was aimed at the secondary effects of adult theaters, a justification unrelated to the content of the adult movies themselves. *Id.* at 48. See also *City of Erie* v. *Pap's A.M.*, 529 U.S. 277, 296 (2000) (concluding that a regulation is "still properly evaluated as a content-neutral restriction" if the government's "interest" is in "combating the secondary effects . . . unrelated to the suppression of the [message]"); *Osborne* v. *Ohio*, 495 U.S. 103, (1990) (regulating private speech associated with child pornography given the secondary effects of the speech). Taken together, even if a regulation implicates content, that regulation is still subject to intermediate scrutiny so long as the government's purpose is to address the secondary effects of the speech.

Here, the government's purpose under Section 2(a) is not to suppress speech, but to ensure the orderly flow of commerce. See 15 U.S.C. 1127 ("The intent of this chapter is to regulate commerce[.]"). Racially discriminatory commercial speech disrupts the orderly flow of commerce to a substantial degree. The purpose of Section 2(a) is to ward off those secondary effects, an interest which is

unrelated to the suppression of any speech. That is why Congress passed—and this Court has repeatedly upheld—laws like the Civil Rights Act.

Thus, under Section 2(a), the government's concern is not whether it approves of the message conveyed by a particular mark, but whether a particular mark disrupts commerce by, for example, inciting racial hatred or inflicting dignitary harm. In effect, Section 2(a) is a rather quotidian time, place, and manner restriction, similar to laws regulating adult businesses,[11] or laws regulating speech because of its secondary effect on commerce.[12]

In addition to prohibiting registration of marks which may disparage institutions or groups, Section 2(a) also prohibits registration of marks that are likely to cause confusion among consumers, implicate their privacy interests, or are otherwise misleading or deceptive—all things likely to harm consumers or impact their ability and desire to participate fully in commerce. See 15 U.S.C. 1052.

Just like marks that confuse or mislead consumers, or marks that invade consumer privacy, marks that disparage individual or group identities have the effect of decreasing full consumer participation in commerce while also sending the message that the government is a participant in endorsing, advancing, and promoting that behavior.

---

[11] See, *e.g.*, *Pap's A.M.*, 529 U.S. 277 (2000) (upholding ban on fully nude dancing).

[12] See, *e.g.*, *Turner Broad. Sys., Inc.* v. *F.C.C.*, 512 U.S. 622, 647 (1994) (affirming F.C.C.'s must-carry regulations because they furthered the substantial government interest in "protecting noncable households from loss of regular television broadcasting service" (citation omitted)).

Section 2(a) alleviates these harms and directly advances the government's interests in distancing itself from racial discrimination thereby discouraging the perpetuation of racial discrimination in commerce and encouraging full participation by all consumers in commerce.[13] A number of commercial speech cases have recognized substantial interests that are unavoidably entangled with government disapproval of a certain message.[14] Here, Section 2(a)'s primary purpose of ensuring the orderly flow of commerce also coincides with the government's substantial interest in discouraging racial, social, and religious discord.[15]

---

[13] See *Sambo's Rests., Inc.* v. *City of Ann Arbor*, 663 F.2d 686, 695 (6th Cir. 1981) (noting that "racial harmony and equality is a substantial state interest").

[14] See, *e.g.*, *Posadas de Puerto Rico Assocs.* v. *Tourism Co. of Puerto Rico*, 478 U.S. 328, 341 (1986) (discouraging gambling); *Ohralik* v. *Ohio State Bar Ass'n*, 436 U.S. 447, 466-67 (1978) (regulating in-person attorney solicitation).

[15] See *R.A.V.* v. *City of St. Paul*, 505 U.S. 377, 395 (1992) (recognizing that "help[ing] to ensure the basic human rights of members of groups that have historically been subjected to discrimination, including the right of such group members to live in peace where they wish" is a compelling state interest); *Regents of Univ. of Cal.* v. *Bakke*, 438 U.S. 265, 396 (1978) (Marshall, J., concurring) ("In light of the sorry history of discrimination and its devastating impact on the lives of Negroes, bringing the Negro into the mainstream of American life should be a state interest of the highest order."); *Ostergren* v. *Cuccinelli*, 615 F.3d 263, 277 (4th Cir. 2010) ("[A]lthough a state government might practice racial discrimination for decades—and many have—we would not therefore be barred from considering racial equality a state interest of the highest order." (citing *Bakke*, 438 U.S. at 396)); *Sambo's Rests., Inc.*, 663 F.2d at 695.

Because the government's interest is not to suppress speech but to promote the orderly flow of commerce, Section 2(a) is content neutral.

iii. The importance of this interest is perhaps best evidenced by the policies implemented by the U.S. Board of Geographic Names.[16] Dead Negro Draw, Texas, ostensibly honors black soldiers who died during a battle, except that until the U.S. Board of Geographic Names intervened, it was called Dead Nigger Creek on federal maps.[17] Over 30 place names in America were originally called "Niggerhead" on federal maps, but most of those names were changed to swap out "Nigger" for Negro, such as Negro Ben Peak, Arizona—"named after a miner known as 'Nigger Ben McClendon.'"[18]

As late as 1974, there were 200 place names on federal maps that still referenced "Japs," and even today there are 30 places on federal maps named "Chinaman."[19] And until last year, a lake and creek in Washington were called Coon Lake and Coon Creek, respectively, on federal maps.

---

[16] Donald J. Orth & Roger L. Payne, *Principles, Policies, and Procedures: Domestic Geographic Names*, U.S. BD. OF GEOGRAPHIC NAMES 21-22 (1997), http://geonames.usgs.gov/docs/pro_pol_pro.pdf.

As discussed above, Title II of the 1964 Civil Rights Act is another strong example of the government disavowing harmful racial discrimination in commerce.

[17] Jennings Brown, Tal Reznik, & Matan Gilat, *Racial Slurs Are Woven Deep Into The American Landscape*, VOCATIV (Oct. 29, 2015), http://www.vocativ.com/news/244179/racial-slurs-are-woven-deep-into-the-american-landscape/.

[18] *Id.*

[19] *Id.*

It goes without saying that a black family would be reticent to visit a place called Niggerhead. Just like a Japanese mother is unlikely to take her son to a park called Jap Point. And those feelings were made all the worse because until relatively recently the federal government approved those names and published them on its maps.

This shows that when the government creates programs like the federal trademark registry or publishes maps, it may decline to allow others to use the programs in a manner that contributes to discrimination. Of course, individuals are free to call these locations whatever they want—just like they are free to use whatever trademark they want—but the government is under no obligation to help spread hatred, given the effects it has on commerce.

2. *Being denied federal registration has not prevented Tam from continuing to use a racial slur for his band's name.*

Amici are all too familiar with the sting of slurs such as "slant," "chink," "gook," "sand nigger," and the like. These taunts are not limited to the schoolyard. Racial slurs and epithets often accompany racialized violence. In 1982, a white Detroit autoworker called Vincent Chin a "Chink" and "Nip" before beating Chin to death with a baseball bat. In 1992, Luyen Phan Nguyen was killed in Coral Springs, Florida, by a group of white men who followed Nguyen from a party after Nguyen objected to the use of a racial slur. In 2001, Balbir Singh Sodhi was killed in Mesa, Arizona, by a gunman who had been overheard previously at a bar saying he wanted to kill "ragheads."

Simon Tam has used a racial slur as his band's name since 2006. This usage has created a protectable trademark and he could enforce his common law rights in federal court. This usage persisted even after his application for federal registration was denied in 2013. The denial of registration has not prevented him from continuing his proclaimed project to re-appropriate or reclaim this racial slur. [20] There is no extraneous consequence to a mark owner who uses a trademark that the federal government refuses to register. Mr. Tam can still call his band *The Slants*, and still register any other trademarks he wishes (so long as those trademarks independently qualify). In fact, Mr. Tam could still use the Lanham Act's other provisions to enforce his trademarks, registered or not.[21]

Put differently, engaging in speech that the government refuses to register as a trademark does not disqualify Mr. Tam from using the Lanham Act to register and enforce other trademarks, or even to enforce unregistered ones (like *The Slants*).[22] It is

---

[20] Reclamation projects sometimes fail spectacularly. Commenting on comedian Trevor Noah's failed attempt to reclaim the slur "kaffir," Kagiso Lediga said, "It was well spirited, and it came from a good place, trying to make it into a good word. But leave it alone." Norimitsu Onishi, *Jail Time for Using South Africa's Worst Racial Slur?*, N.Y. TIMES (Oct. 27, 2016), http://www.nytimes.com/2016/10/28/world/africa/south-africa-hate-speech.html?_r=0.

[21] See 15 U.S.C. 1125(a).

[22] See, *e.g.*, *Specialized Seating, Inc.* v. *Greenwich Indus., L.P.*, 616 F.3d 722, 728 (7th Cir. 2010) (noting that cancellation of registration "does not affect the mark's validity, because a trademark need not be

simply a narrow limitation on Mr. Tam's ability to force the government to publish this one mark in the federal register.

3. *The cancellation of the* REDSKINS *trademark registration illustrates the importance of Section 2(a).*

Race still matters in this country. For many, that is not an easy concept to accept, given how far removed we are from the Trail of Tears, slavery, and Jim Crow. But the vestiges of racism are all around us. This case is just one example.

There are others, too. One of the most visible examples of a racist trademark is the one used by the WASHINGTON REDSKINS football team. For decades this team has called itself by a racial slur, and until recently that slur had a federal seal of approval in the form of a registered trademark. But recently, the government decided to cancel the registration of several of the team's trademarks, finally recognizing what so many already knew: that the term redskin is a racial slur, and should never have been allowed into the federal registry. The issue is currently before the Fourth Circuit. As applied to the particular trademarks at issue in the two cases, the question there is the same as the one presented here: whether the government can, consistent with the First Amendment, refuse to register a racially disparaging trademark. Here, however, the court below imposed the far more sweeping remedy of

---

registered to be enforceable"); *Volkswagenwerk Aktiengesellschaft* v. *Wheeler*, 814 F.2d 812, 819 (1st Cir. 1987) ("[T]he cancellation of a trademark registration does not extinguish common law rights that registration did not create.").

facial invalidation of a federal statute. Applying such "strong medicine," *Broadrick* v. *Oklahoma*, 413 U.S. 601, 613, the *en banc* Federal Circuit essentially held that *no* trademark—no matter how offensive or denigrating to racial groups, can be refused the benefits that accompany federal registration.

The REDSKINS example informs how the Court should approach this case. Even if the Court were to decide that Section 2(a) is unconstitutional as applied to Mr. Tam, it should not find Section 2(a) unconstitutional on its face. The REDSKINS trademark is perhaps the foremost example of the impact that a racially disparaging trademark has on commerce. The mark is known worldwide, and its use pervades every corner of our society. As the REDSKINS case shows, this provision stands as an important bulwark against a flood of racially discriminatory marks that would severely and negatively affect commerce, particularly for people of color.

Amici use the REDSKINS example in this brief to show the Court that the government can, consistent with First Amendment principles, cancel or refuse to register a racially disparaging trademark given the substantial interest in an orderly flow of commerce. The REDSKINS case exemplifies the magnitude of impact that disparaging marks can have on commerce, and it shows why we still need Section 2(a).

i. For centuries Native Americans[23] have been arguably the most marginalized group in the United States. While the efforts of other racial groups to overcome their respective marginalization are far from over, in some ways the Native American community is still just beginning. Among major ethnic and racial groups in America, Native Americans rank at or near the bottom in income per capita, high school graduation rates, and political representation, and suffer from the highest poverty and unemployment rates. The child born in America with the lowest probability of ever achieving self-determination is the Native American child. And unfortunately that statement has been true for a very long time.

It is against this historical backdrop of marginalization that a $2.85 billion professional sports team has proudly used a racial slur against Native Americans as its team name. The word "redskins" was around long before Pro-Football, Inc. ("PFI" or the "Team") adopted it as its name, logo, and mascot. But it has always been clear that the term has been used to dehumanize a group of human beings living in America.

Like calling African Americans "niggers" and Latinos "spics"—words that long ago fell out of favor in common lexicon precisely because of their negative effects on those groups—Native Americans have suffered the indignity of being called "redskins" by

---

[23] *Amici* use the term Native Americans throughout this brief to refer interchangeably and collectively to American Indian, Alaska Native, and Native Hawaiian peoples.

those who would diminish their humanity.[24] The main difference, however, is that Native Americans *continue* to suffer this indignity in the common lexicon. PFI would never call itself the "Washington Spics," and then have the audacity to argue that doing so is okay because there is no proof that a "substantial composite" of Latinos find that term offensive. Nor would the National Football League ("NFL") permit such a name—it penalizes use of racially derogatory language on the field as unsportsmanlike conduct.[25]

ii. The term "'redskin' was first used as a reference to American Indian people at a time when [they] were hunted for bounty and a price was paid for a red skin."[26] It is "to Indian people what 'nigger' is to African Americans."[27]

---

[24] *Amici* recognize the odious, abhorrent, and offensive nature of these racist slurs, even when they appear in a legal brief that describes their harm and repudiates them. Nevertheless, *amici* use the slurs themselves, rather than their abbreviations, not to be incendiary or exploitative, but to demonstrate a point: as a society, we are far more uncomfortable with certain slurs, such as those that discriminate against African Americans and Latinos, whereas the slur against Native Americans is almost quotidian.

[25] Roger Goodell, *2016 Official Playing Rules of the National Football League*, NFL 54-55 (2016), http://operations.nfl.com/ media/2224/2016-nfl-rulebook.pdf; see also Jonathan Jones, *Foul Language: The NFL is cracking down on the use of the N-word on the football field*, SPORTS ILLUSTRATED (Oct. 26, 2016), http://www.si.com/nfl/2016/10/26/nfl-n-word-penalty-unsportsmanlike-conduct (describing the NFL's recent history of imposing 15-yard penalties on players who use the n-word).

[26] Note, *A Public Accommodations Challenge to the Use of Indian Team Names and Mascots in Professional Sports*, 112 HARV. L. REV. 904, 912 n.64 (1999) (quoting Letter from Lawrence R. Baca, Chairman, Indian Law Section of the Federal Bar Association, to John Hope

It is unlikely that when the Team adopted the name "redskins" in 1932 that it was doing so as an homage to Native Americans, and far more likely that it reflected racial animus. In fact, the next year the Team's owner, "George Preston Marshall instituted what would become a 13-year league-wide ban on African-American players from the NFL."[28] And, as the rest of the NFL integrated in response to the Civil Rights Movement, the Team remained the last holdout, clinging to segregation until the bitter end.

It took 30 years—until 1962—for the Team to integrate and finally accept its first non-white players, the last NFL team to do so. But not because the Team suddenly changed its mind about racial discrimination: "[i]n contrast to other N.F.L. owners, [Team owner] Marshall 'did not pretend there were no blacks good enough to make his team,'. . . 'he was honest enough to admit that he simply didn't want them around.'"[29]

Franklin, Chairman, President's Advisory Board on Race Relations 2 (June 30, 1997) (on file with Harvard Law School Library)) (HEREINAFTER "*Indian Team Names*").

[27] *Id.* at 912 n.65 (quoting Lawrence R. Baca, What About the Indian Country "N" Word? 2 (Nov. 17, 1998) (unpublished manuscript) (on file with Harvard Law School Library)).

[28] *Ending the Legacy of Racism in Sports & the Era of Harmful "Indian" Sports Mascots*, NAT'L CONG. OF AM. INDIANS 2 (Oct. 2013), http://www.ncai.org/attachments/PolicyPaper_mijApMoUWDbjqFtjAYzQWlqLdrwZvsYfakBwTHpMATcOroYolpN_NCAI_Harmful_Mascots_Report_Ending_the_Legacy_of_Racism_10_2013.pdf.

[29] Ryan Basen, *Fifty Years Ago, Last Outpost of Segregation in N.F.L. Fell*, N.Y. TIMES (Oct. 6, 2012),

In fact, and particularly relevant here, the reason the Team desegregated and began signing non-white players was because "[t]he Redskins were preparing to move into a new stadium being built on federally controlled land affiliated with the national parks system," and the government stipulated that the Team had to integrate to use the new stadium.[30] In other words, for the sole purpose of taking advantage of a discretionary federal benefit, did the Team finally integrate. And even then, only begrudgingly as the Team's owner lamented that "the government had the right to tell a showman how to cast the play."[31]

Half a century later, the Team's decision to cling to its racist name is consistent with its discriminatory past. But this time, the Team wants to bootstrap its racist name to another discretionary federal program: the trademark registry.

iii. The government's decision to decline to register racist slurs makes sense for all the same reasons that the government regulates discrimination in public accommodations and geographic place names—because the harms of disparagement in commerce are real. "Indian team names and mascots in particular have been charged with fostering 'racial stereotyping,' causing low self-esteem amongst American Indians, and setting up

---

http://www.nytimes.com/2012/10/07/sports/football/50-years-ago-redskins-were-last-nfl-team-to-integrate.html.

[30] *Id.*

[31] *Id.*

Indian children as targets for physical harassment by their peers."[32] And that's not all:

> The studies suggest that American Indian mascots have harmful psychological consequences for the group that is caricaturized by mascots. This is true whether . . . the mascot represented an American Indian university, a mainstream university, or a professional sports team.
>
> . . . .
>
> American Indian mascots thus remind American Indians of the limited ways in which others see them. Moreover, because identity construction is not solely an individual process (i.e., you cannot be a self by yourself), the views of American Indians held by others can also limit the ways in which American Indians see themselves.[33]

The bombardment of slurs has a lasting negative effect on Native Americans, not only "threaten[ing] the psychological functioning of American Indians" but also "facilitating the expression of discriminatory and explicitly racist attitudes toward American

---

[32] *Indian Team Names*, supra n.26, at 911 (footnotes omitted).

[33] Stephanie A. Fryberg, et al., *Of Warrior Chiefs and Indian Princesses: The Psychological Consequences of American Indian Mascots*, 30 BASIC & APPLIED SOC. PSYCHOL. 208, 216 (2008).

Indians" by non-Native people. [34] As Professor Steinfeldt explained to Congress:

> Having a cultural icon like Chris Berman provide colorful commentary on Washington's pro football team doesn't mean that such a hateful racial [epithet] (i.e., Redskin) doesn't hurt people—rather, it means that the people using this hateful term have become desensitized to the fact that they are hurting people with their historical tradition of dishonor. Despite how members of mainstream society want to frame the issue, this is NOT an issue of mere sensitivity, offensiveness, or "political correctness." Rather this is an issue involving oppression, stereotyping, and inflicting psychological harm[.][35]

Indeed, the human costs of racism that Dr. King described are not limited to those contexts where an accommodation is denied. If a hotel clerk begrudgingly accepts African-American and Native American patrons, but calls each one a "nigger" and

---

[34] *Stolen Identities: The Impact of Racist Stereotypes on Indigenous People: Hearing Before the S. Comm. on Indians Affairs* 112th Cong. 69 (2011) (prepared statement of Jesse A. Steinfeldt, Assistant Professor, Indiana University-Bloomington).

[35] *Id.*; see also *APA Resolution Recommending the Immediate Retirement of American Indian Mascots, Symbols, Images, and Personalities by Schools, Colleges, Universities, Athletic Teams, and Organizations*, AM. PSYCHOLOGICAL ASS'N (2005), http://www.apa.org/about/policy/mascots.pdf (citing many studies finding psychological harm of exposure to negative stereotypes).

a "redskin," those harms are not cut off at the front desk; a father is still left with the unenviable task of explaining to his daughter, "tongue twisted and [his] speech stammering," why a business is permitted to register those terms and why they are still accepted as normal parlance in 2016.[36] Likewise, if hotels (and sports teams) admit minorities, but use names like "Redskins Inn," "Nigger Inn," or "Spic Inn"—and even get such names federally registered as trademarks—the impact is similar to a denial of public accommodations.

iv. Given this history, the government finally canceled the registration of several of the Team's trademarks, correctly finding that they are racist and contrary to the government's interest in promoting orderly and non-discriminatory commerce. *Pro-Football, Inc.* v. *Blackhorse*, 112 F. Supp. 3d 439, 461 (E.D. Va. 2015).

Canceling registration of the REDSKINS trademark did not restrict PFI's speech. The Team can still sell hats, jerseys, and footballs bearing its racist name. Cancellation simply means the government will not affirmatively allow its own program to be used to endorse, promote, or subsidize PFI's ability to capitalize on its mark. This Court has repeatedly held that the government can decline to subsidize

---

[36] *See Jones* v. *City of Boston*, 738 F. Supp. 604, 605 (D. Mass. 1990) (noting that calling patron a "nigger" at a bar—despite serving him—still satisfies the Title II requirement "of showing that he was denied equal access to a place of public accommodation on the basis of race" because "[t]he term 'nigger' is intimidating by its very nature").

certain speech.[37] That is especially true in the commercial context where the government has a substantial interest in promoting a non-discriminatory flow of commerce.

But the decision below creates a world where "Spics Not Welcome" and "Muslim Free Zone" could be registered as federal trademarks, and the WASHINGTON REDSKINS could remain a federally registered trademark. And so, should the decision below stand, the Native American father must still explain to his daughter why it remains acceptable for others to think nothing of calling their people "redskins" on SportsCenter, and why the federal government has approved and endorsed the use of its ® next to a slur and done nothing to distance itself from such racial discrimination.

We have come too far to take such a big step back.

CONCLUSION

Refusing federal registration of Simon Tam's disparaging mark may not eliminate the derogatory term from the American lexicon. Indeed, it will not deter Simon Tam from using the term for his re-

---

[37] See *Regan* v. *Taxation With Representation of Wash.*, 461 U.S. 540, 546 (1983) ("We again reject the notion that First Amendment rights are somehow not fully realized unless they are subsidized by the State." (citation and quotation marks omitted)); *Ysursa* v. *Pocatello Educ. Ass'n*, 555 U.S. 353, 359 (2009) ("[T]he State's decision not to [provide deductions for union dues] is not an abridgment of the unions' speech; they are still free to engage in such speech as they see fit. They simply are barred from enlisting the State in support of that endeavor."); *Lyng* v. *UAW*, 485 U.S. 360, 366 (1988) (rejecting First Amendment challenge to law barring certain workers who are on strike from receiving food stamps).

appropriation project. But these facts should not prevent the government from refusing to use its resources for activity that deters rather than promotes commerce. *Amici* respectfully request that the Court reverse the decision below.

Respectfully submitted.

WILLIAM C. RAVA
Counsel of Record
ELVIRA CASTILLO
DAVID A. PEREZ
CARA WALLACE
DANE WESTERMEYER
PERKINS COIE LLP
1201 Third Avenue, Suite 4900
Seattle, WA 98101-3099
206.359.8000
WRava@perkinscoie.com

ROBERT S. CHANG
FRED T. KOREMATSU CENTER FOR LAW AND EQUALITY
901 12th Avenue
Seattle, WA 98122
(206) 398-4025
changro@seattleu.edu

NOVEMBER 16, 2016

RECORD AND BRIEFS

No. 15-1293

FILED
DEC 16 2016
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

AMICUS CURIAE PROFESSOR HUGH C. HANSEN IN SUPPORT OF RESPONDENT

HUGH C. HANSEN
Counsel of Record
FORDHAM UNIVERSITY SCHOOL OF LAW
150 West 62nd Street
New York, New York 10023
(212) 636-6854
hansenhugh@gmail.com

Counsel for Amicus Curiae

269961

TABLE OF CONTENTS

Page

TABLE OF CONTENTS. i

TABLE OF CITED AUTHORITIES ii

INTEREST OF THE *AMICUS CURIAE* 1

NOTE ABOUT THIS *AMICUS CURIAE* BRIEF 2

SUMMARY OF ARGUMENT 3

ARGUMENT. 9

I. The actual role of Courts in free speech cases has been to determine how much speech should be protected and in what manner. 9

II. The use of trademarks for expressive content is an important nascent marketplace for the reception and debate of ideas. 10

III. Elimination of the current disparagement regime would be a plus not a drawback 12

IV. By determining what marks individuals and groups may use to define themselves, the government is restricting self-expression and depriving them of personal autonomy 14

V. There is significant harm to mark owners who have been denied registration 17

CONCLUSION 19

TABLE OF CITED AUTHORITIES

Page

Cases

44 Liquormart, Inc. v. Rhode Island,
517 U.S. 484 (1996) 15

Abrams v. United States,
250 U.S. 616 (1919) 3, 10

Cohen v. California,
403 U.S. 15 (1971) 15

Huber Baking Co. v. Stroehmann Brothers Co.,
252 F.2d 945 (2d Cir. 1958) 18

In re McGinley,
660 F.2d 481 (C.C.P.A. 1981) 12

In re Tam,
785 F.3d 567 (Fed. Cir. 2015) 8

In re Tam,
808 F.3d 1321 (Fed. Cir. 2015) 8, 12

Procunier v. Martinez,
416 U.S. 396 (1974) 7, 15

Ritchie v. Simpson,
170 F.3d 1092 (Fed. Cir. 1999) 8, 17

Cited Authorities

Page

Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc., 425 U.S. 748 (1976) 15

Statutes and Regulations

15 U.S.C. § 1052 ..... *passim*

15 U.S.C. § 1127 18

Additional Authorities

First Amendment to the U.S. Constitution ..... *passim*

Sup. Ct. R. 37.6 1

Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the Committee on Patents, 76th Cong., 1st Sess. (1939) 13

RANDALL KENNEDY, NIGGER: THE STRANGE CAREER OF A TROUBLESOME WORD (2008) 16

The New York Times, "Afro-American," Sec. A, p. 21, col. 2 (October 17, 1989) 16

INTEREST OF THE *AMICUS CURIAE*[1]

Professor Hugh C. Hansen is a law professor at the Fordham University School of Law where he is also the Founder and Director of the Fordham IP Institute and the Fordham Conference on Intellectual Property Law & Policy now in its 25th year. The conference has been called the "Davos of Intellectual Property" by the Director-General of the World Intellectual Property Organization based in Geneva. He is also Director of the Emily C. and John E. Hansen Intellectual Property Law Institute.[2]

He has taught intellectual property law for over 30 years and taught constitutional law for 25 years including a First Amendment course. Managing Intellectual Property Magazine has three times has named him one of the 50 most influential people in the world in IP.

As a result of two clerkships, litigation practice and over 30 years of teaching, Professor Hansen has developed a strong interest in approaching the law from a legal realist (lower case) perspective. He, with colleagues, is in

---

1. Pursuant to Rule 37.6, amicus curiae certifies that no counsel for a party authored this brief in whole or in part and that no person or entity, other than amicus and the Emily C. and John E. Hansen Intellectual Property Law Institute has made a monetary contribution to the preparation or submission of this brief. Further, amicus curiae certifies that both parties have given blanket consent to the filing of amici briefs; the written consent on file with the Clerk.

2. Prof. Hansen's affiliation is for identification purposes only. His views are his own. Neither this brief nor the decision to file it should be interpreted to represent the views of Fordham University School of Law or the Fordham IP Institute.

the process of editing a casebook on intellectual property law for West Publishing that includes, perhaps for the first time, this perspective.

Professor Hansen expects that this perspective will not be presented by others on this appeal. He thinks and hopes that the issues in this case will benefit from such an analysis. This is not meant to denigrate any other form of analysis but rather to add something of value which otherwise would not be before the Court.

NOTE ABOUT THIS *AMICUS CURIAE* BRIEF

This brief is a different type of submission from what one would normally see in litigation, and certainly different from ones I have previously written. The purpose is not to debate the doctrinal free speech First Amendment issues. For the view I espouse, I refer to the majority en banc opinion of the Federal Circuit and the brief of the Respondent in this appeal, both of which are excellent in their legal analysis.

I am submitting this to suggest another way of looking at this controversy, and the applicable law. I use cites very sparingly because either the points are generally accepted or the statements are for background and not central to the discussion. In addition, I am consciously trying to lighten the load by making this brief as short as possible.

I am a legal realist (again lower case) and my analysis will reflect this. This brief may or may not be of assistance. I submit it for what it is worth.

HCH

SUMMARY OF ARGUMENT

Introduction

In a case such as this in which there is a clear First Amendment violation, the U.S. government and many amici argue that it does not apply because to do so would, in effect, leave a lot of people feeling bad. Of course, you only need the First Amendment free speech right in situations where people might feel bad because of differing opinions, accusations and positions. You do not need it when everyone agrees and are in harmony. Feeling bad at times might be the price we pay of having free speech and open debate. Apparently, today we are not willing to pay that price and that is a problem.

To be honest, the actual right of free speech has never had many true friends. It receives plenty of lip service. We are generally in favor of it when we like the speech for which protection is sought but find reasons to avoid it when we do not.

We should not forget that Justice Holmes' strong defense of free speech in *Abrams v. United States* was offered in a dissenting opinion.[3]

Individual rights are normally the concern of elites. We get rights from the top down, not bottom up. But elites today are not even giving free speech lip service. For instance, none of the briefs in support of Petitioner that were available when this was written said anything positive about the free speech right. They treated it as any other doctrinal rule to be analyzed and overcome.

---

3. 250 U.S. 616, 624 (1919) (Brandeis, J. concurs).

Rather, today, elites are mostly concerned, not explicitly, with political correctness. Political correctness is not the province of any one group. Every group has some form of it. In fact, it can even start within the family unit. We have had it in some form probably as long as humans existed. In short, political correctness is us and we cannot avoid it.

Moreover, it is not intrinsically bad. It starts with a pure heart that some view or value is very important. The trouble starts over time when the original views or values cannot be challenged. As the group grows socially other penalties exist for non-adherence including the modern form of shunning. On a larger platform it adversely affects the democratic process.

In this country, in the past we had a mild form of political correctness. People with different views or in different groups interacted socially and politically. Today, in the U.S. political correctness is the worst it has ever been here and maybe the worst anywhere. Political correctness is the new tribalism. People in different tribes are demonized not debated. When you add the effect of social media, lives of the speaker and his or her family can be ruined based upon what is said. Free speech is severely penalized.

In this environment, it is safer not to think for yourself. As an act of self-preservation, it is better to support the "proper" tribal result and work backwards from that to create reasoning that keeps you safe.

Lee v. Tam will be remembered for a long time. It is the most important free speech case in many years. It

will decide whether we retreat further in to prohibited debate or instead strongly invigorate and support the public policies of free speech and debate.

The Federal Circuit en banc recognized this and ruled accordingly. It is now time for this Court to do so as well.

Argument

This case presents a clear cut First Amendment violation.

It is rare that a case doctrinally can have so clear a result as this one. The government chooses who are good guys and bad guys based upon views of the affected public who are allegedly disparaged. Then based upon that it decides whether to register a trademark. This is about the clearest violation of the free speech clause in the First Amendment one can imagine. There is no need to discuss this further here as there are the Federal Circuits excellent en banc decision and Respondent's excellent brief that provide specific arguments with which I wholly agree.

I. Actual role of courts in free speech cases.

There are many doctrinal tests used in First Amendment free speech cases. Ironically, the large number highlights the ad hoc nature of this jurisprudence. "New case, new doctrine" might be needed to explain a decision. In essence, there has been a common law approach which asks how much does the speech at issue need to be protected on these facts and in what manner? Based upon that test for the reasons given elsewhere in

this brief there is a strong need to allow expressive speech contained in trademarks.

II. Expressive trademarks such as Tam's can be an important part of the market place of ideas.

In our tribalized world with little or no incentive to engage in genuine debate or receive different ideas, no one can exclude ideas contained in trademarks such as THE SLANTS. They receive them without warning in the marketplace where they might actually consider the ideas on their merits – before they can jump-start their ideological protective screening. Moreover, they will normally receive them more than once.

Thus, the use of trademarks for expressive content is an important nascent marketplace for the reception and debate of ideas. Current construction of Section 2(a) effectively stifles this marketplace.

III. Elimination of the current disparagement regime would be a plus not a drawback.

There is no likely harm to the trademark system from this elimination. The concerns in the Law Professors Amicus Brief in Support of Petitioner relies upon a misguided and almost bizarre reading of footnote 1 of the decision which does not reflect anything in the opinion of the court, the briefing or argument of the parties, or commentaries after the case was decided.

The disparagement regime was created over 40 years after the enactment of the Trademark Act of 1946 and was not part of the intent of Congress. Its elimination would bring the Act back to Congress' original intent.

IV. By determining what marks individuals and groups may use to define themselves, the government is restricting self-expression and depriving them of personal autonomy.

As Justice Marshall observed:

> The First Amendment serves not only the needs of the polity but also those of the human spirit—a spirit that demands self-expression. Such expression is an integral part of the development of ideas and a sense of identity. To suppress expression is to reject the basic human desire for recognition and affront the individual's worth and dignity.

Procunier v. Martinez, 416 U.S. 396, 427 (1974) (Marshall, J., concurring). Contrary to these purposes, Section 2(a) interferes with the ability of individuals and groups to define themselves. Instead, it tasks USPTO trademark examiners with determining *for others* what is and is not disparaging *for them and others*.[4] Such paternalistic

4. There are numerous examples of minority groups attempting to register marks deemed to disparage the very group of which they are a part. However, many of these attempts are rejected or ultimately abandoned under the power of 2(a)'s disparagement clause. *See e.g.*, THE BIG HEEB BREWING COMPANY Serial No. 78/432,597, filed June 9, 2004; N.I.G.G.A. NATURALLY INTELLIGENT GOD GIFTED AFRICANS Serial No. 75/002,364, filed Oct. 6, 1995. The application was ultimately abandoned; BABY JAP by a Jewish woman for clothing. Serial No. 78/665,332, filed July 7, 2005. Rather than protecting the marginalized and subjugated, the U.S. government's bar on registration for such reappropriated marks condones their oppression.

regulation and suppression of speech, even in the commercial context, has been consistently discouraged.

V. There is significant harm to mark owners who have been denied registration.

Judge Plager of the Federal Circuit has noted that "the mark holder who is denied federal registration [because of Section 2(a)] will not receive the benefits conferred on a federal trademark registrant," *Ritchie v. Simpson*, 170 F.3d 1092, 1099 (Fed. Cir. 1999). Judge Moore, in her "additional views" *In re Tam*, 785 F.3d 567, 575-77 (Fed. Cir. 2015), and in her en banc opinion, 808 F.3d 1321, 1328-29, 1340-44 (Fed. Cir. 2015) catalogues the many ways lack of registration harms the mark owner.

In addition to these explicit harms it should be noted that a mark cancelled or denied registration because of disparagement is the equivalent to a criminal record for an individual. There is a stigma that has to be overcome. A person can be rehabilitated but there is nothing a mark can do to achieve that. This stigma will affect, if not preclude, sales, licensing and investment in the mark. It will also similarly affect the product which will become an IP orphan, and there are no IP orphanages.

ARGUMENT

I. The actual role of Courts in free speech cases has been to determine how much speech should be protected and in what manner.

The role of the First Amendment in protecting "free speech" has changed dramatically since the Amendment was adopted in 1791. Today, the limited "no prior restraint" view of the Framers would be unthinkable. On the other hand, the Framers would not recognize the expansive approach of Justice Holmes, let alone the even broader view that prevails today.

This progressive doctrinal change is the product of courts' de facto common-law approach to the First Amendment, which has been adapted over time to changing circumstances. Such adaption has led courts to create rules not directly derived from the words of the Constitution but based on how they believed free speech should be protected in various settings.

Another way of looking at First Amendment jurisprudence is that it is more of an ad hoc approach in which judges were not particularly concerned with establishing or applying rules, but rather with reaching the perceived correct outcome on the facts. Such flexibility has made any synthesis of the applicable law more difficult, even as it has allowed courts to be more responsive in individual instances.

Thus, the basic issue before this Court is the one underlying all free speech cases: Is there speech to be protected? If so, how much speech needs to be protected

on these facts and in what manner? As this brief will show, there is a strong need for high protection for expressive marks from denial of registration by the "disparagement" clause of the Lanham Act.

II. The use of trademarks for expressive content is an important nascent marketplace for the reception and debate of ideas.

Oliver Wendell Holmes extolled the idea that freedom of speech in the First Amendment is based upon a marketplace of ideas. *See Abrams v. United States*, 250 U.S. 616, 624 (1919) (Holmes, J., dissenting). No ideas are sacrosanct and all have to withstand scrutiny and debate. Truth will win out in this process and democracy will benefit.

While that is a very worthy ideal, it is difficult to find any such marketplace today. Newspapers are in decline. Television news shows are divided ideologically with viewers driven by confirmation bias. The Internet is primarily a gathering place for digital mobs ready to tar and feather those who hold opposing views.

The rest of us have gathered not in the public square but in private groups where admission is dependent upon adherence to politically-correct orthodoxy. It is safe inside these groups where shared views are sacrosanct, and they never have to withstand scrutiny. Opposing views are there too, but only to be mocked from a distance.

In this environment, free speech is permitted for somebody with the same views but is disdained when it comes to opposing ones. Political correctness is the new tribalism.

On top of this, students in some our best schools are shielded from information inside or outside of class that might trigger unpleasant feelings. Safe spaces abound. Free speech is the problem not the solution.

It is upon this highly-fraught platform that the USPTO argues that it should be able to enforce politically correct views through Section 2(a). It tells those that are distressed, and are in an eligible group, that it will challenge offensive marks on their behalf or allow the distressed to do it themselves. It will not debate these marks in the public square but rather will exclude them from it.

Respondent's mark, which encapsulates their controversial ideas, is barred because of those ideas. Yet it is such use of expressive trademarks that are the best hope for a marketplace of ideas. No private group can exclude their ideas because they cannot insulate themselves from exposure to THE SLANTS. Moreover, people receive the name without warning in neutral territory – in a setting where they might actually consider the ideas on their merits – before they can jump-start their ideological protective screening.

In sum, the use of trademarks for expressive content is an important nascent marketplace for the reception and debate of ideas. Current construction of Section 2(a) effectively stifles this marketplace and, as will be discussed, does serious harm to mark owners and to the public as well.

III. Elimination of the current disparagement regime would be a plus not a drawback.

A. Law Professors Amicus Brief in Support of Petitioner. This states that if the Federal Circuit's decision is upheld it could "allow for numerous provisions of the Trademark Act to be overturned dismantling the modern trademark system." p.2. This "sky is falling" scenario is just as mistaken as was that of Chicken Little, actually hers, which was based upon an acorn falling on her head, was more credible.

The Professors' concern is footnote 1 at the beginning of the decision which is clearly concerned with the "immoral and scandalous" subsection of 2(a) provision, which the Court specifically stated it was not addressing in its opinion. *See In re Tam*, 808 F.3d 1321, 1330 n.1 (2015). It also addresses the precedential affect of *In re McGinley*, 660 F.2d 481 (CCPA 1981), and that it would not preclude consideration of the constitutionality of "scandalous and immoral" if and when that case arose.

The Professors' brief apparently rely upon the court speaking of Section 2 and not just those two subsections of Section 2(a). However, if the court was opening up the constitutionality of the whole trademark system as claimed by the Professors, this would have been a major concern in the case. No one has ever suggested that this was a possibility. It was not briefed nor addressed at the oral argument of the panel or at the en banc oral argument. If was a possibility, it certainly would have found room at least in one of the majority, concurring, or dissenting opinions. It was in none. An issue of this magnitude would not have been left to a housekeeping footnote.

Finally, as noted, the Court specifically stated that even the constitutionality of the related "immoral and scandalous" subsection of 2(a) was not being addressed in the opinion. This indicates the very narrow scope of the opinion, not the bizarre broad reading of the Professors.

B. The Disparagement provision. First, this type of disparagement enforcement is relatively new, and was not envisioned by Congress in 1946. In fact, the provision did not originate as the result of a clearly felt need but rather appears to have been meant to fill potential gaps in the other provisions. *See Hearings of H.R. 4744 Before the Subcomm. On TradeMarks of the Committee on Patents*, 76th Cong., 1st Sess. 20-21 (1939). In any case, legislators did not envision this regime. Removing it would leave the law as intended by Congress in 1946.

Yet, even those who believe in a governmental a politically correct enforcement regime should be concerned with the current one.

For instance, should the Boy Scouts lose their mark? A disparagement attack could be used to force a "proper" resolution of whether the organization should allow gay scouts and scoutmasters. There are people on both sides who are genuinely upset over this issue and might feel that the mark under the wrong regime would sully or disparage scouts as a group or "the scouting way."

The NAACP is cancellation proceeding just waiting to happen. The acronym, of course, stands for the National Association for the Advancement of Colored People. While the organization was founded in 1910, it was only registered in 1982, not long enough ago to

argue that "colored people" was acceptable at the time of registration. Of course, it would be seriously politically incorrect to attack the NAACP. Yet, political correctness cannot be controlled. There might be people out there for whom it would be politically correct to attack it, and use cancellation as a weapon against it.

This current system is also perfect for disparagement trolls. They can bring or threaten to bring opposition and cancellation proceedings against unsuspecting mark owners. This would be based upon members of the affected public's "heartfelt" beliefs, who should not be hard to find for a committed troll in our current culture.

In short, an application of the First Amendment here would not disrupt a valuable regime. Rather, it would disable a regime that is already badly flawed and could go seriously wrong.

IV. By determining what marks individuals and groups may use to define themselves, the government is restricting self-expression and depriving them of personal autonomy.

As Justice Marshall observed:

> The First Amendment serves not only the needs of the polity but also those of the human spirit—a spirit that demands self-expression. Such expression is an integral part of the development of ideas and a sense of identity. To suppress expression is to reject the basic human desire for recognition and affront the individual's worth and dignity.

Procunier v. Martinez, 416 U.S. 396, 427 (1974) (Marshall, J., concurring).

Contrary to the purposes mentioned by Justice Marshall, Section 2(a) interferes with the ability of individuals and groups to define themselves. Instead, it tasks USPTO trademark examiners with determining *for others* what is and is not disparaging *for them and others*.[5] Such paternalistic regulation and suppression of speech, even in the commercial context, has been consistently discouraged. *See 44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 510 (1996) ("legislature does not have broad discretion to suppress truthful nonmisleading information for paternalistic purposes"); *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 770 (1976) (rejecting state's "highly paternalistic" approach to pharmacist advertising). Further, the First Amendment is "designed and intended to remove governmental restraints from the arena of public discussion, putting the decision as to what views shall be voiced largely into the hands of each of us." *Cohen v. California*, 403 U.S. 15, 24 (1971).

---

5. There are numerous examples of minority groups attempting to register marks deemed to disparage the very group of which they are a part. However, many of these attempts are rejected or ultimately abandoned under the power of 2(a)'s disparagement clause. *See e.g.*, THE BIG HEEB BREWING COMPANY Serial No. 78/432,597, filed June 9, 2004; N.I.G.G.A. NATURALLY INTELLIGENT GOD GIFTED AFRICANS Serial No. 75/002,364, filed Oct. 6, 1995. The application was ultimately abandoned; BABY JAP by a Jewish woman for clothing. Serial No. 78/665,332, filed July 7, 2005. Rather than protecting the marginalized and subjugated, the U.S. government's bar on registration for such reappropriated marks condones their oppression.

Moreover, once the USPTO denies a mark on the basis that it is disparaging, it is as a practical matter declaring it permanently to be so despite what cultural changes may transpire over time. In recent years, minority groups have often reappropriated terms considered disparaging, transforming slurs into as an empowering form of speech and self-identification. *See, e.g.*, RANDALL KENNEDY, NIGGER: THE STRANGE CAREER OF A TROUBLESOME WORD 38 (2008) ("[African Americans] have added a positive meaning to nigger, just as women, gays, lesbians, poor whites, and children born out of wedlock have defiantly appropriated and revalued such words as bitch, cunt, queer, dyke, redneck, cracker, and bastard.")

As it stands, it would seem highly unlikely that even if a once "disparaging" mark was reapplied for after being reappropriated, that any subsequent USPTO examiner would approve a mark previously deemed "disparaging." It would be a can of worms they would not want to open.

Finally, it is inappropriate for the government to be choosing among contemporary choices of an individual or group wants to call itself. Justice Thurgood Marshall continued to use the term "Negro" from the bench until he retired and in opinions through 1988, when he switched to "Afro American." The New York Times, Sec. A, p 21, col. 2 (October 17, 1989) He said he never liked the term "black" and would not use it.

Should it be up to an Examining Attorney and the PTO, in the first instance anyway, to determine what name he could use in a mark? But would Justice Marshall have tried to use it in a mark? Probably not, indicating that the disparaging provision is a de facto prior restraint on use of speech in marks.

Another example is that the NAACP continues to use the spelled out words "Colored People" in its name on it website and elsewhere. Undoubtedly, it is proud of its heritage. Under Federal Circuits Court's liberal standing rules, however, a person of any race could object to what they considered disparaging words and seek cancellation. *See Ritchie v. Simpson*, 170 F.3d 1092, 1097 (Fed. Cir. 1999) ("the potential injury sustained if the mark is registered is the disparagement of [plaintiff's] alleged belief in a loving and nurturing relationship between husband and wife.) These standing rules would allow members of the public to harass mark owners not in spite of but because of their protected speech.

V. There is significant harm to mark owners who have been denied registration.

Judge Plager has noted that "the mark holder who is denied federal registration [because of Section 2(a)] will not receive the benefits conferred on a federal trademark registrant," *Ritchie v. Simpson*, 170 F.3d 1092, 1099 (Fed. Cir. 1999). Judge Moore, in her "Additional Views," *supra*, catalogues the many ways lack of registration harms the mark owner.

In addition to these explicit harms it should be noted that a mark cancelled or denied registration because of disparagement is the equivalent to a criminal record for an individual. There is a stigma that has to be overcome. A person can be rehabilitated but there is nothing a mark can do to achieve that. This stigma will affect, if not preclude, sales, licensing and investment in the mark. It will also similarly affect the product which will become an IP orphan, and there are no IP orphanages.

Moreover, because of the lack of support it will be hard to build goodwill in the mark. What goodwill has been obtained will be "fair game" for free riders who know that enforcement will be very difficult for the owner. Ironically, this might cause more dissemination of the disparagement than if the mark were registered.

In addition barring registration would preclude any protection for a collective mark in its capacity as a collective mark with use "by the members of a cooperative, an association, or other collective group or organization" 15 U.S.C.A. § 1127. This is because there is no protection at common law for them. *See Huber Baking Co. v. Stroehmann Brothers Co.*, 252 F.2d 945, 952 (2d Cir. 1958) ("collective mark was unknown to the common law, it is actually a creature of federal statute.") and collective marks would be particularly useful to groups who are debating and fighting for the proper designation and names for people within the group.

CONCLUSION

Amicus Curiae supports the Respondent's position that the bar on registration of disparaging marks in §2(a) of the Lanham Act, 15 U.S.C. §1052(a), violates the First Amendment and, as a consequence, the Federal Circuit's en banc decision should be affirmed.

Respectfully Submitted,

HUGH C. HANSEN
Counsel of Record
FORDHAM UNIVERSITY SCHOOL OF LAW
150 West 62nd Street
New York, New York 10023
(212) 636-6854
hansenhugh@gmail.com

Counsel for Amicus Curiae

RECORD AND BRIEFS

No. 15-1293

DEC 16 2016
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF *AMICUS CURIAE* ON BEHALF OF THE INTERNATIONAL TRADEMARK ASSOCIATION IN SUPPORT OF RESPONDENT

LAWRENCE K. NODINE
BALLARD SPAHR LLP
999 Peachtree Street,
Suite 1000
Atlanta, GA 30309
(678) 420-9300

ROBERT D. CARROLL
GOODWIN PROCTER LLP
100 Northern Avenue
Boston, MA 02210
(617) 570-1000

ANTHONY J. DREYER
Counsel of Record
ANDREW L. GREEN
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
Four Times Square
New York, NY 10036
(212) 735-3000
anthony.dreyer@skadden.com

JOHN W. CRITTENDEN
COOLEY LLP
101 California Street, 5th Floor
San Francisco, CA 94111
(415) 693-2000

Counsel for Amicus Curiae

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES iii

INTERESTS OF THE AMICUS CURIAE 1

SUMMARY OF THE ARGUMENT 5

ARGUMENT 7

I. The "May Disparage" Provision of Lanham Act Section 2(a) Is Void for Vagueness 7

A. The Text of the "May Disparage" Provision in Section 2(a) and Its Application by the PTO Do Not Provide Adequate Guidance for Applicants or Examiners 8

B. The Vagueness of the "May Disparage" Provision and the PTO's Implementation of It Adversely Impacts Brand Owners 13

II. Because Trademarks Are Commercial Speech, and Section 2(a) Does Not Foreclose Expressive Speech, Section 2(a) Should Be Reviewed Under Intermediate Scrutiny 14

A. Trademarks Are Commercial Speech, Restrictions on Which Are Subject to Intermediate Scrutiny 15

B. Adding Private Speech to Commercial Speech Does Not Trigger Strict Scrutiny . 17

C. Strict Scrutiny Is Not Necessary Because There Is No Risk of Suppressing Unfavorable Speech Entirely 26

III. A Trademark Registration Is Not Government Speech 29

A. Issuing a Trademark Registration Is Not Expressive Activity 29

B. The Public Does Not Associate Registered Trademarks with Any Expressive Government Activity 32

IV. Section 43(a) Is Available to Enforce Rights in Disparaging Marks 34

A. The Text of Section 43(a) Does Not Limit Protection to Registrable Marks 35

B. Courts Have Routinely Permitted Section 43(a) Claims to Proceed for Unregistrable Marks 38

C. None of the Cases Relied Upon by the Federal Circuit Involved a Mark Challenged, Let Alone Found Unregistrable, Under Section 2(a) 40

CONCLUSION 43

TABLE OF AUTHORITIES

CASES

Accuride International, Inc. v. Accuride Corp.,
871 F.2d 1531, 10 U.S.P.Q.2d 1589 (9th Cir. 1989) 38
B & B Hardware, Inc. v. Hargis Industries, Inc.,
135 S. Ct. 1293 (2015) 13
Board of Trustees v. Fox,
492 U.S. 469 (1989) 21, 22
Bolger v. Youngs Drug Products Corp.,
463 U.S. 60 (1983) 20
Bros. of the Wheel M.C. Executive Council, Inc. v. Mollohan,
909 F. Supp. 2d 506 (S.D. W. Va. 2012) 41
Central Hudson Gas & Electric Corp. v. Public Service Commission of New York,
447 U.S. 557 (1980) 18, 19, 20, 26
Davenport v. Washington Education Ass'n,
551 U.S. 177 (2007) 28
Dombrowski v. Pfister,
380 U.S. 479 (1965) 10
E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.,
547 F.3d 1095 (9th Cir. 2008) 25
EMI Catalogue Partnership v. Hill, Holliday, Connors, Cosmopulos Inc.,
228 F.3d 56 (2d Cir. 2000)..... 38
F.C.C. v. Fox Television Stations, Inc.,
132 S.Ct. 2307 (2012) 7, 8

Friedman v. Rogers,
440 U.S. 1 (1979) 16
Grayned v. City of Rockford,
408 U.S. 104 (1972) 11
In re Hershey,
6 U.S.P.Q.2d 1470 (T.T.A.B. 1988) 5, 11
In re In Over Our Heads, Inc.,
16 U.S.P.Q.2d 1653 (T.T.A.B. 1990) 11
Johanns v. Livestock Marketing Ass'n,
544 U.S. 550 (2005) 30
KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.,
543 U.S. 111 (2004) 24
Lyng v. UAW,
485 U.S. 360 (1988) 28
In re McGinley,
660 F.2d 481 (C.C.P.A. 1981) 26
In re Old Glory Condom Corp.,
26 U.S.P.Q.2d 1216 (T.T.A.B. Mar. 3, 1993) 32
Pleasant Grove City v. Summum,
555 U.S. 460 (2009) 29, 30, 33
Pro-Football, Inc. v. Blackhorse,
112 F. Supp. 3d 439 (E.D. Va. 2015)..... 27
Radiance Foundation, Inc., v. NAACP,
786 F.3d 316 (4th Cir. 2015) 25
Re v. Smith,
77 U.S.P.Q.2d 1858 (D. Mass. 2005)..... 38
Renna v. County of Union,
88 F. Supp. 3d 310 (D.N.J. 2014)..... 41
Riley v. National Federation of the Blind of N.C., Inc.,
487 U.S. 781 (1988) .....passim

Rogers v. Grimaldi,
875 F.2d 994 (2d Cir. 1989) 25
S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.,
483 U.S. 522 (1987) 16
In re Simon Shiao Tam,
808 F.3d 1321 (Fed. Cir. 2015) ..... passim
Smith v. Chanel, Inc.,
402 F.2d 562 (9th Cir. 1968) 15
Sorrell v. IMS Health Inc.,
564 U.S. 552 (2011) 17
Sugar Busters LLC v. Brennan,
177 F.3d 258 (5th Cir.1999) 39
Two Pesos, Inc. v. Taco Cabana, Inc.,
505 U.S. 763 (1992) 24, 35, 40, 41
Walker v. Tex. Division, Sons of Confederate Veterans, Inc.,
135 S. Ct. 2239 (2015) 29, 30, 32
Yarmuth-Dion, Inc. v. D'ion Furs, Inc.,
835 F.2d 990 (2d Cir. 1987) 41

STATUTES

15 U.S.C. § 1052 ..... 9, 36
15 U.S.C. § 1052(a) 7
15 U.S.C. § 1052(e) 24
15 U.S.C. § 1052(f) 24
15 U.S.C. § 1072 32
15 U.S.C. § 1115(b)(4) 24
15 U.S.C. § 1125(a) 4, 37
15 U.S.C. § 1125(a)(1) 34, 36, 37
15 U.S.C. § 1125(c)(3) 24
15 U.S.C. § 1127 15
Pub. L. No. 100-667, 102 Stat. 3935 36

OTHER AUTHORITIES

134 Cong. Rec. 5864 (1988) 38
J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 3:2 (4th ed. 2016) 15
McCarthy § 3:3.20 23
McCarthy § 3:5 15
McCarthy § 9:13 38
McCarthy § 19:2 31
McCarthy § 19:3 31
McCarthy § 19:78 41
McCarthy § 19:148 31
McCarthy § 27:8 37
McCarthy § 27:15 38
Trademark Manual of Examining Procedure § 1203.03(b)(i)(7th ed. Oct. 2016) 10, 11

INTERESTS OF THE *AMICUS CURIAE*[1]

Founded in 1878, *amicus curiae* the International Trademark Association ("INTA") is a not-for-profit global organization dedicated to the support and advancement of trademarks and related intellectual property. INTA has more than 7,000 member organizations from 190 countries. Its members include trademark and other brand owners, as well as law firms and other professionals who regularly assist brand owners in the creation, registration, protection, and enforcement of their trademarks. All INTA members share the goal of promoting an understanding of the essential role that trademarks play in fostering effective commerce, fair competition, and informed decision-making by consumers.

INTA was founded in part to encourage the enactment of federal trademark legislation

---

[1] Pursuant to Supreme Court Rule 37.6, this brief was authored solely by INTA and its counsel, and no part of this brief was authored by counsel for a party. No party or counsel for a party, nor any other person or entity other than *amicus curiae*, its members, and its counsel, made a monetary contribution intended to fund the preparation or submission of this brief. Pursuant to Supreme Court Rule 37.3(a), both parties have filed letters with the Clerk of the Court consenting to the filing of *amicus* briefs.

following invalidation on constitutional grounds of the United States' first trademark act. Since then, INTA has been instrumental in making recommendations and providing assistance to legislators in connection with major trademark and related legislation. INTA also has participated as *amicus curiae* in numerous cases in this Court and other courts across the country involving significant Lanham Act issues.[2] Moreover, INTA's members are frequent participants in litigations in courts and in administrative proceedings before the United States Patent and Trademark Office ("PTO") and Trademark Trial and Appeal Board ("TTAB") with respect to actions brought under the Lanham Act, and therefore are interested in the development of clear, consistent and equitable principles of trademark law.

---

[2] Recent Supreme Court cases in which INTA has filed amicus briefs include, without limitation: *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293 (2015); *Hana Financial, Inc. v. Hana Bank*, 135 S. Ct. 907 (2015); *POM Wonderful LLC v. Coca-Cola Co.*, 134 S. Ct. 2228 (2014); *Lexmark International, Inc. v. Static Control Components, Inc.*, 134 S. Ct. 1377 (2014); *Already, LLC v. Nike, Inc.*, 133 S. Ct. 721 (2013); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); and *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003).

INTA has a particular interest in this case because it concerns a matter of utmost concern to INTA and its members: the registrability of trademarks under the Lanham Act. Although INTA in no way condones or supports trademarks that disparage persons, institutions, beliefs, or national symbols, INTA and its members have a strong interest in ensuring consistent application of the Lanham Act, including those provisions governing trademark registrations. Brand owners invest significant time, effort, and expense in developing and clearing trademarks for use and registration, and need clear guidance and predictability about which trademarks will be registrable. This need is undermined by the vague and imprecise nature of the "may disparage" provision of Section 2(a) of the Lanham Act, which has been inconsistently interpreted and applied.

INTA and its members also have a strong interest in ensuring the proper interpretation and construction of the Lanham Act. In this regard, INTA believes that the Federal Circuit properly determined that trademark registrations are not government speech, but erred by concluding that the disparagement provision of Section 2(a) does not regulate commercial speech. INTA believes that trademarks are inherently commercial in nature; indeed their principal purpose is to identify to consumers the source or sponsorship of goods and services used in commerce. Accordingly, trademarks should be viewed as commercial speech, and laws affecting or restricting the use of trademarks should be subject to intermediate scrutiny.

INTA and its members likewise have a strong interest in clarifying that, contrary to the suggestion of the Federal Circuit, Section 43(a) of the Lanham Act is available to protect a word or term regardless of whether it is a registered trademark. Whereas claims under Section 32 of the Lanham Act expressly are limited to federally registered marks, Section 43(a) contains no such requirement, and instead is available where "*any* word, term, name, symbol, or device, or any combination thereof" is used in a manner that is false, misleading, or deceptive to consumers. 15 U.S.C. § 1125(a) (emphasis added).

To be clear, INTA in no way condones disparaging, offensive, or hateful speech. INTA also acknowledges that the government has an interest in protecting consumers from hateful speech in the commercial marketplace, and a Congressional restriction against registrations of trademarks that constitute hate speech may well survive intermediate scrutiny. However, for the reasons explained more fully below, the "may disparage" provision of Section 2(a), as drafted, is unconstitutional.

SUMMARY OF THE ARGUMENT

The Federal Circuit correctly determined that the "may disparage" provision of Section 2(a) of the Lanham Act does not pass constitutional scrutiny—but that failure is due to the provision's vagueness. Over the years, the PTO has demonstrated, through inconsistent application, that the current Lanham Act prohibition against registration of disparaging marks cannot be implemented in a predictable and/or objective fashion. Moreover, the TTAB itself has conceded that the guidelines for identifying a disparaging mark are "somewhat vague." *In re Hershey*, 6 U.S.P.Q.2d 1470, 1471 (T.T.A.B. 1988). As a result, the disparagement provision raises the risk of—and indeed has resulted in—arbitrary application that may adversely impact brand owners. Although INTA does not condone disparaging, offensive, or hateful speech, the "may disparage" provision of Section 2(a), as drafted, is void for vagueness.

With respect to the constitutionality of the disparagement provision under the First Amendment, strict scrutiny is not the appropriate standard. Because trademarks serve an inherently commercial purpose—identifying the source of goods and services in commerce—trademarks should be viewed as commercial speech. Although the Federal Circuit largely recognized the inherently commercial nature of trademarks, the majority erred in concluding that commercial and expressive speech were "inextricably intertwined" in the SLANTS mark. Because a trademark, "taken as a whole," serves a commercial purpose—

and because trademark law does not protect any expressive message separate and apart from its function as a source identifier—trademark laws should be subject to intermediate scrutiny. Moreover, strict scrutiny is unwarranted because the denial of a trademark registration does not restrict speech; terms that have been refused registration may still be used for expressive (or commercial) purposes.

The Federal Circuit did correctly conclude that issuance of a trademark registration is not an act of government speech. To the contrary, issuing a trademark registration is merely a regulatory function and does not involve any expressive activity from the government. The trademark owner creates and controls the mark, along with any message a mark conveys. Moreover, the suggestion that registration would cause the public to identify a trademark with the government is antithetical to the entire purpose of a trademark—to identify the source of goods or services. Accordingly, the government speech doctrine is not applicable to trademark registration.

Finally, to the extent the Federal Circuit suggested that owners of unregistrable marks may not separately seek relief under Section 43(a) of the Lanham Act, INTA respectfully disagrees. This suggestion has no support in the Lanham Act text or legislative history and is contrary both to the text and years of precedent. Accordingly, this Court should confirm that Section 43(a) is available to protect marks that provide a source-identifying

function, regardless of whether the mark is registrable.

ARGUMENT

I. THE "MAY DISPARAGE" PROVISION OF LANHAM ACT SECTION 2(A) IS VOID FOR VAGUENESS

"A fundamental principle in our legal system is that laws which regulate persons or entities must give fair notice of conduct that is forbidden or required." *F.C.C. v. Fox Television Stations, Inc.*, 132 S.Ct. 2307, 2317 (2012). Despite longstanding efforts by the PTO, decades of attempts by that body and trademark applicants to discern what constitutes a trademark that "[c]onsists of or comprises . . . matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute" show that the "may disparage" provision of Lanham Act Section 2(a) is impermissibly vague. 15 U.S.C. § 1052(a). Accordingly, the Court should declare the "may disparage" provision void for vagueness under the Fifth Amendment to the U.S. Constitution.

"Th[e] requirement of clarity in regulation is essential to the protections provided by the Due Process Clause of the Fifth Amendment." *Fox Television Stations*, 132 S.Ct. at 2317. Where, as here, a regulation implicates speech, this Court has identified three discrete due process concerns:

> [F]irst . . . regulated parties should know what is required of them so they may act accordingly; second, precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory way[; and third,] rigorous adherence to those requirements is necessary to ensure that ambiguity does not chill protected speech.

Id. Lanham Act Section 2(a) and the PTO's internal regulations on their face show that, even if examiners and courts apply the utmost care, the "may disparage" provision cannot be implemented in a predictable, objective, and evenhanded way. The many inconsistent outcomes that the PTO has reached over the years concerning what "may disparage" under Section 2(a) provide additional evidence that the standard is unpredictable and unworkable. The vagueness of the "may disparage" provision has led to uncertainty among brand owners, with the greatest potential impact on small brand owners.

A. The Text of the "May Disparage" Provision in Section 2(a) and Its Application by the PTO Do Not Provide Adequate Guidance for Applicants or Examiners

The text of the "may disparage" provision itself provides little guidance to applicants and trademark examiners. Section 2(a) provides that:

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—
>
> (a) Consists of or comprises . . . matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute . . .

15 U.S.C. § 1052.[3] The statutory prohibition on the registration of marks that "*may* disparage" persons, institutions, beliefs, or national symbols on its face is overly broad, making it difficult to understand what is prohibited or how the statute will be applied. Read literally, the statutory language could sweep broadly enough to prevent registration of all marks that incorporate even gentle critique or

---

[3] INTA has endorsed the harmonization of state trademark law with the Lanham Act by encouraging states to enact INTA's Model State Trademark Bill (the "Model Bill"). *See* INTA Model Laws and Guidelines, *http://www.inta.org/Advocacy/Pages/ModelLawsandGuidelines.aspx* (retrieved on December 14, 2016). The Model Bill contains language similar to the "may disparage" provision of Section 2(a) of the Lanham Act. INTA recognizes that any infirmities applicable to Lanham Act Section 2(a) also likely apply to the laws of states that have adopted the Model Bill.

satire of any individual, group, faith, or national symbol.

"[A]uthoritative constructions sufficiently illuminating the contours of an otherwise vague prohibition," may save an otherwise impermissibly vague statute from constitutional infirmity. *Dombrowski v. Pfister*, 380 U.S. 479, 490-91 (1965). The TTAB's construction of the "may disparage" provision does not sufficiently illuminate the contours of the prohibition to save the provision. The TTAB applies a two-part test in determining whether a mark may disparage:

> (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
>
> (2) If that meaning is found to refer to *identifiable persons, institutions, beliefs or national symbols*, whether that meaning *may be disparaging to a substantial composite of the referenced group.*

Trademark Manual of Examining Procedure ("TMEP") § 1203.03(b)(i) (7th ed. Oct. 2016) (emphasis added).

Far from illuminating the contours of the prohibition in Section 2(a), the TMEP compounds

the ambiguity in a way that gives individual examiners little guidance and almost unbridled discretion in the application of the rule. Even the TTAB itself concedes that, despite its efforts to articulate a workable standard, the guidelines for determining whether a mark may disparage are "somewhat vague," and any such determination is "highly subjective." *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d 1653, 1653 (T.T.A.B. 1990) (quoting *In re Hershey*, 6 U.S.P.Q.2d at 1471). As Judge O'Malley observed in her concurring opinion in *Tam*, an examiner can reject an application under the "may disparage" provision if the mark "only *potentially disparage[s]* a subset of *any group* as long as that group can be 'identifi[ed].'" *In re Simon Shiao Tam*, 808 F.3d 1321, 1359 (Fed. Cir. 2015) (en banc) (O'Malley, J., concurring) (second alteration in original) (citation omitted).

The dangers of "arbitrary and discriminatory application" attendant to the vague language of the "may disparage" prohibition are exacerbated because the provision is most often applied by a single PTO examiner in *ex parte* proceedings. *See Grayned v. City of Rockford*, 408 U.S. 104, 108-09 (1972). PTO examiners must determine: (a) the likely meaning of the mark in question; (b) whether that meaning refers to "identifiable persons, institutions, beliefs or national symbols," and if so, (c) "whether that meaning may be disparaging to a substantial composite of the referenced group," TMEP § 1203.03(b)(i)—all without the benefit of being presented evidence through an adversarial process. Even if examiners are able to undertake their review with the utmost diligence, insufficient

clarity around the standard makes it impossible to implement the "may disparage" provision in a predictable, objective, and evenhanded way.

The Federal Circuit and numerous *amici* have extensively documented the inconsistent application and varying results of the "may disparage" provision. *Compare, e.g.*, App. Ser. No. 85/077647 (denying application for HAVE YOU HEARD SATAN IS A REPUBLICAN as disparaging) *with*, App. Ser. No. 85/525,066 (not refusing the mark DEVIL IS A DEMOCRAT as disparaging; application abandoned after publication for other reasons); *see also Tam*, 808 F.3d at 1342 n.7 (gathering examples). The PTO appears to have particular challenges applying the "may disparage" provision in a predictable way to applications, like Mr. Tam's, that seek registration for "reclaimed slurs." *Compare, e.g.*, DYKES ON BIKES, Reg. No. 3,323,803 (initially rejected as disparaging, but later accepted for registration after applicant submitted evidence that "dyke" can be used as a source of pride for the LGBT community) *and* F•A•G FABULOUS AND GAY, Reg. No. 2,997,761, *with* MARRIAGE IS FOR FAGS, App. Ser. No. 77/477549 (rejected on the ground that it may disparage persons, institutions, beliefs, or national symbols), *and* THE SLANTS, App. Ser. No. 85/472044.

B. The Vagueness of the "May Disparage" Provision and the PTO's Implementation of It Adversely Impacts Brand Owners

The Lanham Act "confers important legal rights and benefits on trademark owners who register their marks." *B&B Hardware v. Hargis Indus.*, 135 S.Ct. 1293, 1300 (2015) (internal quotation marks and citation omitted). Even assuming that protection exists under Section 43(a) for trademarks that "may disparage,"[4] uncertainty concerning the registrability of a trademark nevertheless may have a significant effect on brand owners' willingness to invest in a brand—an effect that is particularly concerning because it falls disproportionately on small businesses which, unlike large brand owners, often lack the resources to pursue extended trademark prosecution, much less through the appeals process. As the Federal Circuit noted in its opinion, "[i]n many cases, as soon as a trademark examiner issues a rejection based upon disparagement, the applicant immediately abandons the trademark application." *Tam*, 808 F.3d at 1343.

---

[4] INTA believes the Federal Circuit erred by asserting that a trademark is not protectable pursuant to Lanham Act Section 43(a) if it is unregistrable due to the "may disparage" provision. *See infra* part IV.

II. Because Trademarks Are Commercial Speech, and Section 2(a) Does Not Foreclose Expressive Speech, Section 2(a) Should Be Reviewed Under Intermediate Scrutiny

The Federal Circuit applied strict scrutiny to Section 2(a)'s "may disparage" provision, while also holding that the provision failed intermediate scrutiny. INTA strongly opposes the application of strict scrutiny to trademark laws and regulations. To the extent the Court considers whether Section 2(a) survives First Amendment scrutiny, intermediate scrutiny should be applied for two reasons.

First, because trademarks serve an inherently commercial purpose—to identify the source of goods and services in commerce—trademarks are commercial speech properly subject to intermediate scrutiny. The addition of a private expressive message to a commercial source-identifying trademark does not convert the "speech taken as a whole" to an expressive message. *See Riley v. Nat'l Fed'n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988). The Federal Circuit erred when it incorrectly concluded that commercial and expressive speech were "inextricably intertwined" in the SLANTS mark.

Second, strict scrutiny is unwarranted because denial of a registration does not restrict anyone from using the term "slants" in expressive or commercial speech. This distinguishes the instant

case from those cited by the *Tam* majority involving a burden on free speech.

A ruling that imposes an inappropriately high burden on the government's authority to regulate trademarks, or that disturbs the balance between the need to regulate trademarks as commercial signals and the right of trademark owners to free speech risks far-reaching unintended consequences. The more deferential intermediate scrutiny standard applicable to commercial speech best ensures the appropriate balancing of these interests.

A. Trademarks Are Commercial Speech, Restrictions on Which Are Subject to Intermediate Scrutiny

A trademark is a commercial designation used "to identify and distinguish" the goods of a person. 15 U.S.C. § 1127. Trademarks function to identify a single source for goods or services, to indicate the quality level of goods or services, and to serve as a prime instrument for the advertising and sale of goods or services. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 3:2 (4th ed. 2016) [hereinafter "McCarthy"]. Without trademarks, "informed consumer choice, and hence meaningful competition in quality, could not exist." *Id.* § 3:5 (quoting *Smith v. Chanel, Inc.*, 402 F.2d 562, 566 (9th Cir. 1968)).

It is equally important to recognize that trademark law does not protect the expressive message conveyed by a trademark. As explained

more fully below, trademark law consistently *distinguishes* between the commercial source-identifying function of a mark, which trademark law protects, and the expressive component, which it does not.[5]

Before the *Tam* opinion, it was well settled that trademarks and trade names were commercial speech and "nothing more." *See Friedman v. Rogers*, 440 U.S. 1, 11 (1979) (observing that trademark protections involve "a form of commercial speech and nothing more"); *S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 535 (1987) (recognizing trademarks as "commercial speech" that receive "a limited form of First Amendment protection" (internal quotation marks and citation omitted)). The contention that trademarks are commercial speech is neither controversial nor contested. Indeed, all of the *Tam* Federal Circuit judges agreed that trademarks are commercial speech. *See* 808 F.3d at 1338 (majority opinion); *id.* at 1365 (Dyk, J., concurring in part and dissenting in part)[6]; *id.* at 1376 (Reyna, J., dissenting).

Although the *Tam* majority conceded that trademarks historically have been considered

---

[5] See, *infra*, part II.B, at 23-24 & n.10, 11.

[6] Judge Lourie joined in Judge Dyk's concurring opinion, but in his dissent questioned whether a trademark is "speech" at all. *Id.* at 1375.

commercial speech, it nonetheless applied strict scrutiny, reasoning that the SLANTS mark included an expressive message. This application ignores decades of established precedent treating trademarks as commercial speech, and is inconsistent with the fundamental commercial purpose of trademarks.

B. Adding Private Speech to Commercial Speech Does Not Trigger Strict Scrutiny

Even though this Court historically has reviewed commercial speech restrictions under intermediate scrutiny, the *Tam* majority nonetheless applied strict scrutiny primarily[7] because it concluded that the SLANTS trademark "inextricably intertwined" commercial and expressive private speech.[8] 808 F.3d at 1339. This

---

[7] The *Tam* majority also cited *Sorrell v. IMS Health Inc.*, 564 U.S. 552 (2011), in support of the application of "heightened scrutiny," implying this meant strict scrutiny. 808 F.3d at 1338. But *Sorrell* did not apply strict scrutiny, explaining that, because the challenged statute failed the commercial speech test, "there is no need to determine whether all speech hampered by [the challenged statute] is commercial." *Sorrell*, 564 U.S. at 571-72.

[8] Aware that this conclusion was unusual, if not unprecedented, the *Tam* majority observed that, even though "marks often have an expressive

conclusion was based on a misreading of *Riley*. Mr. Tam's addition to his mark of an expressive component, even a political component, does not change the mark's commercial character and should not change the traditional level of scrutiny used for commercial speech.

This Court has consistently rejected the *Tam* majority's premise that strict scrutiny applies when the speech in question mixes a commercial component and a private expressive component. In *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*, 447 U.S. 557 (1980), this Court established the now well-known judicial test for evaluating the constitutionality of restrictions on commercial speech under intermediate scrutiny. *Central Hudson* concerned a New York Public Service Commission regulation prohibiting utilities from promoting consumption of electricity. Recognizing that advertising was commercial speech, this Court struck down the subject regulation under intermediate scrutiny. *Id.* at 567-71.

In a concurring opinion, Justice Stevens argued—much in the way the *Tam* court held—that the restriction at issue should be subject to strict scrutiny because it regulated speech with a mixed

---

aspect over and above their commercial-speech aspect," *id.* at 1338, "[c]ourts have been slow to appreciate the expressive power of trademarks." *Id.* at 1327.

commercial and expressive purpose. As a result, Justice Stevens believed this mixed speech was "entitled to the maximum protection afforded by the First Amendment." *Id.* at 579.

Given the parallels between Justice Stevens's approach and that of the Federal Circuit here, the *Central Hudson* majority's rejection of Justice Stevens's approach is particularly instructive:

> Apparently [Justice Stevens's] concurring opinion would accord full First Amendment protection to all promotional advertising that includes claims "relating to . . . questions frequently discussed and debated by our political leaders." . . .
>
> [W]e think it would blur further the line the Court has sought to draw in commercial speech cases. It would grant broad constitutional protection to any advertising that links a product to a current public debate. But many, if not most, products may be tied to public concerns with the environment, energy, economic policy, or individual health and safety. We rule today . . . that utilities enjoy the full panoply of First Amendment protections for their direct comments on public issues. There is no reason for providing similar constitutional protection when such statements are made only in the context of commercial transactions.

Id. at 562 n.5 (second alteration in original) (citations omitted).

The Court reiterated that point three years later in *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60 (1983), striking down a federal law prohibiting the mailing of unsolicited advertisements for contraceptives. Although the advertisements at issue contained "discussions of important public issues," the Court properly treated them as commercial speech and therefore refused to apply strict scrutiny:

> The mailings constitute commercial speech notwithstanding the fact that they contain discussions of important public issues . . . . We have made clear that advertising which "links a product to a current public debate" is not thereby entitled to the constitutional protection afforded noncommercial speech. A company has the full panoply of protections available to its direct comments on public issues, so there is no reason for providing similar constitutional protection when such statements are made in the context of commercial transactions.

Id. at 67-68 (quoting *Central Hudson*, 447 U.S. at 562 n.5) (footnotes omitted).

Rather than follow this clear precedent, the *Tam* majority relied on *Riley* to justify its application of strict scrutiny. *See Tam*, 808 F.3d at 1339. In *Riley*, this Court struck down a North Carolina law that required professional fundraisers

to submit to potential donors a written disclosure of the percentage of their collections in the past year actually received by the charities that hired them. This Court applied strict scrutiny because the added disclosure (which the Court assumed to be commercial speech) was "inextricably intertwined" with the underlying donation requests, which the Court had already held in several earlier cases to be private speech protected by strict scrutiny. *Riley*, 487 U.S. at 796. The addition of a commercial disclosure did not change the "nature of the speech taken as a whole," which was the private solicitation of a donation to a charitable cause. *Id.*

The *Tam* majority's reliance on *Riley* is misplaced for reasons that this Court explained in *Board of Trustees v. Fox*, 492 U.S. 469 (1989). That case involved a New York statute prohibiting private commercial enterprises from selling housewares at "Tupperware" parties on the state university campus. Students challenged the statute as a violation of their First Amendment rights. Because attendees at the parties "proposed a commercial transaction," *id.* at 473, the Supreme Court applied the *Central Hudson* commercial speech standards. The Court rejected the argument of the students who, like the majority in *Tam*, relied on *Riley* to support their contention that strict scrutiny should apply because the commercial speech (sales pitches for the household products) was "inextricably intertwined" with "pure" speech touching on other subjects, such as how to be financially responsible and run an efficient home. *Id.* at 474.

Writing for the majority in *Fox*, Justice Scalia distinguished *Riley* with observations directly relevant here:

> [In *Riley*], the commercial speech (if it was that) was "inextricably intertwined" because the state law *required* it to be included. By contrast, there is nothing whatever "inextricable" about the noncommercial aspects of these presentations. No law of man or of nature makes it impossible to sell housewares without teaching home economics, or to teach home economics without selling housewares. Nothing in the resolution prevents the speaker from conveying, or the audience from hearing, these noncommercial messages, and nothing in the nature of things requires them to be combined with commercial messages.
>
> Including these home economics elements no more converted AFS' presentations into educational speech, than opening sales presentations with a prayer or a Pledge of Allegiance would convert them into religious or political speech. . . . We discuss this case, then, on the basis that commercial speech is at issue.

492 U.S. at 474-75 (citations omitted). This Court's limitation of *Riley* to its unique facts—facts which are in no way present here—demonstrates why the *Tam* majority erred when it relied on *Riley*.

In *Riley*, the underlying speech was expressive, such that its nature was unchanged by the addition of a commercial disclosure. 487 U.S. at 796. Here, by contrast, the underlying speech—the name of a provider of music and music performances—serves first and foremost as a trademark, which is inherently and solely commercial in nature. Mr. Tam's voluntary[9] addition of an expressive connotation does not change the principal purpose of his music group's name: to identify the source of goods and services the group provides. Thus, treating a trademark as commercial speech is consistent with *Riley*.

This is especially true because trademark law is not designed to protect the expressive component of a trademark. Trademark law consistently *distinguishes* between the commercial source-identifying function of a mark, which is protected, and the expressive component, which is not.[10]

---

[9] Mr. Tam voluntarily adds this connotation to his mark. The word "slants" does not communicate Mr. Tam's intent to "reclaim" the derogatory term. The reclamation message is based on collateral explanations and commentary that Mr. Tam adds on.

[10] Purely informational words or slogans typically do not qualify for trademark protection. McCarthy § 3:3.20. "This is especially true of words or slogans that primarily or solely convey an informational or promotional message. Even when prominently displayed, such informative words

Thus, generic words cannot serve as marks. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) ("[G]eneric marks—those that 'refe[r] to the genus of which the particular product is a species,' . . . are not registrable as trademarks." (second alteration in original) (citations omitted)). Similarly, "merely descriptive" words are not registrable as trademarks, 15 U.S.C. § 1052(e), unless they acquire distinctiveness by virtue of long use and consumer recognition, *id.* § 1052(f), and even then are subject to the right of others to make fair use of the ordinary meaning of the words. *Two Pesos*, 505 U.S. at 769; *see also KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004) (finding "no indication that the [Lanham Act] was meant to deprive commercial speakers of the ordinary utility of descriptive words"). In many other ways, the trademark jurisprudence carefully avoids extending trademark protection to a mark's expressive message.[11]

---

may not perform the job of identifying [a] source." *Id.*

[11] The Lanham Act expressly excludes from liability many non-trademark uses, including descriptive and nominative fair use, "all forms of news reporting and news commentary" and "any noncommercial use of a mark." 15 U.S.C. § 1125(c)(3) (involving dilution claims); *see also id.* § 1115(b)(4) (providing affirmative defense for descriptive use "otherwise than as a mark").

As a result of the distinction from the commercial component of a mark, the addition of an expressive component does not change "the nature of the speech taken as a whole." *Riley*, 487 U.S. at 796. Accordingly, Mr. Tam's insistence that he is reclaiming the derogatory connotation of the word "slants" does not alter the nature of the mark as a whole.

Nor are the expressive and commercial connotations of the SLANTS trademark "inextricably intertwined." To paraphrase this Court in *Fox*: No law of man or of nature makes it

---

Numerous cases recognize that noncommercial uses of a mark do not infringe. *See, e.g., Radiance Found., Inc., v. NAACP*, 786 F.3d 316, 331-32 (4th Cir. 2015) (reversing injunction against use of "National Association for Abortion of Colored People" and holding this use of the NAACP mark was a noncommercial use of the mark). Use of a mark in an artistic work, especially a title, enjoys First Amendment protection. *E.S.S. Entm't 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099 (9th Cir. 2008) (alterations in original) ("An artistic work's use of a trademark that otherwise would violate the Lanham Act is not actionable 'unless the [use of the mark] has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless [it] explicitly misleads as to the source or the content of the work.'" (citing *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989))).

impossible to name a musical group without making a social statement on bigotry, or to make a social statement on bigotry without naming a musical group. Nothing in Section 2(a) prevents Mr. Tam from conveying, or his audience from hearing, his social message.

In sum, this Court consistently has rejected efforts to apply strict scrutiny merely because the commercial speech at issue also included private speech, even when that private speech related "to public concerns with the environment, energy, economic policy, or individual health and safety." *Central Hudson*, 447 U.S. at 562 n.5. Here, adding a social message to what is inherently commercial speech warrants no different result. Accordingly, the Federal Circuit erred in applying strict scrutiny.

C. Strict Scrutiny Is Not Necessary Because There Is No Risk of Suppressing Unfavorable Speech Entirely

Strict scrutiny is warranted when there is viewpoint discrimination and the government is suppressing speech it does not favor. But denying a trademark registration does not create any meaningful risk that speech will be suppressed entirely. Any slight incidental burden on speech does not warrant strict scrutiny.

The denial of the registration does not prevent Mr. Tam from using the term "slants," either generally or as a mark. In *In re McGinley*, 660 F.2d

481, 484 (C.C.P.A. 1981), the court held that the denial of a trademark registration did not raise any First Amendment concerns because the government did not prevent the trademark owner from using his mark.[12] Although the absence of a complete bar on speech does not avoid the First Amendment issue entirely, it does affect the degree of scrutiny: if the purpose of strict scrutiny is to provide maximum protection against the suppression of speech, then the minimal risk of suppression should reduce the need for strict scrutiny.

The Federal Circuit held that, even though Mr. Tam remains free to express his message, the denial of registration has a chilling effect on free speech. The court asserted that people are less likely to adopt marks that cannot be registered, and, further, that this preference for registrable marks will chill free speech. *See Tam*, 808 F.3d at 1339–44.

This potential burden on free speech does not justify strict scrutiny. Given the undeniable value of a trademark registration, it is reasonable to assume that the "may disparage" provision causes some trademark owners to use and seek to *register*

---

[12] *See also Tam*, 808 F.3d at 1368-70 (Dyk, J. concurring in part and dissenting in part); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 455-57 (E.D. Va. 2015), *appeal docketed*, No. 15-1874 (4th Cir. Aug. 6, 2015).

a non-disparaging commercial symbol instead of a potentially disparaging one—but there is no basis for the additional assumption that this hypothetical applicant will otherwise abandon the message conveyed by a potentially disparaging mark. Certainly, the significance of any chill is unknown.[13] Most importantly, INTA does not propose to ignore any assumed chilling of speech, but rather to test it against the standards historically applied to commercial speech. Where, as here, it is "exceedingly unlikely" that a law will burden a fundamental right, there is no call for strict scrutiny. *Lyng v. Int'l Union, UAW*, 485 U.S. 360, 365 (1988); *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177, 188 (2007) ("And we have identified numerous situations in which that risk [of driving certain ideas or viewpoints from the marketplace] is inconsequential, so that strict scrutiny is unwarranted.").

---

[13] INTA has not been able to verify, much less quantify, any chilling effect. Mr. Tam began using THE SLANTS as a mark in 2006, but waited until 2010 to apply for a federal registration. He presumably continues using "Slants" as a band name without the benefit of a registration. The *Tam* majority cites to a catalogue of amicus briefs, none of which support the contention that there is chilling of speech. 808 F.3d at 1341.

III. A TRADEMARK REGISTRATION IS NOT GOVERNMENT SPEECH

A. Issuing a Trademark Registration Is Not Expressive Activity

As the Federal Circuit properly determined, trademark registrations do not constitute government speech and thus are not beyond the scope of constitutional protection. 808 F.3d at 1345-48. The hallmark of government speech is that the government itself has engaged in "expressive conduct" to convey a particular message. *See Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2251 (2015); *Pleasant Grove City v. Summum*, 555 U.S. 460, 474 (2009). As shown below, the registration of a trademark—like the issuance of a permit or granting of a license—does not convey any expressive message by the government, but instead merely is an exercise of a regulatory function.

Trademark registrations do not bear any of the indicia of government speech that this Court has identified in its prior jurisprudence. For example, in *Walker*, this Court ruled that the designs on specialty state license plates constituted government speech. 135 S. Ct. at 2253. Crucial to this determination were the facts that Texas *required* all motor vehicles to display valid license plates issued by the state and that the state *owned* all license plate designs, "including the designs that Texas adopt[ed] on the basis of proposals made by private individuals and organizations." *Id.* at 2244, 2248. As a result, Texas maintained "direct control

over the messages conveyed" by license plates. *Id.* at 2249. This Court further observed that states long have used license plates "to urge action, to promote tourism, and to tout local industries," *id.* at 2248, all of which "'are meant to convey and have the effect of conveying a government message.'" *Id.* at 2251 (quoting *Summum*, 555 U.S. at 472).

Similarly, in *Summum*, this Court ruled that monuments on government property constituted government speech. "By accepting a privately donated monument and placing it on city property, a city engages in expressive conduct . . . ." *Summum*, 555 U.S. at 476. The placing of a monument on government property constitutes speech by the government "because it wishes to convey some thought or instill some feeling in those who see the structure." *Id.* at 470; *see also Johanns v. Livestock Mktg. Ass'n*, 544 U.S. 550, 562 (2005) (finding government speech doctrine applicable where government "sets the overall message to be communicated and approves every word that is disseminated").

A trademark registration, by contrast, does not constitute expressive government activity, but rather "is a regulatory activity." *Tam*, 808 F.3d at 1346. The registrant—not the government—creates and selects the trademark it uses in commerce. And the registrant—not the government—retains ownership of the trademark and directly controls how that mark is used and what, if any, message the mark communicates. Thus, as the *Tam* majority properly observed,

"[w]hen the government registers a trademark, the only message it conveys is that a mark is registered." *Id.*; *see also* McCarthy §§ 19:2 (observing that the federal register serves "as a centralized and efficient national list of marks" and provides notice to potential users of existing similar marks); 19:3 ("Although a federal registration gives the owner of a mark very important and valuable legal rights and benefits, the registration does not create the trademark.").

Unlike license plates, trademark registrations are not mandated by the government as a prerequisite to the use of a mark. Indeed, a trademark owner may use the same mark and convey the same message regardless of whether that mark is registered. *See Tam*, 808 F.3d at 1333 (observing that "refusal to register a mark under § 2(a) does not bar the applicant from using the mark").

Nor do the facts that the government publishes lists of all trademark registrations, issues certificates of registration, or permits registrants to use the ® symbol[14] demonstrate that the government is engaging in expressive speech relating to the registered mark. Issuing a registration does not convert third-party speech

---

[14] Owners of unregistered marks often utilize the ™ symbol, which—like the ® symbol—informs consumers that the owner is asserting trademark rights. *See* McCarthy § 19:148.

into government speech. *Id.* at 1346-47. Rather, the registration of a trademark on the principal register merely provides third parties with "constructive notice of the *registrant's* claim of ownership thereof." 15 U.S.C. § 1072 (emphasis added).

B. The Public Does Not Associate Registered Trademarks with Any Expressive Government Activity

Because the government's role in registering a trademark is regulatory, registration does not cause the public to associate any particular mark with the government. Even the TTAB has previously recognized that "the act of registration is not a government imprimatur or pronouncement that the mark is a 'good' one in an aesthetic, or any analogous, sense." *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1219 n.3 (T.T.A.B. Mar. 3, 1993); *see also Tam*, 808 F.3d at 1347 (quoting same). Indeed, the entire purpose of a trademark—identifying the mark's *owner* as the source of goods or services—is "antithetical to the notion" that consumers would associate a particular registration with the government. *Tam*, 808 F.3d at 1345.

By contrast, license plates, state flags (registration of which is prohibited by Section 2(b) of the Lanham Act), and public monuments constitute government speech in part because, as vehicles for speech in which the government actively participates, they "'are often closely identified in the public mind with the [State].'" *Walker*, 135 S. Ct. at 2248 (alterations in original)

(quoting *Summum*, 555 U.S. at 472); *see also Summum*, 555 U.S. at 487 (Souter, J., concurring) (suggesting that analysis should focus on "whether a reasonable and fully informed observer would understand the expression to be government speech, as distinct from private speech the government chooses to oblige").

As the Federal Circuit observed, the government performs numerous ministerial activities that neither constitute expressive activity by the government, nor imply government endorsement of the registration or permit at issue.[15] *Tam*, 808 F.3d at 1346. The fact that the government has final approval authority over such activities—including issuing permits for street parades, granting medical, hunting, fishing or driver's licenses, or recording property titles, birth certificates or articles of incorporation—does not mean that it is engaging in speech by exercising such authority. *Id.* at 1348. "To conclude otherwise would transform every act of government registration into one of government speech and thus allow rampant viewpoint discrimination." *Id.*

---

[15] Just as registration of "Just Do It" (Reg. No. 1,875,307) does not constitute government endorsement of Nike or the call to athletic accomplishment encouraged by that mark, registration of the "SLANTS" mark would not constitute government endorsement of Mr. Tam or any message conveyed by his mark.

IV. SECTION 43(A) IS AVAILABLE TO ENFORCE RIGHTS IN DISPARAGING MARKS

Regardless of whether the disparagement provision of Section 2(a) of the Lanham Act passes constitutional muster, owners of unregistrable trademarks may still seek relief under Section 43(a). In footnote 11 of its opinion, the Federal Circuit erroneously contended that "it is not at all clear" that the owner of a trademark denied registration under Section 2(a)'s disparagement provision can bring a claim for unfair competition under Section 43(a). *Tam*, 808 F.3d at 1344 n.11. To the contrary, Section 43(a) of the Lanham Act is—and has always been—available to protect all designations of origin, even those that cannot be registered under Section 2(a). This Court should correct the Federal Circuit's error.

Section 43(a) broadly protects "designation(s) of origin," and makes no distinction between marks that are registered or unregistered. 15 U.S.C. § 1125(a)(1). *All* designations of origin that are inherently distinctive or have acquired distinctiveness (and, for trade dress, that are not functional) are entitled to the full protections of Section 43(a), regardless of whether they "may disparage."

As explained below, the legislative history of the Lanham Act reveals that Congress intended to ratify and codify numerous court decisions that broadly interpreted Section 43(a) to protect designations that could not be registered as trademarks. The Federal Circuit ignored this

history in concluding otherwise. And none of the cases the Federal Circuit cited to support its comment regarding Section 43(a) involved a term that was denied registration as disparaging. INTA respectfully urges this Court to correct this error, to avoid having that dicta cited in future cases.

A. The Text of Section 43(a) Does Not Limit Protection to Registrable Marks

The Federal Circuit quoted *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992), for the proposition that "the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)." But this statement merely conveys the unremarkable principle that a term must have source-identifying properties in order to be federally registered or form the basis of a Section 43(a) claim.

Nothing in the text of Section 43(a) supports the broader claim (as the Federal Circuit suggested) that a term must satisfy all "qualifications" of registrability to be protected under Section 43(a). The term "qualifying" does not appear in Section 43(a), and the Federal Circuit's generalizations overlook that Section 2 is by its terms limited to rules governing registration of "trademarks" rather than protection of "designations of origin." Section 2 is entitled "Trademarks registrable on principal register; concurrent registration" and begins thus: "No

trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless . . .." 15 U.S.C. § 1052.

Section 43(a), by contrast, protects designations that are not registered or registrable. It does not use the terms "trademark" or "mark," both of which are explicitly defined in Section 45, but uses the much broader phrase "designation of origin." Nor does Section 43(a) exclude from protection marks that "may disparage," something Congress clearly knew how to articulate were that its intention.

To the contrary, Section 43(a) makes it actionable to use "*any* word, term, name, symbol, or device, or *any* combination thereof, or *any* false designation of origin, false or misleading description of fact, or false or misleading representation of fact." *Id.* § 1125(a)(1) (emphases added). It does not contain any exclusions comparable to those in Section 2(a) or any express declaration that a designation of origin must "qualify" for registration.

The legislative history of Section 43(a) confirms that Congress chose the term "any" to broaden the scope of protection provided under Section 43(a). The current text of Section 43(a) is a product of the Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935 (effective Nov. 16, 1989). Prior to these amendments, Section 43(a) created a civil action for use of "a false designation of

origin."[16] The 1988 amendments changed the text to create liability for the use of "*any* word, term, name, symbol, or device, or *any* combination thereof, or *any false designation of origin*." 15 U.S.C. § 1125(a)(1) (emphasis added). This unambiguously broad language affords no support for the argument that protection under Section 43(a) is only available if all of the trademark registration strictures of Section 2 are met.

At the time of the 1988 amendments, Congress was well aware that courts were broadly interpreting Section 43(a) to protect unregistered marks. As Professor McCarthy noted, "[s]everal courts have held that Lanham Act § 43(a) is a remedial statute that should be broadly construed." McCarthy § 27:8. Nonetheless, rather than narrow the terms that could be protected, Congress used language that emphasized the broad scope of Section 43(a).

Indeed, as a supporting Senator explained, the 1988 legislation "amends the language of section 43(a) of the Lanham Act to *conform it to the*

---

[16] Prior to November 16, 1989, Section 43(a) read: "Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, *a false designation of origin*, or any false description or representation . . .." 15 U.S.C. § 1125(a) (1988) (emphasis added).

expanded scope of protection it has been given by the courts."[17]

B. Courts Have Routinely Permitted Section 43(a) Claims to Proceed for Unregistrable Marks

We are aware of no court—in more than fifty years of Section 43(a) jurisprudence—holding that a "designation of origin" cannot be protected under Section 43(a) if Section 2(a) bars its registration. On the contrary, numerous decisions have extended Section 43(a) protection to designations that are not registrable.

For example, trade names cannot be registered as trademarks, *see* McCarthy § 9:13, but they can be protected under Section 43(a). *See, e.g., Accuride Int'l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1534, 10 U.S.P.Q.2d 1589, 1591 (9th Cir. 1989); McCarthy § 27:15. Likewise, single book titles are not registrable as trademarks, but may be protectable under Section 43(a) if they have acquired secondary meaning. *See Re v. Smith*, 77 U.S.P.Q.2d 1858, 1858 n.1 (D. Mass. 2005) (citing *EMI Catalogue P'ship v. Hill, Holliday, Connors,*

---

[17] 134 Cong. Rec. 5864, at 5869 (1988) (statement of Sen. Dennis DeConcini), *reprinted in* U.S. Trademark Ass'n, The Legislative History, Reports, Testimony, and Annotated Statutory Text: The Trademark Law Revision Act of 1988 (Public Law 100-667), at 141 (1989) (emphasis added).

Cosmopulos Inc., 228 F.3d 56, 63 (2d Cir. 2000)); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999).

Sugar Busters LLC v. Brennan is instructive. The authors of a popular diet book entitled "Sugarbusters" brought a Section 43(a) action to enjoin the defendants' "Sugar Bust for Life" book. The defendants responded with an argument structurally identical to the Federal Circuit's argument here: that, if a mark is not registrable under Section 2(a), then it cannot be protected under Section 43(a). *Sugar Busters*, 177 F.3d at 267. But the Fifth Circuit disagreed, holding that Section 43(a) is available even if the title could not be registered. *Id.* at 269.

Courts have consistently adopted a broad view of Section 43(a) as a catchall remedy for any word or term likely to cause confusion. They have done so without requiring that the term at issue adhere to the strictures of registration, and without any express cross-linkage to registrability. Accordingly, the position expressed in the Federal Circuit's commentary cannot be squared with Section 43(a) jurisprudence.

C. None of the Cases Relied Upon by the Federal Circuit Involved a Mark Challenged, Let Alone Found Unregistrable, Under Section 2(a)

None of the three cases on which the Federal Circuit relied considered—let alone addressed—whether a mark not registrable under Section 2(a) nevertheless may be protected under Section 43(a). For example, in *Two Pesos*, this Court considered whether "trade dress that is inherently distinctive is protectable under § 43(a) without a showing that it has acquired secondary meaning." 505 U.S. at 767. The Federal Circuit relied on this Court's observation that "§ 43(a) protects qualifying unregistered trademarks and . . . the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)." *Id.* at 768. But the *Two Pesos* language was taken entirely out of context.

The "for the most part" qualifier in the language quoted by the Federal Circuit reflects that not all principles governing registrability of marks in Section 2 apply to common law rights. Moreover, the only "general principles" at issue in *Two Pesos* concerned whether trade dress was *distinctive* for purposes of source-identification, and thus protectable under Section 43(a). *See id.* at 768-69. These principles establish that only a distinctive, source-identifying mark is protectable and thus, distinctiveness is a prerequisite both to Section 2

registration and to relief under Section 43(a). The opinions in *Two Pesos* and *Yarmuth-Dion, Inc. v. D'ion Furs, Inc.*, 835 F.2d 990, 992 (2d Cir. 1987), merely reiterate those principles without ever addressing whether Section 43(a) protection is available for marks deemed unregistrable under Section 2(a).

The district court in *Renna v. County of Union*—which addressed Section 2(b), not Section 2(a)—made the same misinterpretation of *Two Pesos* as the Federal Circuit here. *See* 88 F. Supp. 3d 310, 320-21 (D.N.J. 2014). Indeed, Professor McCarthy criticized the conclusion in *Renna* that unregistrable marks are not actionable under Section 43 by flatly observing "[t]here is no statutory or case law support for such a view." McCarthy § 19:78 n.4; *see also Bros. of the Wheel M.C. Exec. Council, Inc. v. Mollohan*, 909 F. Supp. 2d 506, 542 (S.D. W. Va. 2012) (although mark incorporating the American flag was not registrable under Section 2(b), it could still be protected under Section 43(a)). Like the district court in *Renna*, the *Tam* majority improperly treated registrability of a mark as a prerequisite to protectability generally. But registration or registrability has never been held to be a prerequisite to protection under Section 43(a), and there is nothing in the Lanham Act to suggest otherwise. As noted above, distinctiveness is the hallmark of protectability and the prerequisite both for Section 43(a) protection *and* Section 2 registration.

Accordingly, the Court should confirm that Section 43(a) is available to protect all distinctive

designations of origin, including those that cannot be registered under Section 2(a).

CONCLUSION

For the foregoing reasons, the Court should conclude that trademarks are commercial speech and governmental regulations thereon are subject to intermediate scrutiny, but also rule that the "may disparage" provision of Section 2(a) of the Lanham Act, as drafted, is unconstitutional.

December 16, 2016

Respectfully submitted,

Lawrence K. Nodine
BALLARD SPAHR LLP
999 Peachtree Street,
Suite 1000
Atlanta, GA 30309
(678) 420-9422
nodinel@ballardspahr.com

Anthony J. Dreyer
Counsel of Record
Andrew L. Green
SKADDEN, ARPS, SLATE,
MEAGHER & FLOM LLP
Four Times Square
New York, NY 10036
(212) 735-3000
anthony.dreyer@skadden.com

Robert D. Carroll
GOODWIN PROCTER LLP
100 Northern Avenue
Boston, MA 02210
(617) 570-1753
rcarroll@goodwinlaw.com

John W. Crittenden
COOLEY LLP
101 California Street
5th Floor
San Francisco, CA 94111
(415) 693-2090
jcrittenden@cooley.com

Counsel for Amicus Curiae
International Trademark Association

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR,
UNITED STATES PATENT AND TRADEMARK OFFICE,
Petitioner,

v.

SIMON SHIAO TAM,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF JUSTICE AND FREEDOM FUND AS *AMICUS CURIAE* IN SUPPORT OF RESPONDENT

James L. Hirsen
Counsel of Record
505 S. Villa Real Drive, Suite 208
Anaheim Hills, CA 92807
(714) 283-8880
hirsen@earthlink.net

Deborah J. Dewart
620 E. Sabiston Drive
Swansboro, NC 28584-9674
(910) 326-4554
debcpalaw@earthlink.net

Counsel for Amicus Curiae

Becker Gallagher · Cincinnati, OH · Washington, D.C. · 800.890.5001

TABLE OF CONTENTS

TABLE OF AUTHORITIES ... iii

INTEREST OF *AMICUS CURIAE* ... 1

INTRODUCTION AND SUMMARY OF THE ARGUMENT ... 1

ARGUMENT ... 4

I THE GOVERNMENT IS NOT DISSEMINATING ITS OWN SPEECH. ... 4

II THE GOVERNMENT IS NOT SUBSIDIZING SPEECH OR FUNDING ITS OWN MESSAGE. ... 9

III THE GOVERNMENT TARGETS THE EXPRESSIVE ASPECTS OF SPEECH IN WHICH COMMERCIAL AND NON-COMMERCIAL EXPRESSION ARE "INEXTRICABLY INTERTWINED." ... 12

A. The Disparagement Provision Does Not Serve The Purposes Of Trademark Law. ... 14

B. Trademarks May Contain "Inextricably Intertwined" Commercial And Non-Commercial Expression. ... 15

C. The Disparagement Provision Cannot Survive Even The Intermediate *Central Hudson* Test For Commercial Speech. ... 18

IV THE GOVERNMENT IS CENSORING PRIVATE SPEECH—CONTRARY TO THE FIRST AMENDMENT. ... 20

A. Subjectivity Pervades The Examination Process. 21

B. Suppression Of Protected Speech In The Form Of Viewpoint Discrimination Is The Inevitable Result Of The Subjective Examination Process. 28

C. Strict Scrutiny Must Be Applied To This Content-Based Statute. 30

CONCLUSION 32

TABLE OF AUTHORITIES

CASES

44 Liquormart, Inc. v. Rhode Island,
517 U.S. 484 (1996) 8, 14, 22

Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.,
133 S. Ct. 2321 (2013) 11

ACLU v. Tata,
742 F.3d 563 (4th Cir. 2014) 5

Arkansas Ed. Television Comm'n v. Forbes,
523 U.S. 666 (1998) 7, 10

Ayres v. City of Chicago,
125 F.3d 1010 (7th Cir. 1997) 18

B&B Hardware, Inc. v. Hargis Indus.,
135 S. Ct. 1293 (2015) 23

Bartnicki v. Vopper,
532 U.S. 514 (2001) 15

Berger v. ACLU,
135 S. Ct. 2886 (2015) 5

B.H. ex rel Hawk v. Easton Area Sch. Dist.,
725 F.3d 293 (3d Cir. 2013) 18

Bigelow v. Virginia,
421 U.S. 809 (1975) 13

Bd. of Regents of Univ. of Wis. System v. Southworth,
529 U.S. 217 (2000) 6, 7, 12

Bolger v. Youngs Drug Prods. Corp.,
463 U.S. 60 (1983) 14

Boos v. Barry,
485 U.S. 312 (1988) 30

Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n,
447 U.S. 557 (1980) 13, 14, 18, 19

Eastern Railroad Presidents Conference v. Noerr Motor Freight, Inc.,
365 U.S. 127 (1961) 15

Edenfield v. Fane,
507 U.S. 761 (1993) 14, 15, 19, 20

F.C.C. v. Fox Television Stations, Inc.,
132 S. Ct. 2307 (2012) 28

Forsyth Cty. v. Nationalist Movement,
505 U.S. 123 (1992) 29

Friedman v. Rogers,
440 U.S. 1 (1979) 13

In re Geller,
751 F.3d 1355 (Fed. Cir. 2014) 22, 25

Hague v. Committee for Industrial Organization,
307 U.S. 496 (1939) 26

In re Heeb Media, LLC,
89 U.S.P.Q.2d 1071, 2008 WL 5065114 (T.T.A.B. 2008) 25

Hoffman v. Capital Cities/ABC, Inc.,
255 F.3d 1180 (9th Cir. 2001) 18

Johanns v. Livestock Marketing Ass'n,
544 U.S. 550 (2005) 10

Lakewood v. Plain Dealer Pub. Co.,
486 U.S. 750 (1988) 26

In re Lebanese Arak Corp.,
94 U.S.P.Q.2d 1215 (T.T.A.B. 2010) 23, 24

Legal Services Corporation v. Velazquez,
531 U.S. 533 (2001) 11

Lorillard Tobacco Co. v. Reilly,
533 U.S. 525 (2001) 19, 20

Marsh v. Alabama,
326 U.S. 501 (1946) 15

National Endowment for the Arts v. Finley,
524 U.S. 569 (1998) 10, 11

New York Times Co. v. Sullivan,
376 U.S. 254 (1964) 15

In re Old Glory Condom Corporation,
26 U.S.P.Q.2d 1216, 1993 WL 114384 (T.T.A.B.
1993) 5

Pleasant Grove City v. Summum,
555 U.S. 460 (2009) 7

R.A.V. v. City of St. Paul,
505 U.S. 377 (1992) 20, 29, 32

Reed v. Town of Gilbert,
135 S. Ct. 2218 (2015) 26, 28, 29, 30

Riley v. National Federation of Blind, Inc.,
487 U.S. 781 (1988) 17

In re Riverbank Canning Co.,
95 F.2d 327 (C.C.P.A. 1938) 24

Rosenberger v. Rector and Visitors of Univ. of Va.,
515 U.S. 819 (1995) 12, 29

Rust v. Sullivan,
500 U.S. 173 (1991) 10

Sons of Confederate Veterans, Inc. v. Comm'r of Va. Dep't of Motor Vehicles,
305 F.3d 241 (4th Cir. 2002) 5

Sorrell v. IMS Health, Inc.,
131 S. Ct. 2653 (2011) 20, 28, 30

South Dakota v. Dole,
483 U.S. 203 (1987) 11

In re Summit Brass and Bronze Work, Inc.,
59 U.S.P.Q. 22, 1943 WL 8300
(TTAB 1943) 24, 27

In re Tam,
808 F.3d 1321 (Fed. Cir. 2015) ..... *passim*

Texas v. Johnson,
491 U.S. 397 (1989) 29

Trade-Mark Cases,
100 U.S. 82 (1879) 9

United States v. Am. Library Ass'n, Inc.,
539 U.S. 194 (2003) 7, 11

Valentine v. Chrestensen,
316 U.S. 52 (1942) 13

Village of Schaumberg v. Citizens for a Better Environment,
444 U.S. 620 (1980) 17

Virginia Pharmacy Board v. Virginia Citizens Consumer Council, Inc.,
425 U.S. 748 (1976) 13, 22

Walker v. Sons of Confederate Veterans, Inc.,
135 S. Ct. 2239 (2015) ..... *passim*

Ward v. Rock Against Racism,
491 U.S. 781 (1989) ..... *passim*

West Virginia Bd. of Ed. v. Barnette,
319 U.S. 624 (1943) 21

Wooley v. Maynard,
430 U.S. 705 (1977) 7

STATUTES

7 U.S.C.S. § 2901(b) 10

15 U.S.C.S. § 1052(a) 4, 9, 27

15 U.S.C.S. § 1127 ..... 21, 31

20 U.S.C.S. § 951(7) 11

Tex. Transp. Code Ann. § 504.801(c) 6

OTHER AUTHORITIES

Joseph P. Bauer, *ARTICLE: Copyright and the First Amendment: Comrades, Combatants, or Uneasy Allies?*, 67 Wash & Lee L. Rev. 831 (Summer 2010) 15

Hearing on H.R. 4744 Before the Subcomm. on Trademarks of the H. Comm. on Patents, 76th Cong. 21 (1939) 27

Mark McKenna, *The Normative Foundations of Trademark Law*, 82 Notre Dame L. Rev. 1839 (2007) 31

Carl J. Minniti III, *Article: The Lanham Act's Unconstitutional Hodgepodge*, 17 Rutgers J. Law & Relig. 315 (Spring 2016) ..... *passim*

Kristian D. Stout, *Article: Terrifying Trademarks and a Scandalous Disregard for the First Amendment: Section 2(a)'s Unconstitutional Prohibition on Scandalous, Immoral, and Disparaging Trademarks*, 25 Alb. L.J. Sci. & Tech. 213 (2015) ..... *passim*

Trademark Manual of Exam. Proc. ("TMEP") § 1203.03 (Jan. 2015 ed.) 27

INTEREST OF *AMICUS CURIAE*[1]

Justice and Freedom Fund, as *amicus curiae*, respectfully submits that the decision of the Eighth Circuit should be reversed.

Justice and Freedom Fund is a California non-profit, tax-exempt corporation formed on September 24, 1998 to preserve and defend the constitutional liberties guaranteed to American citizens, through education, legal advocacy, and other means. JFF's founder is James L. Hirsen, professor of law at Trinity Law School and Biola University in Southern California and author of New York Times bestseller, *Tales from the Left Coast*, and *Hollywood Nation*. Mr. Hirsen is a frequent media commentator who has taught law school courses on constitutional law. Co-counsel Deborah J. Dewart is the author of *Death of a Christian Nation* (2010) and holds a degree in theology (M.A.R., Westminster Seminary, Escondido, CA). JFF has made numerous appearances in this Court as *amicus curiae*.

INTRODUCTION AND SUMMARY OF THE ARGUMENT

Section 2(a) of the Lanham Act has been called a "Hodgepodge. . .a statutory monster." Carl J. Minniti III, *Article: The Lanham Act's Unconstitutional*

---

[1] The parties have consented to the filing of this brief. *Amicus curiae* certifies that no counsel for a party authored this brief in whole or in part and no person or entity, other than *amicus*, its members, or its counsel, has made a monetary contribution to its preparation or submission.

Hodgepodge, 17 Rutgers J. Law & Relig. 315 (Spring 2016).

> Lurching quietly and stalking with menace, the Hodgepodge picked off unsuspecting victims for decades. In broad daylight, the Hodgepodge snuck behind its victim placing a muzzle on their mouth. Anyone who gave a cross eye – ridiculed. Anyone who dares question the Hodgepodge's existence – a heretic. An amalgam of supposed morality and societal decency, the Government released the Hodgepodge on any citizen bold enough to wade into commercial waters without sensitivity to such morality and societal decency. For years, the Hodgepodge has been the Government's loyal hound, eager to deny federal protection to those stepping outside the bounds of accepted decorum. But, alas, the Hodgepodge may now be dead.

Id. This Court can assure that the "statutory monster" has a decent burial.

Section 2(a) is an anomaly, placed among statutory bars that actually serve the Lanham Act's purposes—avoiding confusing similarity and deception, protecting the markholder's investment. The "disparagement" provision is a classic content-based law. Even though that content is partially or wholly commercial, the government specifically targets its expressive aspects when refusing to register a "disparaging" mark. The highly subjective examination process leaves government officials free to manipulate the system and engage in viewpoint discrimination.

Petitioner's arguments consistently miss the mark. The government is neither speaking nor funding a message of its own. A trademark is created, owned and used by the markholder. A major purpose of trademark registration is to identify the source of goods—and that source is the markholder, not the government. Any message expressed by the mark is clearly identified with that markholder. The government is also not funding or subsidizing the markholders, their messages, or their commercial activities. On the contrary, user fees fund the registration program and the government appropriates no funds. The Lanham Act originated with congressional power under the Commerce Clause—not the Spending Clause. Registration grants legal rights to the markholder—not the government—and protects the markholder's investment—not the government's funds.

If this Court allows the government the ability to subjectively eliminate speech utilizing criteria that is unrelated to consumer protection, viewpoint-based discrimination of speech is the inevitable result.

The government performs administrative functions by maintaining a centralized database that is easily accessible to both consumers and businesses. It also acts in a regulatory capacity by ensuring that new registrations are not confusingly similar to previously registered marks. The government has distorted its role in a misguided attempt to transform private expression into a government subsidy and/or government speech. This case is an opportunity to clarify and cabin the government speech doctrine following *Walker v. Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015). This Court should limit that

doctrine to situations where the government disseminates its own message, and not allow it to encroach on private speech.

ARGUMENT

I. THE GOVERNMENT IS NOT DISSEMINATING ITS OWN SPEECH.

The government does not create, own, or control the use of a private trademark in the owner's business. The government does not own the goods which bear the mark and identify their source. The government has no financial investment in the mark. It is the private owner who creates the mark, applies for registration, retains ownership, and uses it in commerce. The government's role is administrative. As the Federal Circuit correctly concluded, "[t]here is no government speech at issue in the rejection of disparaging trademark registrations that would insulate § 2(a) of the Lanham Act, 15 U.S.C.S. § 1052(a), from First Amendment review." *In re Tam*, 808 F.3d 1321, 1345 (Fed. Cir. 2015).

The government's argument is "unmoored from the very concept of government speech." *Id.* at 1346. A trademark identifies the source of goods. That source is not the government but rather the markholder—and the "[u]se of a mark by its owner is clearly private speech." *Id.* at 1345.

The government never identifies a message it intends to disseminate through trademark registration. Trademarks convey a vast array of diverse messages. The government could not endorse every message without hopeless inconsistency, and Establishment Clause concerns would likely arise concerning marks

containing religious expression. There is no actual risk that the public would view a trademark registration as tantamount to government endorsement. *In re Old Glory Condom Corporation*, 26 U.S.P.Q.2d 1216, 1993 WL 114384 (T.T.A.B. 1993). On the contrary:

> Trademarks are understood in society to identify the source of the goods sold, and to the extent that they convey an expressive message, that message is associated with the private party that supplies the goods or services.

In re Tam, 808 F.3d at 1347. The government's association with trademarks is tangential, and its case citations bear little resemblance to the trademark registration scheme.

1. License plates are not analogous. The government's reliance on *Walker* is misplaced. License plates are perhaps "the quintessential example of speech that is both private and governmental." *Sons of Confederate Veterans, Inc. v. Comm'r of Va. Dep't of Motor Vehicles*, 305 F.3d 241, 245 (4th Cir. 2002). The state manufactures the plates, retains ownership, and places its name on them. The plates serve an important government function—vehicle identification. The private speakers' agreement with the message does not supersede the state's role. License plate schemes vary widely from state to state, or even within one state. Texas had three schemes, and only one of them was before this Court in *Walker*. *Walker*, 135 S. Ct. at 2244. Some, as in *Walker*, require a level of government editorial control that renders them government speech. *See also Berger v. ACLU*, 135 S. Ct. 2886 (2015), vacating and remanding *ACLU v. Tata*, 742 F.3d 563 (4th Cir. 2014) (North Carolina "Choose Life" and other

specialty license plates require legislative authorization). Individualized vanity plates—which were not before this Court in *Walker*—present stronger arguments for private speech. Trademarks, in contrast to license plates, are not owned by the state, use no state property, and bear no seal of government approval. The registration process is largely invisible to the general public, other than the small ® placed on a markholder's goods.

License plates are a unique avenue of communication, and while it is precarious to rely on them as precedent, a few notes of comparison are in order. There is a surface similarity between this case and *Walker*, where the government could refuse to create a specialty plate if, inter alia, "the design might be offensive to any member of the public." *Walker*, 135 S. Ct. at 2245; Tex. Transp. Code Ann. § 504.801(c). This is roughly parallel to the disparagement provision in trademark law. But the similarity ends there. The government's freedom to speak "reflects the fact that it is the democratic electoral process that first and foremost provides a check on government speech. See *Bd. of Regents of Univ. of Wis. System v. Southworth*, 529 U.S. 217, 235 (2000)." *Walker*, 135 S. Ct. at 2245. The Texas statutory scheme included a process that invited public comment. *Id.* This differs from trademark approval, where the government examiner has far broader discretion and a sole official may easily engage in viewpoint discrimination. Texas retained ownership of both the plate itself and the specialty design (*id.* at 2251)—unlike the trademark program where the markholder owns the design and the goods to which the mark is affixed. This Court found that Texas was "not simply managing government property,

but instead [was] engaging in expressive conduct." *Id.* Trademarks involve no comparable government expression. Instead, the government examines applications to ensure that a proposed mark is not confusingly similar to one already registered. This limited inspection serves the purposes of the Lanham Act. Finally, license plates have historically been used to promote state purposes rather than private expression. Opening the program to private expression also opened the door to litigation. *Walker* and other license plate cases highlight the difficulty, in some contexts, of drawing the line between public and private speech. But the line is not so blurred in trademark registration, where the only "government message" is the mere fact that a mark is registered.

The compelled speech doctrine in *Wooley v. Maynard* is even further removed from this case. There is no analogy whatsoever. *Wooley* addresses the "First Amendment right to avoid becoming the courier" for "the State's ideological message" by using one's personal vehicle as a "mobile billboard." *Wooley v. Maynard*, 430 U.S. 705, 715, 717 (1977). Here, there is no government message at all—let alone a message forced on private speakers.

2. Public monuments, libraries, and television stations are not analogous. *See Pleasant Grove City v. Summum*, 555 U.S. 460 (2009) (Ten Commandments monument donated for public park), *United States v. Am. Library Ass'n, Inc.*, 539 U.S. 194 (2003) (libraries), *Arkansas Ed. Television Comm'n v. Forbes*, 523 U.S. 666, 672-673 (1998) (public television). In these cases, the government retained editorial control over the

selections without endorsing the private message embedded in any particular item.

Moreover, the government speech argument is at odds with the purposes of the Lanham Act. The purpose of registration, by itself, is not expressive but administrative, although the markholder may create a particular mark for expressive purposes. Trademarks protect both consumers and markholders. The public can be confident of the source when buying a product that bears a particular trademark, and a markholder's investment is protected from misappropriation. *In re Tam*, 808 F.3d at 1328. The registry provides a convenient way for a business to avoid infringing a registered mark. Many of the bars to registration protect consumers—much like the regulation of commercial speech—from "misleading, deceptive, or aggressive sales practices." *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 501 (1996). But the Lanham Act also grants substantial and exclusive rights that protect the markholder's investment, and that purpose is irreconcilable with classifying registered trademarks as government speech.

The trademark registry is a government database similar to real property titles, birth certificates, articles of incorporation, hunting and fishing licenses, parade permits, and copyright registrations. *In re Tam*, 808 F.3d at 1347-48. The government maintains records without granting an official seal of approval. The expression does not morph into government speech:

> To conclude otherwise would transform every act of government registration into one of government speech and thus allow rampant viewpoint discrimination. When the government

> registers a trademark, it regulates private speech. It does not speak for itself.

Id. at 1348.

II. THE GOVERNMENT IS NOT SUBSIDIZING SPEECH OR FUNDING ITS OWN MESSAGE.

The government has not funded trademark registration as part of a government spending program, but rather has constructed a legislative scheme that allows registered trademark users particular legal rights in court. Trademark registration is a regulatory regime administered by the government. It is not a government subsidy, either directly through a monetary grant or indirectly through a tax exemption. Congressional power to regulate trademarks used in interstate commerce is derived from the Commerce Clause—not the Spending Clause. *In re Tam*, 808 F.3d at 1353-54; *see Trade-Mark Cases*, 100 U.S. 82, 96 (1879). The government collects user fees from applicants to fund the registration program, and registration establishes important legal rights, but Congress has not appropriated funds to subsidize the use of trademarks. Furthermore, trademark registration does not inhibit the government's ability to use its own funds to subsidize particular activities. In this case, the question of funding is all about what the government is *not* doing, and the cases that are *not* analogous. Contrary to numerous suggestions from Petitioner (Pet. Op. Br. 8, 9, 10, 11, 14, 15, 19, 29, 36, 43, 44), the government is not engaged in funding or subsidizing the activities of trademark holders.

1. The government is not funding its own message, as it was in *Johanns v. Livestock Marketing Ass'n*, 544 U.S. 550 (2005). In *Johanns*, the government implemented a federal policy to promote the marketing and consumption of beef. That policy, established by statute (The Beef Promotion and Research Act of 1985), authorized raising funds through an assessment on cattle sales and importation. 7 U.S.C.S. § 2901(b). *Johanns*, 554 U.S. at 553. The government set the message and provided for the funding.

2. The government is not funding a message it favors. "The Government can, without violating the Constitution, selectively fund a program to encourage certain activities it believes to be in the public interest, without at the same time funding an alternative program which seeks to deal with the problem in another way." *Rust v. Sullivan*, 500 U.S. 173, 193 (1991). In *Rust*, the government funded family-planning services but chose to exclude abortion. *Id.* at 178. Similarly, a public television station can make editorial judgments about the material presented to viewers. *Forbes*, 523 U.S. at 672-673. The government may appropriate public funds for a program, and when it does, it may define the limits of the program. *Rust*, 500 U.S. 194. But the trademark registration program is not an appropriation of funds comparable to *Rust*. The government's reliance on this case is misplaced.

3. The government is not funding a competitive grant program, where it acts as a patron rather than a regulator. *National Endowment for the Arts v. Finley*, 524 U.S. 569 (1998). In an effort to support the arts, Congress established the NEA in 1965. Federal funds were pledged to "help create and sustain . . . a climate

encouraging freedom of thought, imagination, and inquiry." *Id.* at 573; 20 U.S.C.S. § 951(7). When the government allocates competitive funding in this manner, it may use "criteria that would be impermissible were direct regulation of speech or a criminal penalty at stake." *Finley*, 524 U.S. at 587-588. The refusal to award a grant is not censorship of the artist. The trademark registry is not a competitive grant program. But if it were, this Court noted that "even in the provision of subsidies, the Government may not aim at the suppression of dangerous ideas." *Id.* at 587 (internal citations and quotation marks omitted).

4. The government is not placing conditions on the use of federal funds. Congress may impose conditions on federal funding to achieve its policy objectives. *South Dakota v. Dole,* 483 U.S. 203, 206 (1987). *See, e.g., United States v. Am. Library Ass'n, Inc.,* 539 U.S. 194, 199 (2003) (public library receiving federal funds for internet access must install software to block obscenity or child pornography). Cases like these involve the Spending Clause, which is not the basis for congressional authority to regulate trademarks. Trademark owners do not receive any federal funds, but even where funding is involved, the government may not use conditions as leverage to limit constitutional rights outside the scope of the program it is funding. *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2326 (2013) (funds provided to nongovernmental organizations to fight HIV/AIDS could not be conditioned on the recipient maintaining a policy explicitly opposing prostitution and sex trafficking); *Legal Services Corporation v. Velazquez*, 531 U.S. 533, 547 (2001) ("Congress cannot

recast a condition on funding as a mere definition of its program in every case, lest the First Amendment be reduced to a simple semantic exercise.")

5. The government is not expending funds to encourage diverse expression—but trademarks display diverse private expression and the government is subject to similar constraints. *See, e.g., Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819, 834 (1995) (viewpoint discrimination is impermissible "when the government does not itself speak or subsidize transmittal of a message it favors but instead expends funds to encourage a diversity of views from private speakers") (internal citations and quotation marks omitted); *Southworth,* 529 U.S. at 229 ("The University of Wisconsin exacts the fee at issue for the sole purpose of facilitating the free and open exchange of ideas.").

In short, this case does not involve government funding. Regardless of the content of a particular trademark—and even if it is "disparaging"—the government is not "underwrit[ing] the commercial use of racist, misogynist, or bigoted terms and imagery." *Walker*, 135 S. Ct. at 2245, 2252-2253.

III. THE GOVERNMENT TARGETS THE EXPRESSIVE ASPECTS OF SPEECH IN WHICH COMMERCIAL AND NON-COMMERCIAL EXPRESSION ARE "INEXTRICABLY INTERTWINED."

Trademarks are created by and identified with their private owners. Their use in commerce signifies commercial speech classification. This Court has referred to trademarks as commercial speech. *See, e.g.,*

Friedman v. Rogers, 440 U.S. 1, 11 (1979) (trade name of optometrist was commercial speech). But while many marks are purely commercial in nature, others incorporate political, social, and/or religious expression. Goods can be created and distributed to promote a message, and a trademark may be designed to identify the goods with that message. Under existing precedent the First Amendment "protects commercial speech from unwarranted governmental regulation." *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 561 (1980). And where that speech is intertwined with non-commercial expression, constitutional protection is even stronger.

When Congress exercised its Commerce Clause powers to pass the Lanham Act in 1946, courts had not yet recognized First Amendment protection for commercial speech. On the contrary, this Court had recently declared that "the Constitution imposes [no] restraint on government as respects purely commercial advertising." *Valentine v. Chrestensen,* 316 U.S. 52, 54 (1942). Kristian D. Stout, *Article: Terrifying Trademarks and a Scandalous Disregard for the First Amendment: Section 2(a)'s Unconstitutional Prohibition on Scandalous, Immoral, and Disparaging Trademarks*, 25 Alb. L.J. Sci. & Tech. 213, 222 (2015). Three decades later, "the notion of unprotected commercial speech all but passed from the scene." *Virginia Pharmacy Board v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 759-760 (1976); *Bigelow v. Virginia*, 421 U.S. 809, 818 (1975) ("The fact that the particular advertisement in appellant's newspaper [for legal abortions in New York] had commercial aspects or reflected the advertiser's commercial interests did not negate all First

Amendment guarantees."); *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983) (First Amendment protects unsolicited mailings with information about contraception). The legal landscape shifted dramatically—but the Lanham Act remained intact. Some of its provisions track the rationale underlying commercial speech restrictions, but the "disparagement" bar erects an unconstitutional barrier to free expression.

A. The Disparagement Provision Does Not Serve The Purposes Of Trademark Law.

Trademark law and commercial speech regulation serve similar purposes. Commercial expression "not only serves the economic interest of the speaker, but also assists consumers and furthers the societal interest in the fullest possible dissemination of information." *Cent. Hudson*, 447 U.S. at 561. Regulation helps "to protect consumers from misleading, deceptive, or aggressive sales practices." *44 Liquormart*, 517 U.S. at 501. Similarly, Section 2(a) prohibits deceptive and confusingly similar trademarks, thus providing customers with information about the source of goods and services. Trademark registration also grants legal rights to protect the markholder's investment and assists potential registrants in avoiding duplication. The disparagement provision is not anchored to any of these purposes.

Moreover, commercial speech is sometimes "linked inextricably" with the underlying commercial transaction. The government's interest in regulating that transaction "may give it a concomitant interest in the expression itself." *Edenfield v. Fane*, 507 U.S. 761,

767 (1993) (CPA client solicitation). A trademark, similarly, might be linked to an activity subject to state regulation. But in denying registration to a "disparaging" mark, the government is not regulating the underlying commercial transaction. It is regulating —and suppressing—*only* the expressive aspects of the mark.

B. Trademarks May Contain "Inextricably Intertwined" Commercial And Non-Commercial Expression.

The First Amendment protects a wide range of expression. Its supremacy is evident across a wide spectrum of cases.[2] In addition to speech about political and other matters of public concern, it takes in the arts and entertainment—"serv[ing] a value similar to that fostered by the copyright laws—promoting the creation and dissemination of knowledge and cultural artifacts." Joseph P. Bauer, *ARTICLE: Copyright and the First Amendment: Comrades, Combatants, or Uneasy Allies?*, 67 Wash & Lee L. Rev. 831, 843 (Summer 2010). This Court places a premium on artistic expression, highlighting music as a key example:

---

[2] *See, e.g., New York Times Co. v. Sullivan*, 376 U.S. 254, 292 (1964) (libel action against public official requires proof of "actual malice" in light of free speech rights); *Eastern Railroad Presidents Conference v. Noerr Motor Freight, Inc.*, 365 U.S. 127 (1961) (Sherman Act could not be applied so as to interfere with Petition Clause rights); *Bartnicki v. Vopper*, 532 U.S. 514, 535 (2001) (radio broadcast of intercepted phone conversation on a matter of public concern was protected by the First Amendment even though informants violated wire tap laws); *Marsh v. Alabama*, 326 U.S. 501, 509 (1946) (trespass law violated right of Jehovah's Witness member to distribute literature on a street in a company town).

> Music is one of the oldest forms of human expression. From Plato's discourse in the Republic to the totalitarian state in our own times, rulers have known its capacity to appeal to the intellect and to the emotions, and have censored musical compositions to serve the needs of the state. . . . The Constitution prohibits any like attempts in our own legal order. Music, as a form of expression and communication, is protected under the First Amendment.

Ward v. Rock Against Racism, 491 U.S. 781, 790 (1989). The mark in this case involves both political expression and music—both at the core of the First Amendment:

> With their lyrics, performances, and band name, Mr. Tam and his band weigh in on cultural and political discussions about race and society that are *within the heartland of speech protected by the First Amendment*.

In re Tam, 808 F.3d at 1331 (emphasis added).

Many commercial enterprises involve the creative expression of the business owner and/or customers—music, journalism, photography, graphic design, printing, floral arrangements, cake decorating. That expression may address current political issues or religious beliefs. When a trademark incorporates such non-commercial expression, government examiners are on thin First Amendment ice if they rule it "disparaging" and deny registration.

Assuming that trademarks are a form of commercial speech, where that speech is "inextricably intertwined"

with expressive speech, it does not retain its commercial character but instead must be treated as fully protected expressive speech. This Court "cannot parcel out the speech, applying one test to one phrase and another test to another phrase." *Riley v. National Federation of Blind, Inc.*, 487 U.S. 781, 796 (1988). That is particularly true when the expressive aspect is targeted for regulation. *Riley* built on a principle from an earlier case involving fundraising, where this Court recognized that "[s]olicitation is characteristically intertwined with informative and perhaps persuasive speech seeking support for particular causes or for particular views on economic, political, or social issues." *Village of Schaumberg v. Citizens for a Better Environment*, 444 U.S. 620 (1980). The same is true for trademarks. Trademarks identify commercial goods and services, but "that product or service is not of necessity a purely commercial object." *Terrifying Trademarks*, 25 Alb. L.J. Sci. & Tech. at 243.

Examples.[3] Some approved trademarks identify commercial goods but also transmit messages:

> By serving as a symbol to cultural and political movements, religions, or any other meaningful social structure, what may seem to be a mere commercial object is transformed into an expressive, meaningful cultural artifact.

Terrifying Trademarks, 25 Alb. L.J. Sci. & Tech. at 244. "I Love Boobies," a mark used for bracelets and sunglasses, was designed to raise breast cancer

---

[3] *See Terrifying Trademarks*, 25 Alb. L.J. Sci. & Tech. at 244-247, for discussion of these examples.

awareness and found to be protected expression when a student wore a bracelet to school. *B.H. ex rel Hawk v. Easton Area Sch. Dist.*, 725 F.3d 293, 297-98 (3d Cir. 2013). "[T]he bracelet, a commercial good, became more than a mere commercial good by virtue of its reference to a larger social movement." *Terrifying Trademarks*, 25 Alb. L.J. Sci. & Tech. at 244. Examples from other circuits include: *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1184 (9th Cir. 2001) (magazine about classic films was commercially available but contained non-commercial elements); *Ayres v. City of Chicago*, 125 F.3d 1010, 1017 (7th Cir. 1997) (t-shirts printed with social advocacy messages) ("There is no question that the T-shirts are a medium of expression prima facie protected by the free-speech clause of the First Amendment, and they do not lose their protection by being sold rather than given away.") When examiners apply Section 2(a) it is the expressive character of a mark, rather than the mark's suitability to serve as a source identifier, that ends up being the underlying basis for the disparagement exclusion from registration being applied.

C. The Disparagement Provision Cannot Survive Even The Intermediate *Central Hudson* Test For Commercial Speech.

The government has limited power to restrict commercial speech if "the communication is neither misleading nor related to unlawful activity." *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557, 564 (1980). The limitation must directly advance a substantial state interest, and "if the governmental interest could be served as well by a more limited restriction on commercial speech, the

excessive restrictions cannot survive." *Id.* The framework developed by this Court is "substantially similar to the test for time, place, and manner restrictions." *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 554 (2001) (internal citations and quotation marks omitted). "But the abiding characteristic of valid time, place, and manner regulations is their content neutrality. See *Ward v. Rock Against Racism*, 491 U.S. 781, 791-796 (1989)." *Id.* at 573 (Thomas, J., concurring).

The disparagement provision of Section 2(a) is the antithesis of content neutrality—the government chills protected expression precisely because of its content. Accordingly, it cannot survive even the intermediate *Central Hudson* test—let alone the strict scrutiny that ought to apply. First, it is unrelated to misleading, deceptive, or unlawful communication. On the contrary, it "is squarely based on the expressive aspect of the speech, not its commercial-speech aspects" and thus "discriminates against the mark's political or social message." *In re Tam*, 808 F.3d at 1355. Second, the only government "interest" hinges on disapproval of the message, as perceived by a government official acting with broad discretion to render a value judgment. That judgment is likely speculative. The government must demonstrate that the restriction "directly advance[s] the state interest involved; the regulation may not be sustained if it provides only ineffective or remote support for the government's purpose." *Central Hudson*, 447 U.S. at 564. That burden "is not satisfied by mere speculation or conjecture." *Edenfield v. Fane*, 507 U.S. 761, 770-771 (1993). The government "must demonstrate that the

harms it recites are real and that its restriction will in fact alleviate them to a material degree." *Id.*

This Court should adhere to its earlier precedents by applying strict scrutiny to Section 2(a). Even if commercial speech has reduced constitutional protection, "the government may not engage in content discrimination for reasons unrelated to those characteristics of the speech that place it within the category." *Lorillard Tobacco*, 533 U.S. at 576 (Thomas, J., concurring). *See R.A.V. v. City of St. Paul*, 505 U.S. 377, 384 (1992) ("the government may proscribe libel; but it may not make the further content discrimination of proscribing *only* libel critical of the government"). The government may examine the content of a proposed mark to determine whether it is deceptive or confusingly similar to another mark—but not to suppress the ideas it expresses:

> The First Amendment requires heightened scrutiny whenever the government creates "a regulation of speech because of disagreement with the message it conveys." *Ward v. Rock Against Racism,* 491 U.S. 781, 791 (1989).

Sorrell v. IMS Health, Inc., 131 S. Ct. 2653, 2664 (2011) (striking down content- and speaker-based restrictions on the sale, disclosure, and use of prescriber-identifying information).

IV. THE GOVERNMENT IS CENSORING PRIVATE SPEECH—CONTRARY TO THE FIRST AMENDMENT.

The government has an administrative role in maintaining a centralized trademark database. Its limited examination of content ensures that a

registered mark accurately identifies the source of goods and is not deceptive, duplicative, or confusingly similar to another mark. This furthers the purposes of the Lanham Act. But additional examination—to determine whether a mark "disparages" some ill-defined group of persons or beliefs—thrusts the government into forbidden First Amendment territory:

> If there is any fixed star in our constitutional constellation, it is that no official, high or petty, can prescribe what shall be orthodox in politics, nationalism, religion, or other matters of opinion or force citizens to confess by word or act their faith therein.

West Virginia Bd. of Ed. v. Barnette, 319 U.S. 624, 642 (1943).

Although trademark registration is not a typical speech forum, it implicates similar concerns and constitutional principles. There is unacceptable subjectivity inherent in the government's discretion to find a mark "disparaging"—much like the impermissible "unbridled discretion" in a forum analysis. The result is an unconstitutional burden on protected speech that is tantamount to suppression.

A. Subjectivity Pervades The Examination Process.

The statutory text of Section 2(a) can be objectively construed using definitions in the Lanham Act. The relevant term—"persons"—is defined in 15 U.S.C.S. § 1127 to mean either a natural person or a "juristic" person such as a corporation, association, or other identifiable entity capable of suing or being sued. But the statute's objectivity vanishes under a cloud of

judicially crafted tests that presume "persons" may refer to some nebulous group such as Asian-Americans. "In no other area of federal jurisprudence would a court feel at liberty to determine whether political speech was accurate enough to warrant protection or federal recognition." *Terrifying Trademarks*, 25 Alb. L.J. Sci. & Tech. at 226 (commenting on *Lebanese*).

Earlier cases have found that "the greater objectivity of commercial speech justifies affording the State more freedom to distinguish false commercial advertisements from true ones." *44 Liquormart*, 517 U.S. at 499, citing *Virginia Bd. of Pharmacy*, 425 U.S. at 771, n. 24. In trademark law, there should be a similar objectivity in merely determining whether a proposed mark duplicates or is confusingly similar to an existing registered mark. But where examiners have broad discretion to find that a mark "disparages" a "substantial composite" of an identifiable (but vaguely defined) group, that objectivity evaporates. At the very least, examiners should return to the objective basis provided by the text.

Although the Lanham Act provides a clear definition of "persons," it fails to do the same for "disparaging"—leaving government examiners and courts to speculate. One court has defined a disparaging mark as one which "dishonors by comparison with what is inferior, slights, deprecates, degrades, or affects or injures by unjust comparison." *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014) (alterations omitted). In another case, the court crafted a two-part test, first determining the "likely meaning of the matter in question" and then "whether that meaning may be disparaging to a substantial composite

of the referenced group." *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010) (examining the religious and political meanings of the term "Islamisation"). "This – needless to say – is as subjective as you can get." *Hodgepodge*, 17 Rutgers J. Law & Relig. at 325.

Trademarks have ancient roots, dating back to Roman times. "The principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan's goods from those of others." *B&B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293, 1299 (2015). The Lanham Act was based on that principle, and some of the statutory bars to registration help to avoid confusion and deception between marks and the products they identity. But "Section 2(a) is anomaly in this context. It purports to protect the public morals." *Terrifying Trademarks*, 25 Alb. L.J. Sci. & Tech. at 237. The primary purpose of trademark law is to avert confusion in the minds of consumers when purchasing goods. A consumer who attends a concert given by "The Slants," due to promotion of the band using their name, expects to be listening to and watching the actual band associated with the artistic output and reputation associated with the name that induced the purchase of tickets. The registration of trademarks that contain content an examiner would subjectively determine to be offensive, as defined by section 2(a), does not diminish this primary purpose.

Religious themes. Examples of rampant subjectivity include several cases involving marks containing religious connotations. (For a full discussion of these cases, see *Hodgepodge*, 17 Rutgers J. Law &

Relig. at 330-341.) In *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938), the court upheld the refusal to register "Madonna" as a mark for the sale of wine, based on the assumption that "Madonna" could only refer to the Virgin Mary.

> All in all, *In re Riverbank Canning* stands for the proposition that assessing a mark under Section 2(a) inherently involves the injection of the reviewer's subjective belief. Here, the court injected its own beliefs about how wine consumption was seen in the general public. Unfortunately, this approach has permeated trademark law.

Hodgepodge, 17 Rutgers J. Law & Relig. at 330. Another case involved a trademark using the phrase "Agnus Dei" (Latin for "Lamb of God") for metallic tabernacle safes used by Roman Catholic churches. The court upheld the rejection of this mark despite evidence that priests and bishops who purchased the safes did not object to the phrase. *In re Summit Brass and Bronze Work, Inc.*, 59 U.S.P.Q. 22, 1943 WL 8300 (TTAB 1943).

In re Lebanese—the case that initiated the "substantial composite" test—upheld the rejection of a trademark application using the term "KHORAN" to identify alcoholic beverages, because the Koran forbids consumption of alcoholic beverages. The court embarked on a theological excursion—ordinarily forbidden judicial territory in any other context:

> [T]he Board's reasoning was a sham. In one sentence the Board notes that they are not in a position to interpose their own judgment with

> that of Muslims, but in the very next sentence, the Board, after considering the tenets of Islam, made an assumption that a "substantial composite" of Muslim Americans would be disparaged by the mark KHORAN on wine. It is clear from the opinion that the only evidence considered was documents summarizing the religious doctrine of Islam, without any input from Muslim Americans themselves. Perhaps, this is true and a "substantial composite" of the population would find the mark disparaging - but that is not the point. Rather, the tragedy of the decision is that no evidence was used actually indicating that disparagement might occur. Rather, the Board relied on *pure conjecture and subjective interpretation* of the fact that Islam bars the consumption of alcohol.

Hodgepodge, 17 Rutgers J. Law & Relig. at 334 (emphasis added).

The mark HEEB, used to develop a lifestyle brand for clothing and entertainment, was rejected because "Heeb" has been used historically as a derogatory term for Jews—even though the *same* mark, for the *same* applicant, was previously approved for publishing magazines. *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114 (T.T.A.B. 2008)

One of the most recent cases, *In re Geller*, 751 F.3d 1355, held that "STOP THE ISLAMISATION OF AMERICAN" was disparaging and could not be registered. Geller, an activist opposed to the construction of a mosque near Ground Zero in New York City, argued that the phrase had a political rather than religious meaning. The Federal Circuit upheld the

Board's finding that the mark was disparaging to American Muslims under either meaning. Yet political speech and religious speech are both at the heart of the First Amendment.

Unbridled discretion. The subjectivity of the trademark approval process is reminiscent of the concerns about "unbridled discretion" that arise in a speech forum. In cases involving nonpublic or limited public forums, a policy that does not provide sufficient criteria to prevent viewpoint discrimination generally will not survive constitutional scrutiny. *See, e.g., Hague v. Committee for Industrial Organization*, 307 U.S. 496, 516 (1939) (ordinance could be used for arbitrary suppression of free expression because it enabled the Director of Safety to refuse a permit based on his mere opinion that such refusal would prevent "riots, disturbances or disorderly assemblage"); *Lakewood v. Plain Dealer Pub. Co.*, 486 U.S. 750, 758 (1988) (without clear standards, licensing official could use "shifting or illegitimate criteria" to suppress disfavored expression); *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2229 (2015) (a Sign Code compliance manager who disliked the Church's substantive teachings could potentially deploy the Code to make it more difficult for the Church to inform the public of the location of its services). Such unbridled discretion can intimidate persons into censoring their own speech, and render it difficult to determine whether an official has legitimately denied access or illegitimately abused power. *Lakewood*, 486 U.S. at 757-758.

Comparable concerns are present in the trademark context. As concurring Judge O'Malley observed, the PTO's Assistant Commissioner voiced concerns early in

the process that "the word 'disparage' . . . is going to cause a great deal of difficulty in the Patent Office, because . . . it is always going to be just a matter of the personal opinion of the individual parties as to whether they think it is disparaging." *Hearing on H.R. 4744 Before the Subcomm. on Trademarks of the H. Comm. on Patents*, 76th Cong. 21 (1939) (statement of Leslie Frazer). *In re Tam*, 808 F.3d at 1363 (O'Malley, J., concurring). The trademark examination process reveals an unacceptably high level of discretion. Trademark Manual of Exam. Proc. ("TMEP") § 1203.03 (Jan. 2015 ed.) "does not require an examiner who finds a mark disparaging to consult her supervisor or take any further steps to ensure the provision is applied fairly and consistently across the agency." *In re Tam*, 808 F.3d at 1331. "A *single examiner, with no input from her supervisor*, can reject a mark as disparaging by determining that it would be disparaging to a substantial composite of the referenced group." *Id.* (emphasis added). Such open-ended power could be easily manipulated to advance an examiner's viewpoint or to chill an opposing viewpoint.

Moreover, there is inherent uncertainty in the phrase "may disparage." 15 U.S.C. § 1052(a). Opinions may vary as to whether a particular term disparages a certain group. In *In re Summit Brass and Bronze Work* (discussed above), there was evidence that priests and bishops who purchased safes with the allegedly disparaging "Agnus Dei" mark did not object to the phrase. "[R]egulated parties should *know what is required* of them so they may act accordingly," and particularly where speech is at issue, "precision and guidance are necessary so that those enforcing the law do not act in an arbitrary or discriminatory way."

F.C.C. v. Fox Television Stations, Inc., 132 S. Ct. 2307, 2317-18 (2012).

Every time a mark is rejected as "disparaging," it is because "the government [has] made [a] moral judgment[] based solely and indisputably on the mark['s] expressive content." *In re Tam*, 808 F.3d at 1338. The First Amendment precludes this type of government judgment.

Secondary Meaning. The government never considers the development of "secondary meanings" in trademark law. Trademark law is designed to function of the world of business and commerce. A successful mark will eventually take on a *secondary meaning* separate and apart from its literal meaning. For example, the name of the technology giant, Apple, no longer evokes the thought of fruit in the mind of a consumer but rather it has taken on the *secondary meaning* of smartphones, iPads and laptops. Similarly, Mr. Tam "explicitly selected his mark to create a dialogue on controversial political and social issues." *In re Tam*, 808 F.3d at 1338. He wished to transform a phrase that dealt with racial and ethnic identity and alter its meaning in order to "shift the meaning of, and thereby reclaim, an emotionally charged word." *Id.*

B. Suppression Of Protected Speech In The Form Of Viewpoint Discrimination Is The Inevitable Result Of The Subjective Examination Process.

Section 2(a) is indisputably content-based on its face, because it "draws distinctions based on the message a speaker conveys." *Sorrell v. IMS Health, Inc.*, 131 S. Ct. at 2663; *see also Reed,* 135 S. Ct. at

2227. Even Petitioner admits that "[u]nder Section 1052(a)'s disparagement provision, registrability depends on the content of the mark for which registration is sought. . . ." Pet. Op. Br. 36. Moreover, when the government regulates speech based on "the specific motivating ideology or the opinion or perspective of the speaker," that is viewpoint discrimination, an "egregious form of content discrimination." *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U. S. 819, 829 (1995). Here, "the test for disparagement—whether a substantial composite of the referenced group would find the mark disparaging—makes clear that it is the nature of the message conveyed by the speech which is being regulated." *In re Tam*, 808 F.3d at 1335.

The dissent objects that viewpoint discrimination requires *government* disagreement rather than the "assessment of a non-government perspective." *In re Tam*, 808 F.3d at 1372 (Dyk, J., dissenting). Certainly the government may not prohibit or penalize speech because of its own disapproval. *R.A.V. v. City of St. Paul*, 505 U.S. at 382; *Ward v. Rock Against Racism*, 491 U.S. at 791; *Reed*, 135 S. Ct. at 2227. But the prohibition does not end there. "Listeners' reaction to speech is not a content-neutral basis for regulation." *Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123, 134 (1992). "If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply *because society finds the idea itself offensive or disagreeable*." *Texas v. Johnson*, 491 U.S. 397, 414 (1989) (emphasis added).

Boos v. Barry, 485 U.S. 312 (1988) does not support the constitutionality of the disparagement provision even assuming, arguendo, viewpoint neutrality. The dissent cites this case as an example of a similar statute this Court found viewpoint neutral. *In re Tam*, 808 F.3d at 1371 (Dyk, J., dissenting). The challenged statute prohibited display of any sign within 500 feet of a foreign embassy that would tend to bring that foreign government into "public odium" or "disrepute." The determination was made by reference to the policies of foreign governments. *Boos v. Berry*, 485 U.S. at 319. This Court found the statute viewpoint neutral but nevertheless invalid, explaining that "the government has determined that an entire category of speech—signs or displays critical of foreign governments—is not to be permitted." *Id.* The same is true here. An "entire category of speech"—marks that may be disparaging to specified persons or groups—is proscribed. Moreover, the danger of viewpoint discrimination and censorship is much higher. The phrase "may disparage" is so indefinite, and the approval determination so highly subjective, that the process is easily manipulated to suppress viewpoints the government examiner finds disagreeable.

C. Strict Scrutiny Must Be Applied To This Content-Based Statute.

This Court recently reaffirmed that content-based laws "are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests." *Reed*, 135 S. Ct. at 2226. *See also Sorrell*, 131 S. Ct. at 2664 ("The First Amendment requires heightened scrutiny whenever the government creates a regulation

of speech because of disagreement with the message it conveys."). The government refuses to register "disparaging" trademarks because of disagreement with the messages conveyed, and examiners appear to have carte blanche to make the determination.

The government must show a "compelling interest" in rendering such content-based judgments. The dissent suggests that "the purpose of the statute is to protect underrepresented groups in our society from being bombarded with demeaning messages in commercial advertising" (*In re Tam*, 808 F.3d at 1364 (Dyk, J., dissenting)), but the actual language of the Lanham Act describes a much different objective:

> The intent of this Act is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.

15 U.S.C.S. § 1127. Trademark law is based on principles of unfair competition and the tort of consumer deception. *See* Mark McKenna, *The Normative Foundations of Trademark Law*, 82 Notre Dame L. Rev. 1839, 1840-41 (2007); *Hodgepodge*, 17

Rutgers J. Law & Relig. at 318. The statutory language tracks the familiar purposes of registration—to identify the source of goods and services and to protect the markholder's investment. This is not civil rights legislation designed to ensure access to public accommodations. In *R.A.V.*, this Court rejected the City's assertion that an ordinance prohibiting cross burning "helps to ensure the basic human rights of members of groups that have historically been subjected to discrimination." *R.A.V. v. City of St. Paul*, 505 U.S. at 395. Although this interest may be legitimate and even compelling, "the danger of censorship presented by a facially content-based statute requires that the weapon be employed only where it is necessary to serve the asserted [compelling] interest." *Id.* (internal citations and quotation marks omitted).

CONCLUSION

This Court should affirm the Federal Circuit ruling.

Respectfully submitted,

James L. Hirsen
Counsel of Record
505 S. Villa Real Drive, Suite 208
Anaheim Hills, CA 92807
(714) 283-8880
hirsen@earthlink.net

Deborah J. Dewart
620 E. Sabiston Drive
Swansboro, NC 28584-9674
(910) 326-4554
debcpalaw@earthlink.net

Counsel for Amicus Curiae

RECORD AND BRIEFS

No. 15-1293

Supreme Court, U.S.
FILED
NOV 16 2016
OFFICE OF THE CLERK

In The
Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF OF LAW PROFESSORS AS *AMICI CURIAE* IN SUPPORT OF THE PETITIONER

CHRISTINE HAIGHT FARLEY
Counsel of Record
AMERICAN UNIVERSITY WASHINGTON COLLEGE OF LAW
4300 Nebraska Avenue, NW
Washington, DC 20016
(202) 274-4171
cfarley@wcl.american.edu

REBECCA TUSHNET
GEORGETOWN UNIVERSITY LAW CENTER
600 New Jersey Avenue, NW
Washington, DC 20001
(202) 661-9402

Counsel for Amici Curiae

COCKLE LEGAL BRIEFS (800) 225-6964
WWW.COCKLELEGALBRIEFS.COM

Library of Congress

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES iii

INTEREST OF *AMICI CURIAE* 1

SUMMARY OF THE ARGUMENT 1

ARGUMENT 3

I. THE FEDERAL CIRCUIT'S DECISION WRONGLY TREATS TRADEMARK REGISTRATION REFUSAL AS A BAN ON SPEECH 3

A. Trademark Law Is Pervasively Content-Based 4

B. Section 2 Disparagement, Like Defamation Law, Is Content-Based But Viewpoint-Neutral 8

C. Precedents Involving Bans On Speech, Even Commercial Speech Precedents, Do Not Make Sense For Trademark Law 13

II. DENIAL OF REGISTRATION IS NOT A PUNISHMENT FOR SPEECH 15

A. Registration Is Discretionary, And Directed Only At The Trademark Function, Not At Other Meaning 16

B. The Disparagement Bar Does Not Impose An Unconstitutional Condition 20

TABLE OF CONTENTS – Continued

Page

1. The Government Is Not Leveraging Refusal Of Registration For Speech Outside The Registration Program; Applicants Remain Free To Use Any Symbols They Wish 21

2. Unconstitutional Conditions Analysis Is Appropriate Because *Central Hudson* Scrutiny Cannot Properly Assess A Comprehensive Government Program That Requires Evaluation Of Speech To Function 26

3. Analogies To Copyright Are Flawed 29

III. VAGUENESS IS NOT AN INDEPENDENT REASON TO INVALIDATE THE DISPARAGEMENT BAR 32

CONCLUSION 36

APPENDIX

List of *Amici* ..... App. 1

TABLE OF AUTHORITIES

Page

CASES

Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc., 133 S. Ct. 2321 (2013) 22, 24

AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979) 35

Ark. Educ. Television Comm'n v. Forbes, 523 U.S. 666 (1998) 11

B&B Hardware, Inc. v. Hargis Indust., Inc., 135 S. Ct. 1293 (2015) 28

Balducci Publ'ns v. Anheuser-Busch, Inc., 513 U.S. 1112 (1995) 14

Bd. of Trs. of State Univ. of N.Y. v. Fox, 492 U.S. 469 (1989) 19

Belmora LLC v. Bayer Consumer Care AG, 819 F.3d 697 (4th Cir. 2016) 16

Bongrain Int'l (American) Corp. v. Delice de France, Inc., 811 F.2d 1479 (Fed. Cir. 1987) 17

Boos v. Barry, 485 U.S. 312 (1988) 10

Cent. Hudson Gas & Elec. v. Pub. Servs. Comm'n of N.Y., 447 U.S. 557 (1980) ..... *passim*

Cohen v. California, 403 U.S. 15 (1971) 18

Davenport v. Wash. Educ. Ass'n, 551 U.S. 177 (2007) 9

Friedman v. Rogers, 440 U.S. 1 (1979) 17

In re Budge Mfg. Co. Inc., 857 F.2d 773 (Fed. Cir. 1988) 12

TABLE OF AUTHORITIES – Continued

Page

In re Couriaire Express Int'l, Inc., 222 U.S.P.Q. 365 (T.T.A.B. 1984) 32

In re Florists' Transworld Delivery, Inc., No. 77590475, 2014 WL 2951796 (T.T.A.B. Mar. 28, 2013) 7

In re Heeb Media, LLC, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008) 12

In re Nett Designs, Inc., 236 F.3d 1339 (Fed. Cir. 2001) 32

In re Old Glory Condom Corp., 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993) 8

In re Quadrillion Publ'g Ltd., No. 75/217,892, 2000 WL 1195470 (T.T.A.B. Aug. 9, 2000) 8

In re Tam, 808 F.3d 1321 (Fed. Cir. 2015) .....*passim*

In re Volk Art, Inc., No. 74/693,416, 1998 WL 377661 (T.T.A.B. July 8, 1998) 27

In re Wadhwa, No. 86023037, 2016 WL 1045678 (T.T.A.B. Feb. 16, 2016).....27

Int'l Order of Job's Daughters v. Lindeburg & Co., 633 F.2d 912 (9th Cir. 1980) 7

Kelley v. Chi. Park Dist., 635 F.3d 290 (7th Cir. 2011).....31

Machete Productions, L.L.C. v. Page, 809 F.3d 281 (5th Cir. 2015).....24

McDermott v. S.F. Women's Motorcycle Contingent, 240 Fed. App'x 865 (Fed. Cir. 2007) 33

TABLE OF AUTHORITIES – Continued

Page

MGM-Pathe Commc'ns v. Pink Panther Patrol, 774 F. Supp. 869 (S.D.N.Y. 1991) 14

N.Y. Times Co. v. Sullivan, 376 U.S. 254 (1964) 14

National Endowment for the Arts v. Finley, 524 U.S. 569 (1998) 34

Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189 (1985) 3, 5

Parks v. LaFace Records, 329 F.3d 437 (6th Cir. 2003) 14

Penguin Books USA, Inc. v. Dr. Seuss Enters., 521 U.S. 1146 (1997) 14

Pursuing America's Greatness v. Fed. Election Comm'n, 831 F.3d 500 (D.C. Cir. 2016) 27

R.A.V. v. City of St. Paul, 505 U.S. 377 (1992) 10

Regan v. Taxation with Representation of Wash., 461 U.S. 540 (1983) 24

Reed v. Town of Gilbert, 135 S. Ct. 2218 (2015) 4, 13

Renna v. County of Union, 88 F. Supp. 3d 310 (D.N.J. 2014) 6, 16

Ridley v. Mass. Bay Transp. Auth., 390 F.3d 65 (1st Cir. 2004) 9, 11

Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989) 14

Romm Art Creations Ltd. v. Simcha Int'l, Inc., 786 F. Supp. 1126 (E.D.N.Y. 1992) 14

Rosenberger v. Rector & Visitors of Univ. of Va., 515 U.S. 819 (1995) 8, 10

TABLE OF AUTHORITIES – Continued

Page

Rust v. Sullivan, 500 U.S. 173 (1991) 21, 23

San Francisco Arts & Athletics, Inc. v. United States Olympic Comm., 483 U.S. 522 (1987) 14

Sheetz v. Doctor's Ass., Inc., 108 U.S.P.Q.2d 1341 (T.T.A.B. 2013) 23

Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd., 502 U.S. 105 (1991) 30

Thompson Med. Co. v. Pfizer Inc., 753 F.2d 208 (2d Cir. 1985) 35

Van Camp Sea Food Co. v. Alexander B. Stewart Orgs., 50 F.2d 976 (C.C.P.A. 1931) 35

Van Camp Sea Food Co. v. Packman Bros., 79 F.2d 511 (3d Cir. 1935) 35

Walker v. Tex. Div., Sons of Confederate Veterans, 135 S. Ct. 2239 (2015) 24

STATUTES

15 U.S.C. § 1052 ..... *passim*

15 U.S.C. § 1057 15

15 U.S.C. § 1065 15

OTHER

Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 Trademark Rep. 661 (1993) 24

TABLE OF AUTHORITIES – Continued

Page

Christopher Buccafusco, *Making Sense of Intellectual Property Law*, 97 Cornell L. Rev. 501 (2012) 31

Felix S. Cohen, *Transcendental Nonsense and the Functional Approach*, 35 Colum. L. Rev. 809 (1935) 18

Compendium of U.S. Copyright Office Practices (Third) (2014) §§ 313.6(c), 806.5(B)(3) 31

Christine Haight Farley, *Stabilizing Morality in Trademark Law*, 63 Am. U. L. Rev. 1019 (2014) 6, 32

Michael Grynberg, *A Trademark Defense of the Disparagement Bar*, 126 Yale L.J. Forum 178 (2016), http://www.yalelawjournal.org/forum/a-trademark-defense-of-the-disparagement-bar 7

2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th ed. 2016) 36

Beverly W. Pattishall, *Trade-Marks and the Monopoly Phobia*, 50 Mich. L. Rev. 967 (1952) 18

Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 Trademark Rep. 797 (2016) 10, 22, 30

Edward S. Rogers, *Comments on the Modern Law of Unfair Trade*, 3 Ill. L. Rev. 551 (1909) 18

Ned Snow, *Free Speech and Disparaging Trademarks*, 57 B.C. L. Rev. 100 (2016) 11

Geoffrey R. Stone et al., *Constitutional Law* (3d ed. 1996) 9

TABLE OF AUTHORITIES – Continued

Page

Kathleen M. Sullivan, *Unconstitutional Conditions*, 102 Harv. L. Rev. 1413 (1989) 21

Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 91 Notre Dame L. Rev. (forthcoming 2016) (manuscript available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2745016) 3, 29, 36

U.S. Patent & Trademark Office, Performance and Accountability Report Fiscal Year 2015, https://www.uspto.gov/sites/default/files/documents/USPTOFY15PAR.pdf at 198 tbl. 16 33

INTEREST OF *AMICI CURIAE*

This brief is filed on behalf of the undersigned Law Professors identified in Appendix A. *Amici* are scholars at U.S. law schools whose research and teaching focus is intellectual property law. *Amici* have no direct interest in the outcome of this litigation. *Amici* are concerned that the Court of Appeals for the Federal Circuit's decision below – that all content-based determinations in trademark law must survive strict scrutiny – would wreak havoc on trademark law. We wish to bring to the Court's attention the implications of such a rule on trademark law.[1]

SUMMARY OF THE ARGUMENT

The Federal Circuit's ruling that the § 2(a) disparagement provision is unconstitutional, if upheld, could allow for numerous provisions of the Trademark Act to be overturned, dismantling the modern trademark system. The trademark system is premised on evaluating speech and making content-based determinations. Granting a trademark registration requires content-based determinations, though not viewpoint-based, as

[1] Pursuant to Rule 37.6, *Amici* affirm that no counsel for a party authored this brief in whole or in part and that no person other than *Amici* and their counsel made a monetary contribution to its preparation or submission. Petitioner's and Respondent's consent to the filing of amicus briefs is filed with the Clerk. The Parties were timely notified of the intent to file this amicus brief pursuant to Rule 37.2. *Amici's* institutional affiliations are provided only for purposes of identification.

words are evaluated independent of applicants' individual viewpoints.

In no way does the refusal to register a trademark prevent its use or diminish public debate. Rather than facilitating public debate, a trademark registration is a government-issued document that makes it easier for its owner to suppress the speech of others. A trademark registration is not an entry pass to the forum; it is a right to exclude. Thus in trademark law whether the government refuses registration to a mark owner or it arms that owner with a registration to enforce against other speakers, the government inevitably interferes in someone's speech.

The Federal Circuit's mistake was to treat a regulatory, benefit-granting program as if it were a ban on speech. Although prohibiting the *use* of disparaging marks would suppress speech, the government does not suppress speech by refusing to include these marks on the federal register. If a firm wants to use the N-word as its mark, it is free to do so under trademark law. Instead of doctrines focused on banned speech, the unconstitutional conditions doctrine is a more appropriate test for the trademark registration system, and because registration does not attempt to affect a registrant's speech outside the four corners of the registration it poses no First Amendment problem.

The different justifications, functioning, and risks of registration compared to laws punishing speech make application of doctrines about banning speech to the Lanham Act both incoherent and unwise. To rule

otherwise would jeopardize much of the structure of trademark law.

ARGUMENT

I. THE FEDERAL CIRCUIT'S DECISION WRONGLY TREATS TRADEMARK REGISTRATION REFUSAL AS A BAN ON SPEECH.

In its decision below, the Federal Circuit acknowledged that its decision put other provisions of the Lanham Act in jeopardy. Although its specific holding was limited to the refusal of registration for disparaging marks under 15 U.S.C. § 1052(a) [§ 2(a)], the en banc court made clear that its analysis would require reconsidering "the constitutionality of other portions of § 2 in light of the present decision." *In re Tam*, 808 F.3d 1321, 1130 n.1 (Fed. Cir. 2015). This is no idle threat. If the Federal Circuit's ruling stands, much of the screening that the United States Patent and Trademark Office [USPTO] performs could also be found unconstitutional, and many aspects of the current regime, from incontestability[2] to intent-to-use

[2] The result of incontestability is that "trademarks" with no meaning in the marketplace may be used to suppress others' uses of descriptive terms, despite the fact that consumers could not be harmed by such uses. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 207-09 (1985) (Stevens, J., dissenting); Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 91 Notre Dame L. Rev. (forthcoming 2016) (manuscript available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2745016).

applications,[3] to the infringement standard itself, would be threatened. This widespread vulnerability suggests that the Federal Circuit's treatment of the Lanham Act's regulatory scheme as presumptively unconstitutional is misguided.

A. Trademark Law Is Pervasively Content-Based.

The Federal Circuit held that all regulations of speech that depend on an evaluation of the content of the speech to determine whether the regulation has been violated are content-based and must survive strict scrutiny. *In re Tam*, 808 F.3d at 1335 ("It is beyond dispute that § 2(a) discriminates on the basis of content in the sense that it 'applies to particular speech because of the topic discussed,'" *citing Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015).). But if strict scrutiny applies whenever a program of government benefits for specific kinds of commercial speech demands content determinations, then much of § 2, and possibly much more than that, is unconstitutional.

In addition to the bar on disparaging marks, § 2 prohibits the registration of any mark that is: scandalous; immoral; deceptive; falsely suggestive of a connection with persons, institutions or religions; likely to cause confusion with an existing mark; descriptive;

---

[3] The Lanham Act's intent-to-use provisions allow claimants to assert rights in advance of any use – that is, before consumers form any beliefs about the source of products or services bearing the mark, and thus before they could actually be confused by competing uses, changing the common law first-to-use rules.

misdescriptive; functional; a geographic indication for wine or spirits other than the place of origin of the goods; government insignia; a living person's name, portrait or signature without written consent; or a surname. 15 U.S.C. §§ 1052(a-e). Nor, because § 2 requires that a mark be distinctive, may generic symbols be registered. *Id.* at § 1052 (limiting registration to trademarks "by which the goods of the applicant may be distinguished from the goods of others"); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985). Most of these bars have been in place since the inception of the federal trademark registration program in 1905,[4] and are routinely applied by the USPTO.

This broad list of bars to registration serves a number of policies that go well beyond protecting consumers from deception in the marketplace. A number of the bars deal with confusing or deceptive marks.[5] Some bars, and the prohibition on registering generic symbols, relate to another central concern of trademark law: competition.[6] Significantly, however, a number of the bars apply to marks that are neither

---

[4] The disparagement bar was enacted in 1946, as part of the Lanham Act's original text. Trademark Act of 1946, ch. 540, title I, § 2, 60 Stat. 427.

[5] Specifically, the bars for marks that are deceptive; falsely suggestive of a connection with persons, institutions or religions; likely to cause confusion with an existing mark; and primarily geographically deceptively misdescriptive directly implicate deception.

[6] The bars for marks that are descriptive, misdescriptive, merely a surname, and functional limit the monopolization of words and designs that competitors may desire to use in commerce.

confusing/deceptive nor anticompetitive on their face. These include the disparaging, scandalous, and immoral bars, but also include the bars on inaccurate but not necessarily misleading geographical indications of origin for wine or spirits, names of specific living persons absent written consent, and government insignia.[7] These bars relate to other policy concerns. What the Federal Circuit observed of disparagement is equally true of the competition-related and other non-deception-related bars:

> [t]hese latter restrictions cannot be justified on the basis that they further the Lanham Act's purpose in preventing consumers from being deceived. These exclusions from registration do not rest on any judgment that the mark is deceptive or likely to cause consumer confusion, nor do they protect the mark-holder's investment in his mark.

In re Tam, 808 F.3d at 1329. These bars, including the disparagement bar, do target categories of symbols that are less likely to serve the trademark function than other symbols because of the additional meanings

---

[7] Section 2(b), for instance, bars marks consisting of flags, coats of arms, or "other insignia of the United States, or of any State or municipality, or of any foreign nation." 15 U.S.C. § 1052(b). These bans are effectuated on a per se basis. This list of banned insignia represents institutions that Congress presumably thought should be spared *any* commercial appropriation, not just instances that would sully these symbols based on the particular use involved. *Renna v. County of Union*, 88 F. Supp. 3d 310, 320-21 (D.N.J. 2014) (discussing the free speech interests involved in making insignia unregistrable); Christine Haight Farley, *Stabilizing Morality in Trademark Law*, 63 Am. U. L. Rev. 1019, 1037-38 (2014).

they carry that can overwhelm or detract from potential source-signifying function. *See* Michael Grynberg, *A Trademark Defense of the Disparagement Bar*, 126 Yale L.J. Forum 178 (2016), http://www.yalelawjournal.org/forum/a-trademark-defense-of-the-disparagement-bar. Nonetheless, they are not centrally about deception. For example, the bar on registering symbols that merely truthfully describe the applicant's goods and services is obviously content-based, and it is also clearly not about deception. The descriptiveness bar, like the others, is connected to the broader policy goals of trademark law, but that is to say that registration, and the registration bars, serve government interests beyond deception.

To determine whether the mark itself, or matter contained within the mark, corresponds to any of the bars in § 2, the USPTO must evaluate the content of the mark, with the exception of the bar on utilitarian functionality.[8] Thus, just as the bar at issue in this case

---

[8] The functionality bar in § 2(e)(5) does not require the USPTO to decipher a meaning from the applied-for design. 15 U.S.C. § 1052(e)(5). Aesthetic functionality, however, requires a determination of the aesthetic value of a design. Thus, registration may hinge on a determination of what the design depicts, *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 919 (9th Cir. 1980) (finding that the applied-for design was the emblem of a young women's fraternal organization), or what the design conveys, *In re Florists' Transworld Delivery, Inc.*, No. 77590475, 2013 WL 2951796, at *9-10 (T.T.A.B. Mar. 28, 2013) (finding that the color black communicates particular messages such as luxury and elegance, or grief and condolence, and that the color of floral packaging can be just as important as the color of the flowers themselves in conveying such messages.).

requires the government to evaluate the meaning of Mr. Tam's mark in the context of his services, so too do these other bars. For instance, if an applicant applies for a registration of the word mark BRAMLEY, the USPTO must determine if that word would be understood by a substantial number of consumers as the name of a living person, a place, or a surname. *In re Quadrillion Publ'g Ltd.*, No. 75/217,892, 2000 WL 1195470, at *1-2 (T.T.A.B. Aug. 9, 2000). Likewise, in determining whether a word or words are confusing, deceptive, descriptive or misdescriptive, the USPTO must first parse the meaning of the word to its audience. Nor is this task limited to words. Consider § 2(b), which requires the USPTO to determine whether an applied for design is a "simulation" of an existing flag. *See In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993).

B. Section 2 Disparagement, Like Defamation Law, Is Content-Based But Viewpoint-Neutral.

The Federal Circuit treated disparagement as distinguishable from the other § 2 bars because it found disparagement to be not only content-based but also viewpoint-based. *In re Tam*, 808 F.3d at 1335. However, the line between content- and viewpoint-based regulation is not helpful without a theory of why the particular regulation at issue exists. *See, e.g.*, *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 831 (1995) (noting that the distinction between content and viewpoint discrimination "is not a precise one");

Geoffrey R. Stone et al., *Constitutional Law* 1765 (3d ed. 1996) ("That it is unconstitutional for the government to act for the purpose of promoting speech favoring the Democrats (as opposed to, say, the Republicans) does not necessarily entail that it is unconstitutional for it to act . . . for the purpose of promoting speech favoring democracy (as opposed to, say, totalitarianism).").

Given the meaning of "disparagement" as a concept that could apply to anyone, the ban on disparaging marks is more appropriately characterized as content-based rather than viewpoint-based. Section 2(a) prohibits registration of a mark that disparages anyone, abortionist or anti-choice zealot. *See Ridley v. Mass. Bay Transp. Auth.*, 390 F.3d 65, 82-87 (1st Cir. 2004) (considering ban on disparaging subway ads). The Federal Circuit en banc majority claimed that "[t]he legal significance of viewpoint discrimination is the same whether the government disapproves of the message or claims that some part of the populace will disapprove of the message." *In re Tam*, 808 F.3d at 1336. If the "part of the populace" at issue were static and unchanging no matter what mark was at issue, that might be true. However, because the "part of the populace" whose views are considered changes depending on the specifics of the applied-for mark, no particular group or set of viewpoints receives protection denied to everyone else. *See id.* at 1372 (Dyk, J., concurring and dissenting) (quoting *Davenport v. Wash. Educ. Ass'n*, 551 U.S. 177, 189 (2007)) ("[T]he standard is not based on the *government's* disagreement with anything.

Rather, it is based on an objective, 'neutral' assessment of a non-government perspective – in this case, a 'substantial composite of the referenced group.' . . . [T]here is no 'realistic possibility that official suppression of ideas is afoot.'"). Like defamation, which is content-based but not viewpoint-based, the disparagement bar protects everyone. In the world of trademark registration, no one is licensed to fight freestyle; we are all "to follow Marquis of Queensbury rules" in our registered trademarks. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 391 (1992); *see also* Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 Trademark Rep. 797, 876-77 (2016).

Furthermore, viewpoint discrimination in the past has been tied to the viewpoint of the person who is losing out because of her speech, such as a speaker denied school funding because *her* viewpoint was religious instead of nonreligious. *See Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 831 (1995). By contrast, the disparagement exclusion denies registrations equally to people trying to disparage a group and to people trying to reclaim terms on behalf of the disparaged group, as long as a substantial composite of the referenced group would see the term as disparaging. *See R.A.V. v. City of St. Paul*, 505 U.S. at 391 (a hypothetical statute that prohibited "odious racial epithets . . . to proponents of all views" would not discriminate on basis of viewpoint). Thus, the disparagement bar is also neutral as to the applicant's membership in and viewpoint on the particular disparaged group at issue. *See Boos v. Barry*, 485 U.S. 312, 315-19 (1988)

(plurality) (upholding law against display of any sign within 500 feet of a foreign embassy if the sign would tend to bring that foreign government into "public odium" or "disrepute"; restriction was not viewpoint-based because looking at policies of foreign governments was neutral method of identifying covered speech); *Ridley*, 390 F.3d at 90 ("[G]uidelines prohibiting demeaning or disparaging ads are themselves viewpoint neutral."); *id.* at 91 ("[T]he state is not attempting to give one group an advantage over another in the marketplace of ideas."). *Cf. Ark. Educ. Television Comm'n v. Forbes*, 523 U.S. 666, 683 (1998) (denying participation in political debate to candidate with minimal public support was not viewpoint-based, because participation would be denied to anyone who lacked sufficient support, no matter what views he held). So, for example, if an applicant applied for CELEBRASIANS for an advocacy group that sought to bar Asian immigration, the mark would not be disparaging even if the group's intention was disparaging.

The *In re Tam* majority's error was to find viewpoint discrimination because the bar relies on determining what a group of people understands the meaning of a term to be, in context. The error of conflating the speaker's viewpoint with the audience's understanding, if left undisturbed, would indicate that the deceptiveness and descriptiveness bars are also viewpoint-based. *See* Ned Snow, *Free Speech and Disparaging Trademarks*, 57 B.C. L. Rev. 100, 145 (2016). Terms that convey materially false meanings about a good or service are unregistrable (regardless of the

presence of an intent to deceive), *In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988), but misdescriptive terms that have secondary meaning are registrable so long as consumers do not find the misdescription to be material to their purchasing decision. 15 U.S.C. § 1052(f), while terms that accurately describe the goods or services with which they are used can only be registered with secondary meaning. *Id.* All of these rules require subjective, observer-based inquiries dependent on what the audience believes and considers important, just as the perception of the target group makes the difference for disparagement.

The regulatory nature of trademark registration is vital here because each individual decision is based on the specifics of what the applicant is applying for. Each individual decision may involve a viewpoint, but the law itself does not judge based on viewpoint. Nor, again, does it matter what the applicant's identity or viewpoint is, as long as the targeted group would find the mark disparaging. Trademark law simply does not care about the applicant's views. *See In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 1077 (T.T.A.B. 2008) (holding that the determination of the meaning of the mark centers on the referenced group's perception of the term rather than the applicant's intentions.)

C. Precedents Involving Bans On Speech, Even Commercial Speech Precedents, Do Not Make Sense For Trademark Law.

The Federal Circuit's mistake was to treat a regulatory, rights-granting program as if it were a punishment for speech, rather than a government program awarding rights to control commercial speech to one private party: rights that allow the registrant to suppress the speech of others. The different justifications, functioning, and risks of registration compared to laws punishing speech make application of precedents involving punishment for speech to the Lanham Act both incoherent and unwise.

Reed, on which the Federal Circuit relied, evaluated a prohibition on speech. *Cent. Hudson Gas & Elec. v. Pub. Servs. Comm'n of N.Y.*, 447 U.S. 557 (1980), another case invoked by the Federal Circuit, likewise establishes a four-part test to determine if bans on commercial speech survive First Amendment scrutiny. The first step in the inquiry asks whether the speech at issue is false or misleading; if so, it may simply be banned. Several consequences follow for evaluating trademark law: first, *Central Hudson*, like *Reed*, is not appropriate for evaluating a discretionary government act. Second and relatedly, as detailed in Part II.A., trademarks as such are neither truthful nor deceptive without legal recognition of trademark rights, making traditional *Central Hudson* analysis difficult at best.

Moreover, trademark law has not limited itself to speech meeting the definition of "commercial speech"

used in First Amendment cases. Courts have found infringement in books, *Penguin Books USA, Inc. v. Dr. Seuss Enters.*, 521 U.S. 1146 (1997), parody magazines, *Balducci Publ'ns v. Anheuser-Busch, Inc.*, 513 U.S. 1112 (1995), art, *Romm Art Creations Ltd. v. Simcha Int'l, Inc.*, 786 F. Supp. 1126 (E.D.N.Y. 1992), and songs, *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir. 2003)[9] – and even when they have not found infringement in such cases, they have generally not relied on the fact that the challenged speech is noncommercial to take it outside the scope of the Lanham Act, instead developing special tests to deal with possible trademark infringement in noncommercial speech. *See, e.g., Rogers v. Grimaldi*, 875 F.2d 994, 999-1000 (2d Cir. 1989). Thus, when a trademark registration is issued by the government, the registrant is better able to suppress the speech of others – a situation that itself triggers First Amendment concerns about the scope of the resulting right.[10] *See N.Y. Times Co. v. Sullivan*, 376 U.S. 254 (1964). Even if the suppression is only of commercial speech, that too is of constitutional moment under

---

[9] Many members of *Amici* consider these cases to have the wrong outcomes, but *Amici* here emphasize that the Lanham Act is a broad and multifaceted statute, and a First Amendment ruling on registration should recognize that scope.

[10] *See, e.g., San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987) (enjoining the San Francisco Arts & Athletics, Inc. from using the word "Olympic" in the promotion of the "Gay Olympic Games"); *MGM-Pathe Commc'ns v. Pink Panther Patrol*, 774 F. Supp. 869 (S.D.N.Y. 1991) (enjoining the use of "Pink Panther Patrol" to a group of gay rights activists for their anti-violence campaign).

Central Hudson. (In other words, if the speech suppressed by trademark enforcement is unimportant because it is commercial, then so too is the registrant's speech.)

Thus, unlike the classic speech ban against which most First Amendment doctrine is directed, no matter what decision the government makes in applying the bars of § 2, it will inhibit someone's speech – either the mark owner's, or everyone else's. Registration even goes beyond whatever rights might have existed at common law, providing, for example, nationwide rights in advance of any local use, and protection against invalidation for lack of secondary meaning after five years. 15 U.S.C. § 1057(c); 15 U.S.C. § 1065. In the issuance and refusal of trademark registrations there is no such thing as neutrality. The government has decided to shape the market for speech by regulating trademarks.

II. DENIAL OF REGISTRATION IS NOT A PUNISHMENT FOR SPEECH.

Trademark rights are not created through registration; they are acquired through the use of a distinctive mark in commerce.[11] Rather than being a penalty

---

[11] *Amici* do not believe that the constitutionality of the disparagement bar ought to turn on whether § 43(a) protection is available for an unregistrable mark. At a minimum, the Court should recognize that registration may be unavailable on many absolute grounds, such as lack of use by the applicant as a trademark; lack of use by the applicant in U.S. commerce; functionality; deceptiveness; and genericity, as well as on the relative ground of

imposed on an actor doing business independently of the government, denial of registration requires interaction with the government. Absent government action, there can be no registration. Given that baseline, unconstitutional conditions analysis is the most appropriate doctrine to assess registration.

A. Registration Is Discretionary, And Directed Only At The Trademark Function, Not At Other Meaning.

Although registration is not a traditional monetary subsidy as in many unconstitutional conditions cases, the subsidy label is simply a way to identify government acts that do not impose penalties and thus may be appropriate even if content-based. Unconstitutional conditions doctrine recognizes that the government has more freedom to pick and choose beneficiaries where a private entity has no preexisting right to the benefit.[12] Government may not deny benefits based on an entity's speech outside the boundaries

---

likely confusion with an existing mark already in use in the U.S. Whether, or when, one entity should be able to use § 43(a) to prevent another from using an unregistrable symbol involves both questions of statutory interpretation and of the policies underlying bars on registration, and the Court should not give a casual answer to that complex question in a case in which the question is only subsidiary. *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 708-09 (2016) pet'n for cert. filed No. 16-548 (Oct. 20, 2016); *Renna v. County of Union*, 88 F. Supp. 3d 310, at 320.

[12] Government speech is strongly related to unconstitutional conditions – the relevant considerations are similar, but unconstitutional conditions may better encompass the different ways in which government may carry out its aims.

of a government-funded program, and it may not discriminate based on viewpoint, but it may pursue goals that require it to evaluate content.

Under an unconstitutional conditions analysis, the government's legitimate options are defined by the nature of the program. In trademark registration, the program is to include on the register those marks that identify source – a specific function of symbols – so long as they do not run afoul of a statutory bar. *Bongrain Int'l (American) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1485 (Fed. Cir. 1987). In 1979, this Court recognized that trademarks have "no intrinsic meaning." *Friedman v. Rogers*, 440 U.S. 1, 12 (1979). Unlike copyright law, trademark law does not protect symbols as such. Instead, trademark protects only symbols' source designating function, which can only be assessed contextually in relation to particular goods or services to which they are applied. "Apple" does not intrinsically designate a computer company; neither does "Microsoft"; "Google" once was the name of a search engine company but now is only the name of its most popular service.

Because trademarks do not have intrinsic source-indicating content, the Lanham Act regulates the symbol only in its role as a source identifier and the other functions of symbols are not implicated by trademark law. The primary drafter of the Lanham Act, Edward Rogers, put it this way:

> [T]he trade mark in and by itself is of little importance[;] it is but the visible manifestation of a much more important thing, a business good will[;] the good will is the substance, the trade mark merely the shadow, and . . . this business good will is the property to be protected against invasion.

Edward S. Rogers, *Comments on the Modern Law of Unfair Trade*, 3 Ill. L. Rev. 551, 555 (1909) (footnote omitted); *see also* Beverly W. Pattishall, *Trade-Marks and the Monopoly Phobia*, 50 Mich. L. Rev. 967, 971 (1952) ("[B]asically it is the intangible thing, the individual identity, which must be protected – as may be necessary – not any individual word or mark, as such, which is relied upon to achieve that identity.").

In First Amendment terms, the truth value of source indication, which is the only meaning that trademark law regulates, cannot be determined in the abstract. Felix S. Cohen, *Transcendental Nonsense and the Functional Approach*, 35 Colum. L. Rev. 809, 815 (1935) (explaining that trademark value stems from the willingness of the government to suppress unauthorized uses on the trademark claimant's behalf). Unlike ordinary communication, where changing the words can change the meaning, *Cohen v. California*, 403 U.S. 15, 25-26 (1971), a change of mark does not change the link between the mark and the trademark function, which is the only thing trademark law regulates. Google *is* Alphabet. And it is Alphabet, the legal entity, even though it continues to be called Google in everyday parlance.

The government has no interest in assigning the ownership of the non-trademark meaning of a symbol. Whether a term is arbitrary (apple for computers), suggestive (ivory for soap), or fanciful (hobbit for invented characters), trademark law deliberately leaves the non-source identification functions of symbols to the vagaries of public discourse. The non-source identification functions of symbols, of course, affect whether a term is deceptive, disparaging, descriptive, arbitrary, etc. for particular goods or services (e.g., apple for lipstick versus apple for computers). Thus, the non-trademark meaning of a term necessarily becomes part of the trademark analysis. Nonetheless, trademark law only provides rights in the source-identification aspect of a symbol. An applicant's interest, correspondingly, is solely in obtaining those rights, and not in claiming rights in any non-source-related meaning of a symbol.

Because the trademark function can be separated from the other communicative functions of a symbol, the registration system can operate without having harmful effects on those other functions.[13] The content of expression is important to figuring out if a symbol is capable of being a trademark, but denying trademark rights regulates only the commercial aspects of the speaker's message. Denial of registration relates to the

---

[13] This Court has made a related distinction in cases in which commercial speech is not "inextricably intertwined" with noncommercial speech, allowing the commercial elements to be regulated under *Central Hudson*. *See Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 474 (1989).

source meaning of a symbol, but does nothing to regulate use of the symbol in any other way, even if – indeed, especially if – the bar applies to symbols with particular non-source-related meaning. If the trademark owner wants to communicate other things about itself (including "we wish to reclaim a slur"), it can use other symbols in conjunction with its mark.

B. The Disparagement Bar Does Not Impose An Unconstitutional Condition.

Denying rights to register based on a symbol's non-trademark meaning is necessarily at the core of many registration refusals, but not because of any discrimination against viewpoints or "penalty" for speech. Denial of registration occurs because Congress has determined that certain non-trademark meanings make symbols inappropriate for registration as a trademark, whether that's because of deception, interference with competition, or interference with the interests of others engaged in commerce (an interest common to the bans on registration of personal names without consent and on disparagement). As long as everyone is allowed to use a term in non-trademark ways, trademark law is not regulating or suppressing either the registrant or nonregistrants' uses in anything other than the trademark sense.

1. The Government Is Not Leveraging Refusal Of Registration For Speech Outside The Registration Program; Applicants Remain Free To Use Any Symbols They Wish.

Unconstitutional conditions doctrine regularly struggles to determine what counts as coercion, or as the appropriate baseline from which to measure an entitlement. *See* Kathleen M. Sullivan, *Unconstitutional Conditions*, 102 Harv. L. Rev. 1413, 1420 (1989) ("[D]eciding under what circumstances government offers, like private offers, are coercive is an inevitably normative inquiry."). The Federal Circuit chose the wrong baseline when it declared § 2(a) to impose an unconstitutional condition, *In re Tam*, 808 F.3d at 1339-41, because trademark registration is in its entirety about regulating speech: who gets to register which communicative symbols. The baseline against which to measure § 2(a) therefore cannot be whether the government interferes with a speaker's communication.

Under § 2(a), any speaker can continue to use any symbol it wants for communicating anything it wants, but it can only get a registration for matter that does not run afoul of a statutory exclusion. This distinction – which allows the government to regulate the mark's registration, but not to exercise any leverage over the speaker's other speech – is consistent with the leading unconstitutional conditions cases. In *Rust v. Sullivan*, 500 U.S. 173 (1991), the Court explained that unconstitutional conditions generally involve "situations in

which the Government has placed a condition on the *recipient* of the subsidy rather than on a particular program or service, thus effectively prohibiting the recipient from engaging in the protected conduct outside the scope of the federally funded program." *Id.* at 197. This Court more recently repeated its distinction between conditions that specify what activities Congress wants to subsidize (legitimate) and those that seek to leverage the subsidy to affect speech outside the government program (illegitimate). *Agency for Int'l Dev. v. All. for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013); *see also* Ramsey, *supra*, at 858-59.

The *Tam* en banc majority noted that, in many cases, an applicant whose application is denied will choose a new trademark. *In re Tam*, 808 F.3d at 1341. This consequence should not affect the constitutional analysis for two reasons: First, choosing a new mark does not mean that the applicant will cease using the registration-barred symbol *as a symbol* if it has an expressive reason for continuing to do so. While the *In re Tam* majority claimed that trademark owners could not "realistically have two brand names, one inoffensive, non-disparaging one (which would be able to secure registration) and a second, expressive, disparaging one (which would be unregistrable and unprotectable)," 808 F.3d at 1351, that dual system of official and unofficial names is in fact common in the real world. We speak of the famous judge Learned Hand, but his friends knew him as Bunny; Stefani Germanotta has not changed her legal name, but is generally

known by her stage name, Lady Gaga. Ronald Reagan National Airport is still known to locals as National. Many national sports teams are easily recognizable by their unofficial nicknames. *See, e.g.*, https://en.wikipedia.org/wiki/List_of_baseball_team_nicknames. Many brands also make unprotectable generic terms large parts of their branding because they desire the communicative benefits of those terms even absent registrability: Subway's FOOTLONG is a highly visible example. *Sheetz v. Doctor's Ass., Inc.*, 108 U.S.P.Q.2d 1341 (T.T.A.B. 2013). Slogans can be protected separately from names. Relatedly, trade dress and logos can provide valid, protectable marks if a name is unregistrable. For instance, in the case of the Washington football team, were it to ultimately have its REDSKINS registrations cancelled, it could continue to protect its goods and services through its other many registrations such as its stylized R mark and its logo marks.[14] Thus, the sandwich shop and the football team both illustrate how a markholder can use other, registrable marks to receive the full range of government benefits.

Second, chilling effects or disincentives are a common effect of a failure to subsidize or supply a benefit, but are not constitutionally problematic so long as they are not designed to limit speech outside the subsidized program. *See, e.g.*, *Rust v. Sullivan*, 500 U.S. 173, 197 (1991) (upholding government's choice to subsidize

---

[14] R Registration. No. 3,090,334 (stylized R logo for merchandise); Registration No. 2,902,746 (Indian head logo trademark for merchandise); Registration No. 1,861,766 (Indian head logo on a football helmet for merchandise).

childbirth, but not abortion); *Regan v. Taxation with Representation of Wash.*, 461 U.S. 540, 553 (1983) (Blackmun, J., concurring) (emphasizing charitable organizations' ability to lobby through affiliate organizations as a reason for upholding a tax exemption conditioned on avoidance of lobbying); *Machete Productions, L.L.C. v. Page*, 809 F.3d 281, 289-90 (5th Cir. 2015) (denial of film subsidy allegedly based on viewpoint did not impose unconstitutional condition where filmmaker was not prevented from making the film exactly as planned, only without a subsidy); Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 Trademark Rep. 661, 695 (1993).

Denying Mr. Tam rights in *any* mark as long as his band kept the name THE SLANTS would be an unconstitutional penalty for the exercise of his First Amendment rights. Denying him the right to register any mark he wants is not. To analogize to *Walker v. Texas Division, Sons of Confederate Veterans*, 135 S. Ct. 2239 (2015), the speaker is free to put a Confederate flag bumper sticker on his bumper. He just cannot have it on the license plate. *See also Agency for Int'l Dev.*, 133 S. Ct. at 2329-30 (discussing ease of working around restriction as a reason to accept content-based nature of government program); *Regan*, 461 U.S. at 548-49 (upholding the subsidy of certain organizations for lobbying and noting the relatively simple work-around for unsubsidized organizations to get similar treatment). Under § 2(a), likewise, the band members can keep the name, use it as they like, and receive the benefits of

registration by relying on a non-disparaging logo or other symbol. They just cannot get the government's help by invoking only this particular disparaging symbol. *In re Tam*, 808 F.3d at 1381 (Reyna, J., dissenting). The government is not gaining any leverage over the message appearing outside the registered matter, any more than it has leverage over the message appearing on a bumper sticker because it has the power to approve or disapprove license plates. The government's unwillingness to take part in the disparaging or racist aspects of the message communicated by the mark can therefore itself be a sufficient interest to justify the bar. *Cf. In re Tam*, at 1379 (Reyna, J., dissenting) (noting the Lanham Act's goal, under the Commerce Clause, of assisting the free flow of commerce open to all).

The broader point is that, ultimately, the government *must* weigh in on the validity of a speaker's choice of marks if the mark is to be enforced against others. That is, because the entire system of trademark registration is a system of speech regulation, it is very different from the unconstitutional conditions cases finding that the government overstepped its bounds. Because the government is heavily involved in defining and enforcing trademark rights, its hands-off position to avoid the possibility that the government would be seen as validating disparagement should be held to be constitutional.

2. Unconstitutional Conditions Analysis Is Appropriate Because *Central Hudson* Scrutiny Cannot Properly Assess A Comprehensive Government Program That Requires Evaluation Of Speech To Function.

Assuming arguendo that trademark law only regulates commercial speech, the alternative to unconstitutional conditions is *Central Hudson* analysis (or strict scrutiny). But such scrutiny could not be limited to the disparagement bar. Many of the other bars, as well as other provisions of the Lanham Act, have features that are at least dubious under *Central Hudson* scrutiny, which assumes that the government is directly suppressing speech and therefore puts a relatively heavy burden on the government to justify its prohibitions. False or misleading commercial speech can simply be banned. Thus marks that create a false association under § 2(a), and marks that are deceptive or misdescriptive under § 2(a) or § 2(e)(3) are likely not protected speech (assuming that they are commercial speech). However, substantial issues of tailoring and evidence would remain. Because barring registration of deceptive marks is possible, then all the subject matter-specific, deception-adjacent bans would seem to fail the less restrictive means test. The less restrictive means already present in the statute is to make an individualized determination of deceptiveness rather than to deter all uses of marks within a class, even if that class runs a higher than average risk of being deceptive.

Likewise, the USPTO's use of inference and common sense, without considering the actual marketplace context of a mark's use that might eliminate deception in practice, may make deceptiveness refusals overinclusive. Moreover, as it stands, the USPTO can refuse registration even when the applicant shows that matter outside the applied-for mark makes actual deception unlikely, *e.g.*, *In re Volk Art, Inc.*, No. 74/693,416, 1998 WL 377661, at *4 (T.T.A.B. July 8, 1998), or when a term has a non-deceptive meaning that can be clarified by the rest of a product's packaging, *e.g.*, *In re Wadhwa*, No. 86023037, 2016 WL 1045678, at *2-6 (T.T.A.B. Feb. 16, 2016). If, as courts are beginning to suggest, prophylactic anti-confusion rules are not narrowly tailored enough to survive strict scrutiny, then trademark law's unwillingness to consider disclaimers outside the applied-for matter seems constitutionally suspect. *See Pursuing America's Greatness v. Fed. Election Comm'n*, 831 F.3d 500, 507-11 (D.C. Cir. 2016).

Separately, refusing registration does not stop the *use* of a symbol to deceive consumers, meaning that the harm inflicted on the applicant from denying the registration does not necessarily further the government's interest. Indeed, if the government's refusal is correct, then by hypothesis the applicant's use of a deceptive term is material to consumers, thus helping to sell the product. Even absent a registration, the applicant would therefore have every incentive to continue using the deceptive term. While an outright ban on the use of a deceptive term under false advertising law would

be appropriately tailored to the government's interest, refusing registration would not be.

The bar on registering marks confusingly similar to marks already registered or in use also seems, at first look, highly connected to deception. *See In re Tam*, 808 F.3d at 1329 (stating that such bars were constitutionally unproblematic). However, the standard under which the USPTO refuses registration does not take real likelihood of confusion into account, because it deliberately abstracts away from marketplace context, refusing to consider additional distinguishing features that in practice always appear next to a supposedly confusing mark. For example, if Tam's mark THE SLANTS is ultimately registered, an application to register THE SLANTS would be refused for a second band even if in reality the second band always accompanied the term with a clear distinguishing feature, such as "the really racist ones." Confusion for registration purposes will often be measured differently than confusion in the actual marketplace. *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1308 (2015). The registration inquiry abstracts away from marketplace context in order to make the registration system work by providing a searchable, understandable list of the terms that are off-limits to other businesses. Having two separate registrations of THE SLANTS for identical services would be inconsistent with that systemic objective. However, administrative convenience is generally not a sufficient justification for limiting First Amendment rights – when the limit involves a ban on speech rather than a government-conferred benefit.

Other sensible registration bars, even the bar on registering merely descriptive marks, would also be extremely vulnerable under *Central Hudson* or strict scrutiny taken seriously. *See* Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 91 Notre Dame L. Rev. (forthcoming 2016) (manuscript at 22-23) (available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2745016); *see also* Snow, *supra*, at 125-30 (discussing other trademark issues, such as priority and infringement, that would also face invalidity). For instance, under § 2(c), a flag is not registrable when it forms part of a mark even where there is no suggestion of affiliation with the government that flag represents. Such exclusions from registration do not rest on any judgment that the mark is deceptive or likely to cause consumer confusion, nor do they protect the markholder's investment in his mark.

The widespread chaos that the decision below would cause in registration, and trademark law more generally, if applied according to its own terms, demonstrates that it is inappropriate to use a test about suppressing speech to evaluate whether the government can refuse to give a registration, or even a private right of action, to a commercial speaker.

3. Analogies To Copyright Are Flawed.

In striking down the § 2(a) disparagement bar, the Federal Circuit analogized to copyright law. *In re Tam*, 808 F.3d at 1346-48. Unlike trademark law, however,

copyright protects the expression in a work. Therefore, in copyright, to mandate that a work of authorship be non-disparaging or non-obscene to get protection would be to target the content of the work itself as a condition of the benefits of protection.[15] *See* Ramsey, *supra*, at 879-81 (elaborating relevant distinctions between the regimes). Trademark law is different because it protects only the source identification function of a symbol and not the symbol itself. Thus, any business can continue to use the symbol for which the government refuses registration, even for the very products and services for which it sought registration, and still have its trade interests protected, if it also chooses some other symbol to make the link between itself and its goods and services.[16] Mr. Tam's speech is unaffected, and the government's interest in avoiding

---

[15] Because copyright protects only expression, and not ideas, barring protection for disparaging works might well impose an unconstitutional condition insofar as it reached outside the government-provided benefit for expression to penalize the speaker's ideas. In addition, just as with trademark, denying copyright protection on the basis of the *speaker's* viewpoint would be unconstitutional.

[16] The trademark function also distinguishes registration from New York's unconstitutional "Son of Sam" law, which allowed the state to escrow money received from a criminal's expression about his crimes. *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 108 (1991). Even assuming there is a constitutional right to profit from one's expression, Tam's band can perform under the name Slants without financial sanction, and with trademark protection for other symbols, and the government will not escrow the resulting income nor tax the sales any differently than it does for other sales.

any appearance of endorsement of discrimination in commerce is also satisfied.

Moreover, the Federal Circuit failed to appreciate that the government could indeed withdraw or refuse to grant copyright protection to categories of works (as it has done) without violating the First Amendment. Architectural works, for example, were excluded from copyright protection for two centuries with no First Amendment problems; sound recordings were excluded for decades; perfume, yoga, gardens, and other forms of creative works are still excluded. These examples demonstrate that current copyrightability rules are indeed content-based. *See, e.g.*, *Kelley v. Chi. Park Dist.*, 635 F.3d 290 (7th Cir. 2011); *see also Compendium of U.S. Copyright Office Practices (Third)* (2014) §§ 313.6(c), 806.5(B)(3) (including, among other things, functional physical movements (like yoga), social dances, bridges, interior design, and landscape design as noncopyrightable subject matter) http://www.copyright.gov/comp3/docs/compendium.pdf; Christopher Buccafusco, *Making Sense of Intellectual Property Law*, 97 Cornell L. Rev. 501, 540-41 (2012). The relevant question is whether the exclusions are sufficiently related to a legitimate purpose for the government's program, and this legitimate purpose may come from the categories of creative activity the government wishes to encourage.

III. VAGUENESS IS NOT AN INDEPENDENT REASON TO INVALIDATE THE DISPARAGEMENT BAR.

As with many other trademark determinations, the application of § 2 results in inevitable errors and inconsistencies. For example, WHITE PRIDE COUNTRY WIDE[17] was refused registration as disparaging while ASIAN PRIDE and BLACK PRIDE[18] were registered. There are, however, several reasons not to conclude that these inconsistencies indicate a vague standard. First, inconsistencies naturally result from contextualization. The examiner assembles evidence of what a particular term means in the context of the applied-for goods or services, and the evidence of the meaning of a term to a substantial composite of the referenced group may differ even for related terms. Context changes our understanding of words; inoffensive words become offensive and vice versa based on context. Farley, *Stabilizing Morality in Trademark Law*, 63 Am. U. L. Rev. at 1039 ("[C]ontextualization leads to inconsistent results by design; it is inherent in the exercise.").

Second, the USPTO treats every application on its own merits – for all issues, not just when they raise § 2(a) disparagement concerns. *See, e.g.*, *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341-42 (Fed. Cir. 2001); *In re Couriaire Express Int'l, Inc.*, 222 U.S.P.Q. 365, 366

---

[17] WHITE PRIDE COUNTRY WIDE, Serial No. 78368298.

[18] ASIAN PRIDE, Registration No. 2,089,064; BLACK PRIDE, Registration No. 1,573,602.

(T.T.A.B. 1984) ("That each case must be determined on its own facts is a proposition so well established that no authority need be cited in support of it."). Third, since the applicant is responsible for presenting evidence, similar terms may be evaluated with different evidentiary records leading to different results. *See, e.g.*, *McDermott v. S.F. Women's Motorcycle Contingent*, 240 Fed. App'x 865, 866 (Fed. Cir. 2007) (recounting the initial refusal and subsequent successful registration after applicant submitted evidence that lesbians would not perceive the mark as disparaging).

Finally, touted examples of apparent inconsistency are selected from the millions of applications submitted to the USPTO. The registration system requires hundreds of examiners and attracts hundreds of thousands of applications per year. U.S. Patent & Trademark Office, Performance and Accountability Report Fiscal Year 2015, https://www.uspto.gov/sites/default/files/documents/USPTOFY15PAR.pdf at 198 tbl. 16 (showing over 300,000 applications filed and approved for publication in Fiscal Year 2015). This scope should influence the standards by which the system is judged. As long as the USPTO applies the correct legal standard, apparent differences in the outcome of similar applications do not represent a fatal constitutional flaw. Asking the hundreds of examiners (at any given time) for more than rough consistency in results would be like asking America's public school teachers to make their content-based assessments of English papers with enough precision that they would all give the same grades to the same papers.

The inevitable inconsistency between some selected cases in a merits-based system is, indeed, one reason why the Court has granted government flexibility in making content-based decisions in analogous situations. Many government grant programs could not survive if required to be strictly consistent in every case, and the benefits of having trademark registration (or public school teachers) are great enough to justify the inevitable inconsistencies. This is what it means to have a regulatory state. If the government is going to maintain a trademark system granting the benefits of registration after substantive examination, it needs flexibility and tolerance that is inconsistent with traditional strict scrutiny or even heightened *Central Hudson*-style scrutiny.[19]

The risks of First Amendment scrutiny should be particularly apparent with respect to the argument that disparagement is unconstitutionally vague. If vagueness is a constitutional flaw in disparagement, then the list of potential vagueness challenges will be long. Indeed, similar inconsistency plagues most of the other bars; distinctions between inherently distinctive,

---

[19] *Cf. National Endowment for the Arts v. Finley*, 524 U.S. 569, 585 (1998) ("Any content-based considerations that may be taken into account in the grant-making process are a consequence of the nature of arts funding. The NEA has limited resources, and it must deny the majority of the grant applications that it receives, including many that propose 'artistically excellent' projects."). The PTO's resources are not limited in the same way as those of the National Endowment for the Arts, but the "nature" of its endeavor equally requires multiple content-based determinations assessing the meaning of a specific mark in its specific context.

immediately registrable marks, descriptive marks that can only be registered upon a showing of secondary meaning, and generic terms that can never be protected as marks; the "use as a mark" precedents requiring trademark use instead of ornamental use for registration; and the infringement standards themselves.

There is, for example, a circuit split on the question of whether CHICKEN OF THE SEA is inherently distinctive or descriptive when used for tuna. *Compare Van Camp Sea Food Co. v. Packman Bros.*, 79 F.2d 511, 511-12 (3d Cir. 1935) (per curiam) (descriptive), *with Van Camp Sea Food Co. v. Alexander B. Stewart Orgs.*, 50 F.2d 976, 979 (C.C.P.A. 1931) (suggestive). Many cases note the difficulty of marking the line between suggestive, descriptive, and generic terms. *See, e.g.*, *Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 213 (2d Cir. 1985) ("It cannot be gainsaid that the judiciary is ill-equipped to distinguish between the descriptively suggestive and the suggestively descriptive mark. In addition, societal vicissitudes demand that the categories retain fluidity to accommodate a particular mark's evolving usage over time. . . . [I]t is necessary to surmise the mental processes of those in the marketplace at whom the mark is directed." (footnote omitted)); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979) ("The line separating [suggestive and descriptive marks] is uncertain; extrapolating the line from precedent would be impossible. . . . [T]he distinction between descriptive and suggestive marks may be inarticulable. . . ."); *Thompson Med. Co.*, 753 F.2d at

213 n.8 ("[B]ecause generic marks cannot be protected even upon a showing of secondary meaning, courts increasingly have been called upon to delineate the chimerical line between the descriptive and the generic."). Examples could be multiplied indefinitely. *See* Snow, *supra*, at 156-58 (noting that other bars are also vague and uncertain); Tushnet, *supra*, at 33-35; *cf.* 2 Thomas J. McCarthy, *McCarthy on Trademarks and Unfair Competition* §§ 11:24, 11:72 (4th ed. 2016) (listing examples of marks found suggestive and merely descriptive).

While most of the hundreds of thousands of trademark registration determinations made every year are never challenged outside of the USPTO, they do involve content-based evaluations of specific symbols. Given the size of the system and its need to balance rights among different applicants, competitors, and the general public, general principles of administrative law, not the rules of strict scrutiny, are more appropriate for assessing the performance of the system.

CONCLUSION

The decision below – that all content-based trademark rules must survive strict scrutiny – would wreak havoc on trademark law. The Federal Circuit's treatment of the Lanham Act's regulatory scheme as presumptively unconstitutional is misguided because it wrongly treats trademark registration refusal as a ban on speech. Trademark law is pervasively content-based, but that is not a fatal flaw for a government

program. Because § 2 disparagement is a concept that could apply to anyone, the ban on disparaging marks is more appropriately characterized as content-based rather than viewpoint-based. Under the appropriate analytic framework, the bars of § 2 reflect acceptable judgments about which symbols should receive legal protection as source identifiers, not penalties imposed on an actor doing business independently of the government. The Court should reverse the decision below.

Respectfully submitted,

CHRISTINE HAIGHT FARLEY
Counsel of Record
AMERICAN UNIVERSITY WASHINGTON
COLLEGE OF LAW
4300 Nebraska Avenue, NW
Washington, DC 20016
(202) 274-4171

REBECCA TUSHNET
GEORGETOWN UNIVERSITY LAW CENTER
600 New Jersey Avenue, NW
Washington, DC 20001
(202) 661-9402

Counsel for Amici Curiae

November 16, 2016

APPENDIX

Jasmine Abdel-khalik, University of Missouri-Kansas City School of Law

Margo Bagley, Emory University School of Law

Mark Bartholomew, University at Buffalo School of Law

Ann Bartow, University of New Hampshire School of Law

Irene Calboli, Texas A&M University School of Law

Michael Carroll, American University Washington College of Law

Amanda Compton, Charleston School of Law

Christine Haight Farley, American University Washington College of Law

Sean M. Fiil Flynn, American University Washington College of Law

Leah Chan Grinvald, Suffolk University Law School

Michael Grynberg, DePaul University College of Law

Paul Heald, University of Illinois College of Law

Robert A. Heverly, Albany Law School

Peter Jaszi, American University Washington College of Law

Peter J. Karol, New England School of Law

Sonia Katyal, Berkeley Law

Jessica M. Kiser, Gonzaga University School of Law

Raymond Ku, Case Western Reserve University

Stacey M. Lantagne, University of Mississippi School of Law

Yvette Joy Liebesman, Saint Louis University School of Law

Lee Ann Lockridge, Louisiana State University Paul M. Herbert Law Center

Mark McKenna, Notre Dame School of Law

Lateef Mtima, Howard University School of Law

Xuan-Thao Nguyen, Indiana University McKinney School of Law

Victoria Phillips, American University Washington College of Law

Ken Port, Mitchell Hamline School of Law

Joshua Sarnoff, DePaul University College of Law

Roger E. Schechter, George Washington University Law School

Rebecca Tushnet, Georgetown University Law Center

Liza Vertinsky, Emory University School of Law

Julie Cromer Young, Thomas Jefferson School of Law

RECORD
AND
BRIEF

Supreme Court, U.S.
FILED
DEC 15 2016
OFFICE OF THE CLERK

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,
Petitioner,

v.

SIMON SHIAO TAM,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF PROFESSORS EDWARD LEE AND JAKE LINFORD AS *AMICI CURIAE* IN SUPPORT OF RESPONDENT

EDWARD LEE
Counsel of Record
CHICAGO-KENT COLLEGE OF LAW
565 W. Adams Street
Chicago, IL 60657
(312) 906-5212
elee@kentlaw.iit.edu

Counsel for Amici Curiae

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES iii

INTEREST OF THE *AMICI CURIAE* 1

SUMMARY OF ARGUMENT 2

SECTION 2(a) OF THE LANHAM ACT VIOLATES THE FIRST AMENDMENT 2

A. Government Denials of Registrations if the Government Finds the Trademark "May Disparage Persons" Constitutes Viewpoint Discrimination 2

1. The System of Federal Registration on the Principal Register Is a Limited Public Forum 3

2. Section 2(a)'s Viewpoint Discrimination 11

3. The Reasonable Restrictions of Trademark Ownership in the Lanham Act 22

B. Federal Registration Is Not a Government Subsidy, Government Funding, or Government Speech 25

CONCLUSION 28

Appendix A. Top 50 Artists by Certified Sales with Registered Trademarks* 29

TABLE OF AUTHORITIES

Page(s)

Cases

Arkansas Educ. Television Comm'n v. Forbes, 523 U.S. 666 (1998) 12

Cohen v. California, 403 U.S. 15 (1971) 2

Cornelius v. NAACP Legal Defense and Educ. Fund, 473 U.S. 788 (1985) 6, 8, 13, 14

Davenport v. Washington Educ. Ass'n, 551 U.S. 177 (2007) 26

Eldred v. Ashcroft, 537 U.S. 186 (2002) 25

Good News Club v. Milford Central School, 533 U.S. 96 (2001) ..... *passim*

Lamb's Chapel v. Center Moriches Union Free School Dist., 508 U.S. 384 (1993) 13

Members of City Council v. Taxpayers for Vincent, 466 U.S. 789 (1984) 13, 14

NEA v. Finley, 524 U.S. 569 (1998) 26

Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189 (1985) 23

Perry Educ. Ass'n v. Perry Local Educators' Ass'n, 460 U.S. 37 (1983) 11, 12

Pleasant Grove City v. Summum, 555 U.S. 460 (2009) 11

TABLE OF AUTHORITIES—cont'd

Page(s)

Qualitex Co. v. Jacobson Products Co., 514 U.S. 159 (1995)) 6

R.A.V. v. City of St. Paul, 505 U.S. 377 (1992).....22

Regan v. Taxation With Representation of Wash., 461 U.S. 540 (1983) 25

Rosenberger v. Rector & Visitors of Univ. of Virginia, 515 U.S. 819 (1995).....*passim*

Rust v. Sullivan, 500 U.S. 173 (1991).....26

Sorrell v. IMS Health Inc., 564 U.S. 552, 565 (2011).....22

Texas v. Johnson, 491 U.S. 397 (1989).....28

United States v. American Library Ass'n, 539 U.S. 194 (2003).....26

Walker v. Texas Div., Sons of Confederate Veterans, Inc., 135 S. Ct. 2239 (2015) 9, 23, 26, 27

Ysursa v. Pocatello Educ. Ass'n, 555 U.S. 353 (2009).....26

Giebel v. Sylvester, 244 F.3d 1182 (9th Cir. 2001).....4

In re Old Glory Condom Corp., 26 U.S.P.Q.2d 1216 (T.T.A.B. Mar. 3, 1993).....27

TABLE OF AUTHORITIES—cont'd

Page(s)

In re Squaw Valley Dev. Co., 80 U.S.P.Q.2d 1264 (T.T.A.B. June 2, 2006) 16

In re Tam, 808 F.3d 1321 (Fed. Cir. 2015) (en banc) 26, 27

Pro-Football, Inc. v. Blackhorse, 112 F. Supp. 3d 439 (E.D. Va. 2015), *on appeal*, (4th Cir.) (No. 15-1874) 16

Statutes

15 U.S.C. § 1051(a) 4, 8

15 U.S.C. § 1052 9

15 U.S.C. § 1052(b) 23

15 U.S.C. § 1052(c) 23

15 U.S.C. § 1052(d) 23

15 U.S.C. § 1052(e) 23

15 U.S.C. § 1056(a) 4

15 U.S.C. § 1057(c) 3

15 U.S.C. § 1062(a) 5

15 U.S.C. § 1063(a) 5

15 U.S.C. § 1072 3

TABLE OF AUTHORITIES—cont'd

Page(s)

15 U.S.C. § 1127 ..... 6, 10

Legislative Materials

Senate Judiciary Committee Report on S. 1883, S. Rep. No. 100-515, p. 30 (Sept. 15, 1988) 3

Treaties

Berne Convention for the Protection of Artistic and Literary Works, Sept. 9, 1886, as revised at Paris on July 24, 1971, and amended in 1979, art. 17 10

General Inter-American Convention for Trade Mark and Commercial Protection, Feb. 20, 1929, Art. 3(4), 46 Stat. 2916, T.S. No. 833 10

Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, Art. 6, 25 Stat. 1376 10

Miscellaneous

Megan M. Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 CARDOZO ARTS & ENT. L.J. 321 (2015) 24

TABLE OF AUTHORITIES—cont'd

Page(s)

Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls**t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 465 (2011).....24

COLLINS ENGLISH DICTIONARY, https://www.collinsdictionary.com 18, 19

DICTIONARY.COM, http://www.dictionary.com 15, 16, 28, 20, 21

THE DICTIONARY OF AMERICAN SLANG (Kipfer and Chapman eds., 4th ed. 2007).....18

GREEN'S DICTIONARY OF SLANG, https://greensdictofslang.com.....14, 15, 17, 18

Laura A. Heymann, *The Birth of the Authornym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377 (2005).....7

Laura A. Heymann, *Naming, Identity, and Trademark Law*, 86 IND. L.J. 381 (2011).....7

Marissa Higgins, *Is the Word "Queer" Offensive? Here's a Look at Its History in the LBTQA+ Community*, BUSTLE, Feb. 4, 2016, https://www.bustle.com/articles/ 139727-is-the-word-queer-offensive-heres-a-look-at-its-history-in-the-lgbtqa-community 20, 21

TABLE OF AUTHORITIES—cont'd

Page(s)

Emily M. Kustina, *Discriminatory Discretion: PTO Procedures and Viewpoint Discrimination Under Section 2(a) of the Lanham Act*, 164 U. PA. L. REV. 513 (2016) 22

William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987).....6, 7

Jeffrey Lefstin, Note, *Does the First Amendment Bar Cancellation of Redskins?*, 52 STAN. L. REV. 665 (2000).....27

Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 COLUM. J.L. & ARTS 187 (2004).....24, 25

MERRIAM-WEBSTER DICTIONARY, https://www.merriam-webster.com/.....*passim*

Kerry L. Monroe, Note, *Purpose and Effects: Viewpoint Discriminatory Closure of a Designated Public Forum*, 44 U. MICH. J.L. REFORM 985 (2011). 4

OXFORD ENGLISH DICTIONARY, http://www.oed.com 15, 17, 19

Regan Smith, Note, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451 (2007).....24

TABLE OF AUTHORITIES—cont'd

Page(s)

USPTO, 2016 PERFORMANCE AND ACCOUNTABILITY REPORT 42 (2016).....25

USPTO, Trademark Application Fee Structure, https://www.uspto.gov/ trademarks-application-process/filing-online/trademark-application-fee-structure 25

USPTO, Trademarks Dashboard, Fourth Quarter FY 2016, At a Glance, https://www.uspto.gov/dashboards/trademarks/main.dashxml.....8, 9

USPTO, Trademark Electronic Search System (TESS), www.uspto.gov/trademarks-application-process/search-trademark-database 9

USPTO, Trademark Fee Information, https://www.uspto.gov/trademarks-application-process/filing-online/trade-mark-application-fee-structure 25

List of best-selling music artists, WIKIPEDIA, https://en.wikipedia.org/ wiki/List_of_best-selling_music_artists.....7

List of ethnic slurs, WIKIPEDIA, https://en.wikipedia.org/wiki/List_of ethnic slurs .....*passim*

BRIEF OF PROFESSORS EDWARD LEE AND JAKE LINFORD AS *AMICI CURIAE* IN SUPPORT OF RESPONDENT

INTEREST OF THE *AMICI CURIAE*[1]

Amici are law professors at institutions in the United States who have no personal interest in the case. Instead, they have expertise in trademark law and the First Amendment and have a professional interest in the development of the law in a way that is faithful to the Constitution, as well as to the Lanham Act's legitimate goals. *Amici* are:

Edward Lee
Professor of Law
Director, Program in Intellectual Property
Chicago-Kent College of Law

Jake Linford
Assistant Professor of Law
Florida State University College of Law

Institutional affiliations are given for identification purposes only.

---

[1] The parties consented to the filing of this brief. Written documentation of their consent is filed with the Clerk. No counsel for a party wrote this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than the *amici curiae* made a monetary contribution intended to fund its preparation or submission. *Amici*'s institutional affiliations are noted for identification only.

SUMMARY OF ARGUMENT

"[O]ne man's vulgarity is another's lyric," this Court instructed in paying heed to the First Amendment's protection for offensive words. *Cohen v. California*, 403 U.S. 15, 25 (1971). "Indeed, we think it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual." *Id.* This principle applies especially so here where the government's denial of federal rights is based on the government's own judgment of whether words offend. Section 2(a) of the Lanham Act's bar against registration of words that "may disparage" persons amounts to impermissible viewpoint discrimination in the limited public forum of the system of federal registration of trademarks. What's more, § 2(a)'s bar has favored, in operation, the views of some groups over others, thereby allowing some racial or other group slurs over others. This discriminatory treatment the First Amendment forbids.

ARGUMENT

SECTION 2(A) OF THE LANHAM ACT VIOLATES THE FIRST AMENDMENT

A. Government Denials of Registrations if the Government Finds the Trademark "May Disparage Persons" Constitutes Viewpoint Discrimination

The Lanham Act's prohibition of words that "may disparage" from federal trademark registration is viewpoint discrimination on its face and in operation.

1. The System of Federal Registration on the Principal Register Is a Limited Public Forum

The system of federal registration of trademarks on the principal register is a limited public forum. The federal government, through the Lanham Act, has reserved this trademark forum to "certain groups" (i.e., trademark owners) and to "discussion of certain topics" (i.e., claims of ownership and priority to trademarks). *Cf. Rosenberger v. Rector & Visitors of Univ. of Virginia*, 515 U.S. 819, 829 (1995) (explaining "limited public forum" doctrine). Although the topic of this forum is narrow, it provides nonetheless the *only* way for trademark owners to put the entire United States on "constructive notice of the registrant's claim of ownership" to a registered trademark. 15 U.S.C. § 1072. And, since 1988, constructive notice has been supplemented by the Lanham Act's grant of constructive use based on the registration of a mark, "conferring a right of priority, nationwide in effect" to the registered trademark. *Id.* § 1057(c). This provision was meant to enhance the dissemination of trademark-related information: "[C]onstructive use, by according conditional rights to those that publicly disclose their marks, will encourage the earlier filing of applications to register trademarks and will foster trademark searching by all parties before they adopt and invest in new marks." Senate Judiciary Committee Report on S. 1883, S. Rep. No. 100-515, p. 30 (Sept. 15, 1988).

Federal registration thus operates like a national bulletin board for trademark owners to inform the public of their identity, address, the trademarks they

own for certain products or services, and when they first used their marks. *Cf. Giebel v. Sylvester*, 244 F.3d 1182, 1188 (9th Cir. 2001), *cert. denied*, 534 U.S. 858 (2001) (designated public forum created where "university's bulletin boards are available for use by the public, including persons not affiliated with the university, 'to communicate with students and others at the University'"); Kerry L. Monroe, Note, *Purpose and Effects: Viewpoint Discriminatory Closure of a Designated Public Forum*, 44 U. MICH. J.L. REFORM 985, 988 (2011) ("For example, a school bulletin board may be limited to postings related to a particular academic subject taught at the school, say history. In that case, the bulletin board would be considered not just a designated public forum, but specifically a limited public forum.").

A registrant includes the following information in his application: (1) the trademark claimed and any drawing of it; (2) its first use in commerce; (3) the type of products or services for which the trademark is used; (4) that the person is "the owner of the mark sought to be registered"; (5) that "to the best of the verifier's knowledge and belief, the facts recited in the application are accurate"; (6) that "to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive"; and (7) any disclaimers limiting the scope of the trademark to be registered. *See* 15 U.S.C. §§ 1051(a), 1056(a).

These statements of the registrant are made not just to the Trademark Office, but also to the public. An application to register a mark is published if it appears to the examiner to be "entitled to registration," and "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register" may file an opposition before the Trademark Office. 15 U.S.C. §§ 1062(a), 1063(a). Once a trademark is registered on the principal register, the information above is published online.

For example, Bob Dylan has registered his name as a trademark (Reg. No. 2033295). Dylan's registration information, publicly accessible to all on the Trademark Office website, is shown in Figure 1:

Figure 1. Public Information of Bob Dylan's Registration

Word Mark	BOB DYLAN
Goods and Services	IC 009. US 021 023 026 036 038. G & S: sound recordings, namely phonographic records featuring music recordings, prerecorded tape cartridges and cartridges featuring music recordings, prerecorded video cassettes featuring musical recordings, and prerecorded optical discs featuring music recordings, computer software stored on CD-ROM and magnetic media, namely, a multimedia interactive database of information and activities in the fields of [illegible] music, photographs and biographies of famous persons. FIRST USE: 19580000. FIRST USE IN COMMERCE: 19620000 IC 016. US 002 005 022 023 029 037 038 050. G & S: printed publications, namely books, sheet music, and music folios. FIRST USE: 19580000. FIRST USE IN COMMERCE: 19620000 IC 041. US 100 101 107. G & S: entertainment services, namely public performances by a musical and vocal artist. FIRST USE: 19580000. FIRST USE IN COMMERCE: 19620000
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74588451
Filing Date	October 17, 1994
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	November 5, 1996
Registration Number	2033295
Registration Date	January 28, 1997
Owner	(REGISTRANT) Dylan, Bob INDIVIDUAL UNITED STATES P.O. Box 853 Cooper Station New York City NEW YORK 10276-0853
Attorney of Record	Claudia M. Barrett
Type of Mark	TRADEMARK. SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20160406
Renewal	2ND RENEWAL 20160406
Live/Dead Indicator	LIVE

The speech contained in this registration goes beyond the trademark BOB DYLAN to include important factual information, including the name and address of the owner, any attorney of record, the nature of the goods or services for which the trademark is claimed, any drawings, and the date of first use of the mark in commerce. This information is valuable to not only the trademark owner, but also members of the public who might be interested in licensing the mark or determining if the mark is already registered. Although this trademark-related information is relatively brief, this Court has recognized that even brief information (as few as 30 words from organizations merely to identify themselves for future solicitation of funds) constitutes protected speech. *Cornelius v. NAACP Legal Defense and Educ. Fund*, 473 U.S. 788, 790-91, 799 (1985).

The speech element of federal registration is facilitated by the Lanham Act's expansive view of what can constitute a trademark ("any word, name, symbol, or device, or any combination thereof used by a person ... to identify and distinguish his or her goods, ... and to indicate the source of the goods, even if that source is unknown"). 15 U.S.C. § 1127; *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 162 (1995) ("Since human beings might use as a 'symbol' or 'device' almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive."). Indeed, nearly every word can be used in a way to create a trademark. The Lanham Act even helps to incentivize the creation of new words, as well as new meanings of existing words. *See* William M. Landes & Richard A. Posner,

Trademark Law: An Economic Perspective, 30 J.L. & ECON. 265, 271 (1987).

Moreover, trademarks are often a form of expression of personal identity. *See* Laura A. Heymann, *The Birth of the Authornym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377, 1413 (2005); Laura A. Heymann, *Naming, Identity, and Trademark Law*, 86 IND. L.J. 381, 444-45 (2011) ("both personal names and trademarks ultimately serve the same function: to identify a person or thing, to distinguish that person or thing from others, and, relatedly, to act as a vehicle for certain intended or unintended associations about the individual, company, good, or service").

That is especially so where, as here, the trademark identifies people, not products. A band's name is a part of its identity, the way for it to be discovered and become established among music fans. Federal registration of that name is vital to securing a national scope for a band's name and identity. Through federal registration, a band, just as with any business, can announce to the entire nation: "This MARK is who I am." Not surprisingly, countless musicians have obtained federal registration. To name a few: Bob Dylan, Jimi Hendrix, Elvis Presley, The Beatles, The Rolling Stones, Michael Jackson, N.W.A., Rihanna, Whitney Houston, Katy Perry, and Adele. *See* Appendix A; JIMI HENDRIX (Reg. No. 2902769). As shown in Appendix A, our survey of the top 50 artists (based on certified sales from the List of best-selling music artists, WIKIPEDIA, https://en.wikipedia.org/wiki/List_of_best-selling_music_artists) (all websites cited herein last visited Dec. 14, 2016) indicates that

only 8 of the 50 artists do not have federal registrations of their names. *See* Appendix A (no registrations for Madonna, Elton John, Queen, Eagles, Phil Collins, Lil Wayne, Rod Stewart, and Julio Iglesias). All the other artists on the Top 50 list have federally registered marks—in many cases, multiple registrations—of their names or bands' names. *Id.* And, except for Queen and Eagles, all of the top group bands with fanciful names instead of personal names have federal registrations of their bands' names. *Id.* The Slants ask only for the same treatment.

The limited public forum embodied by the system of federal registration is shown by (i) the openness of federal registration to *all* valid trademark owners and (ii) the openness of the federal registry as a means of disseminating information to the public. *Cf. Cornelius*, 473 U.S. at 802 (for limited public forum, court examines "policy and practice of the government" and "the nature of the property and its compatibility with expressive activity"). Here, any member of the public who owns a valid trademark may post her ownership information in this public forum (embodied in registration on the principal register), and the entire public may access that information.

Given the relative ease by which any person can create a new trademark based on use (either before or after filing for a trademark, *see* 15 U.S.C. § 1051(a), (b)), it is no exaggeration to say that federal registration is potentially available to all. All it takes is coming up with a new trademark. In 2016, over 300,000 trademarks were registered. *See* USPTO, Trademarks Dashboard, Fourth Quarter FY 2016, At a Glance, https://www.uspto.gov/dashboards/trade

marks/main.dashxml. And, of course, the government itself does not play any role in the design of the registered trademarks, much less own them. *Cf. Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2251 (2015) (finding no limited public forum in state specialty license plates because state had "final authority" over design and ultimate "ownership").

Likewise, unlike a state's confidential database of license plates or an internal mailbox system of a public school, the principal register of trademarks is accessible to the public—indeed, the entire world—at the searchable website of the Trademark Office. *See* Trademark Electronic Search System (TESS), www.uspto.gov/trademarks-application-process/ search-trademark-database. Indeed, the whole point of the online federal registry is for trademark holders to announce—or express—to the nation and the world their claim of ownership to certain trademarks in the United States.

Except for § 2(a)'s bar against disparaging marks and its bar against "immoral ... or scandalous matter," Section 2(a) takes a very broad permissive approach to allowing *all* trademarks to be registered ("No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature...") unless they are not valid as source identifiers (e.g., merely descriptive terms, functional, lack priority) or fail for concerns of deception, interference with existing trademarks or geographical indications, consumer confusion, dilution, or unfair competition. *See* 15 U.S.C. § 1052. These

valid trademark-related reasons are recognized in the Lanham Act's statement of Congress's intent. *Id.* §1127 ("The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.").

The government's suggestion (U.S. Br. 24 n.7) that § 2(a) might be justified by a treaty is mistaken. Both treaties cited by the government merely give members the discretion to deny registrations for reasons of public order; neither treaty requires it. *See* General Inter-American Convention for Trade Mark and Commercial Protection, Feb. 20, 1929, Art. 3(4), 46 Stat. 2916, T.S. No. 833; Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, Art. 6, 25 Stat. 1376. A comparable provision in the Berne Convention (of which the U.S. is a member) recognizes discretion for countries to censor copyrighted works. Berne Convention for the Protection of Artistic and Literary Works, Sept. 9, 1886, as revised at Paris on July 24, 1971, and amended in 1979, art. 17. Of course, that does not mean the United States can rely on Berne to justify censorship.

2. Section 2(a)'s Viewpoint Discrimination

Of course, not every trademark owner is entitled to federal registration on the principal register—or to access the limited public forum embodied in federal registration. In the Lanham Act, the government has, as it may under the First Amendment, "confine[d] a forum to the limited and legitimate purposes for which it was created." *Rosenberger*, 515 U.S. at 829. This kind of limitation is what defines a limited public forum. It is, by definition, not as open as a traditional public forum.

Although this Court's precedents have sometimes used "limited" in describing both a designated public forum (the second type in *Perry Educ. Ass'n v. Perry Local Educators' Ass'n*, 460 U.S. 37, 45-46 n.7 (1983)) and a more limited public forum (*id.* at 47 (rejecting association's claim for "limited public forum"); *Good News Club v. Milford Central School*, 533 U.S. 96, 106 (2001); *Rosenberger*, 515 U.S. at 829; *Pleasant Grove City v. Summum*, 555 U.S. 460, 470 (2009)), the Court should take the latter approach and apply the limited public forum doctrine from *Good News Club* and *Rosenberger* to this case.[2] The system of

[2] A limited public forum falls in between a designated public forum (which is equivalent to a traditional public forum in that both are generally open to the public) and a nonpublic forum, which need not contain an expressive purpose. This category of limited public forum as articulated in *Good News Club* and *Rosenberger* is helpful because some forums may be open to a segment of the public, but not generally to the entire public. To characterize such forums as "nonpublic" would be inaccurate. For example, the *Good News Club* Court held that a limited public forum was created by a school district's policy to allow

federal registration is a limited public forum that should be subject to reasonable restrictions of speech and viewpoint neutrality. In any event, even nonpublic forums (the third type in *Perry*, 460 U.S. at 46) are subject to the same scrutiny for reasonable restrictions and viewpoint neutrality. *See Arkansas Educ. Television Comm'n v. Forbes*, 523 U.S. 666, 682 (1998). Thus, even if the system of registration of trademarks on the principal register is considered a nonpublic forum, it should be subject to the same scrutiny as outlined above.

Here, Section 2(a)'s bar of words that may disparage people constitutes viewpoint discrimination under the limited public forum doctrine of *Good News Club* and *Rosenberger*. Section 2(a)'s bar against marks that "may disparage ... persons" has no legitimate trademark purpose. It does not protect source-identification or consumers from confusion, deception, or unfair competition. Instead, § 2(a) attempts to shield the public from putatively disparaging views of people. Such viewpoint discrimination the First Amendment forbids—whatever the type of fo-

---

[Footnote continued from previous page]

district residents to use the school facilities for certain events that were open to the public. *Good News Club*, 533 U.S. at 103. Likewise, in *Rosenberger*, this Court held that a state university's policy to fund student extracurricular activities constituted a limited public forum. *Rosenberger*, 515 U.S. at 829-30. Although a limited public forum and nonpublic forum are subject to the same First Amendment tests of reasonableness and viewpoint neutrality, the test of reasonableness may be applied differently depending on how public (or not) the forum is. A restriction that is reasonable for a nonpublic forum may not necessarily be reasonable for a limited public forum, given its public nature.

rum. *See Good News Club*, 533 U.S. at 106-07 (no viewpoint discrimination for limited public forum); *Cornelius*, 473 U.S. at 800 (no viewpoint discrimination for nonpublic forum).

Section 2(a)'s viewpoint discrimination is manifest. The Trademark Office denies registration of a mark if it believes the meaning of a term may disparage persons. The Trademark Office grants the registration if it believes the meaning of the term does not disparage persons. In short, § 2(a) discriminates against disparaging views taken of people: disparaging terms are barred, while non-disparaging terms are favored. Banning disparaging marks from registration is just as much viewpoint discrimination as would be banning religious marks from registration. *Cf. Lamb's Chapel v. Center Moriches Union Free School Dist.*, 508 U.S. 384, 394 (1993) (viewpoint discrimination through denial of use of school facilities to show religious films); *Rosenberger*, 515 U.S. at 831 (viewpoint discrimination through denial of funds to journal with religious editorial views); *Good News Club*, 533 U.S. at 107 (viewpoint discrimination through denial of use of school facilities after hours for religious purpose). Nor would such a ban on religious marks be excused if the restriction were determined based on the government's assessment of whether the content was religious in context, including by consideration of dictionary definitions and a substantial composite of the public's reaction. Viewpoint discrimination arises if the government favors one view over another in a restriction of speech—e.g., favoring nonreligious views over religious views, or positive views over disparaging views. *See Members of City Council v. Taxpayers for Vincent*, 466 U.S.

789, 804 (1984) ("The general principle that has emerged from this line of cases is that the First Amendment forbids the government to regulate speech in ways that favor some viewpoints or ideas at the expense of others."); *accord Cornelius*, 508 U.S. at 394. That is what happened here.

And it is simply no answer for the government to assert that Tam's band can still enforce an unregistered trademark and use THE SLANTS as its name. U.S. Br. 26-27. By that reasoning, the school district in *Good News Club* could have excluded the religious group from the school's limited public forum as long as the religious group could meet elsewhere, such as on private property. But the whole point of viewpoint neutrality is to place a check on the government favoring certain views. The availability of private forums for speech does not cure the government's viewpoint discrimination. And, here, there is simply no practical substitute for informing the public of an entity's ownership of a national trademark except by inclusion on the federal registry.

In practical operation, the Trademark Office has applied § 2(a) in a way that favors some groups of people, but not others, as the list of registrations below shows:

(1) TACO HEADS (Reg. No. 5006995). *See* GREEN'S DICTIONARY OF SLANG, https://greensdictofslang.com/search/basic?q=taco+head ("taco head": "a derog. term for a Mexican or a Chicano"); List of ethnic slurs, WIKIPEDIA, https://en.wikipedia.org/wiki/List_of_ethnic_slurs#T ("Tacohead ... a Mexican person").

(2) COON POP (Reg. No. 5059018). *See* MERRIAM-WEBSTER DICTIONARY, https://www.merriam-webster.com/dictionary/coon ("coon": "2. offensive — used as an insulting and contemptuous term for a black person"); GREEN'S DICTIONARY OF SLANG, https://greensdictofslang.com/search/basic?q=coon ("coon": "a highly derog. term for a black person"); List of ethnic slurs, WIKIPEDIA, https://en.wikipedia.org/wiki/List_of_ethnic_slurs#C ("coon": "(US, UK) a black person. Possibly from Portuguese barracão or Spanish barracón, a large building constructed to hold merchandise, where slaves were kept for sale, anglicised to barracoon (1837)").

(3) TAR BABY (Reg. No. 0614004, expired). *See* OXFORD ENGLISH DICTIONARY, http://www.oed.com/view/Entry/197754?redirectedFrom=tar+baby#eid19291859 ("tar baby": "(b) a derog. term for a black person (U.S.) or a Maori (N.Z.)").

(4) MACACA (Reg. No. 4799771). *See* List of ethnic slurs, WIKIPEDIA, https://en.wikipedia.org/wiki/List_of_ethnic_slurs#M ("macaca": "originally used by francophone colonists in North Africa, also used in Europe as derogatory term against Immigrants from Africa").

(5) THE REDSKINS (Reg. No. 0836122); WASHINGTON REDSKINS (Reg. Nos. 0978824, 0986668); REDSKINS (Reg. No. 1085092); REDSKIN (Reg. No. 218639). *See* MERRIAM-WEBSTER DICTIONARY, https://www.merriamwebster.com/dictionary/redskin ("redskin": "usually offensive: American Indian"); DICTIONARY.COM, http://www.dictionary.com/browse/redskin ("redskin":

"Older Slang: Disparaging and Offensive. 1.a contemptuous term used to refer to a North American Indian."); *but see Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015) (affirming TTAB's cancellation of REDSKINS registration under "may disparage" bar), *on appeal*, (4th Cir.) (No. 15-1874).

(6) SQUAW (Reg. No. 3322061); SQUAW VALLEY (Reg. Nos. 4934959, 4704112, 4411257, 0670261); SQUAW VALLEY USA (Reg. Nos. 2269300, 2115036, 1645155, 1628589); SQUAW CREEK (Reg. No. 2049234); SQUAW ONE (Reg. No. 3322062); RESORT AT SQUAW CREEK (Reg. No. 3454778). *See* MERRIAM-WEBSTER DICTIONARY, https://www.merriam-webster.com/dictionary/squaw ("squaw": "usually offensive: an American Indian woman"); DICTIONARY.COM, http://www.dictionary.com/browse/squaw?s=t ("squaw": "Older Use: Disparaging and Offensive. a contemptuous term used to refer to a North American Indian woman, especially a wife."); *see also In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264 (T.T.A.B. June 2, 2006) (denial of registration of SQUAW and SQUAW ONE as disparaging under § 2(a) for clothing and sporting goods services, but allowing registration for "skis, ski poles, ski bindings, ski tuning kits comprised of waxes and adjustment tools, ski equipment, namely, power cords").

(7) WHITE TRASH (Reg. No. 3849437); POOR WHITE TRASH PRODUCTIONS (Reg. No. 5021354); MAD MAXS WHITE TRASH BASH (Reg. No. 4821790); WHITE TRASH REBEL (Reg. No. 4687136); WHITE TRASH REPAIRS (Reg. No. 4022732); SUSIE'S WHITE TRASH (Reg. No.

4656958); UPPER WHITE TRASH (Reg. No. 4649626); ETTA MAY'S WHITE TRASH DIARY (Reg. No. 4156905); WHITE TRASH ROYALTY (Reg. No. 4177307); WHITE TRASH RACIN (Reg. No. 3761237); WHITE TRASH BEAUTIFUL (Reg. No. 4009982); AUTHENTIC WHITE TRASH (Reg. No. 4071200). *See* GREEN'S DICTIONARY OF SLANG, https://greensdictofslang.com/search/basic?q=white+trash ("white trash": "a derog. term for the poor white population of the Southern states; thus extended to non-US contexts"); OXFORD ENGLISH DICTIONARY, http://www.oed.com/view/Entry/421005?redirectedFrom=white+trash#eid ("white trash": "orig. and chiefly U.S. colloq. (derogatory) ... Poor white people of low social status, esp. when regarded as uneducated or uncultured; (also) people who are perceived as having the values or attitudes associated with such a group...."); List of ethnic slurs, WIKIPEDIA, https://en.wikipedia.org/wiki/List_of_ethnic_slurs#W ("white trash": (US) poor white people. Common usage from the 1830s as a pejorative used by black house slaves against white servants").

(8) HILLBILLY ROCKSTARZ (Reg. No. 4726546); HILLBILLY HAND SCRUB JUST A SKIRT'LL DO YA' (Reg. No. 4583548); HILLBILLY HOUSE BUYERS (Reg. No. 4587689); HILLBILLY (Reg. No. 4599091); HILLBILLY HORROW SHOW (Reg. No. 4604966); HUNGRY HILLBILLY'S (Reg. No. 4663070); ROUND HILLBILLY (Reg. No. 4736422); SUP'D UP HILLBILLY (Reg. No. 4780679); HOLLYWOOD HILLBILLIES (Reg. No. 4796075); ROUND HILLBILLY (Reg. No. 4856414); THE HEBREW HILLBILLY: FIFTY SHADES OF OY VEY (Reg. No. 4884385); HILLBILLY WILLYS (Reg.

No. 4945787); HILLBILLY FOOTWASH (Reg. No. 4968222); HILLBILLY (Reg. Nos. 4639800, 45599091); HILLBILLY DELUXE (Reg. No. 5005004); HILLBILLY BOURBON (Reg. No. 5013302); HILLBILLY WHISKEY (Reg. No. 5059868). *See* COLLINS ENGLISH DICTIONARY, https://www.collinsdictionary.com/dictionary/english/hillbilly ("hillbilly": "usually derogatory an unsophisticated person, esp from the mountainous areas in the southeastern US"); THE DICTIONARY OF AMERICAN SLANG (Kipfer and Chapman eds., 4th ed. 2007) ("hillbilly": "(1) A southern Appalachian hill dweller •Regarded as offensive by some (1900+)"), *available at* http://www.dictionary.com/browse/hill billy.

(9) REDNECK RIVIERA (Reg. Nos. 5013306, 4813370, 4805587, 4790900, 4770464, 4809070, 4653408, 4168228, 3962132); RR REDNECK RIVIERA (Reg. Nos. 5013307, 4748412, 4769115, 4791126, 4951700); REDNECK BOOT SANDALS (Reg. No. 5015921); THE REDNECK MAGICIAN (Reg. No. 5063221); REDNECK EXPRESS PARTY BUS SERVICE (Reg. No. 5080930); REDNECK CARD REVOKED (Reg. No. 5094705); GREAT SCOTTS HOME OF THE REDNECK SUP! (Reg. No. 5094048). *See* GREEN'S DICTIONARY OF SLANG, https://greensdictofslang.com/search/basic?q=redneck ("redneck": "a derog. term for a country dweller, a peasant, esp. a southern US poor farmer who is stupid and racist; strictly rednecks came from swampy areas while hillbillies, their peers, came from the mountains [their sunburn; orig. a Presbyterian, then transferred to all poor whites]"); MERRIAM-WEBSTER DICTIONARY, https://www.merriamwebster.com/dictionary/redneck ("redneck": "(1) sometimes disparag-

ing: a white member of the Southern rural laboring class; (2) often disparaging : a person whose behavior and opinions are similar to those attributed to rednecks"); OXFORD ENGLISH DICTIONARY, http://www.oed.com/view/Entry/160404?redirectedFrom=redneck#eid ("red neck": "3. orig. N. Amer. (usu. derogatory). Originally: a poorly educated white person working as an agricultural labourer or from a rural area in the southern United States, typically considered as holding bigoted or reactionary attitudes..."); List of ethnic slurs, WIKIPEDIA https://en.wikipedia.org/wiki/List_of_ethnic_slurs#R ("red neck": "(US) Southern laborer-class whites").

(10) DAGO SWAGG (Reg. No. 4347624). *See* MERRIAM-WEBSTER DICTIONARY, https://www.merriam-webster.com/dictionary/dago ("dago": "*offensive* — used as an insulting and contemptuous term for a person of Italian or Spanish birth or descent"); OXFORD ENGLISH DICTIONARY, http://www.oed.com/view/Entry/46892?redirectedFrom=dago#eid ("dago": "A name originally given in the south-western section of the United States to a man of Spanish parentage; now extended to include Spanish, Portuguese, and Italian people in general, or as a disparaging term for any foreigner.").

(11) CRACKA AZZ SKATEBOARDS (Reg. No. 1589729). *See* COLLINS ENGLISH DICTIONARY, https://www.collinsdictionary.com/dictionary/english/cracka ("cracka": "US derogatory a variant spelling of cracker" [meaning "poor White"]); List of ethnic slurs, WIKIPEDIA https://en.wikipedia.org/wiki/List_of_ethnic_slurs#C ("cracker": "(US) a poor Appalachian or poor Southerner, a white person, first used in

the 19th century....Also used in a more general sense in North America to refer to white people disparagingly.").

The Trademark Office's viewpoint discrimination is even clearer in how it has allowed some groups to "reclaim" an offensive term by registration, but denying reclaiming by Simon Shiao Tam and his band in this case:

(12) QUEER STUFF ENTERPRISES, INC. PROMOTING ALL THINGS NORMALLY QUEER AND QUEERLY NORMAL (Reg. No. 3092422); CAPITAL QUEER PROM (Reg. No. 3893904); QUEER OR STRAIGHT? (Reg. No. 4298676); QUEERKAT (Reg. No. 4186417); THE QUEER COMMONS (Reg. No. 4201675); QUEERFINITY (Reg. No. 4463235); A CONCOCTION OF ALL THINGS QUEER, CULTURE, AND CURRENT (Reg. No. 4462433); QUEER BOIS (Reg. No. 4510083); QUEERCRAFT (Reg. No. 4620679); QUEER PAL FOR THE STRAIGHT GAL (Reg. No. 4699581); QUEER FOLK, (Reg. No. 4742269); FROM QUEER TO ETERNITY (Reg. No. 4765714); LOVE IS QUEER (Reg. No. 4568331). *See* MERRIAM-WEBSTER DICTIONARY, https://www.merriam-webster.com /dictionary/queer ("queer": "d (1) often disparaging : homosexual (2) sometimes offensive : gay"); DICTIONARY.COM, http://www.dictionary.com/ browse/ queer?s=t ("queer": "Slang. Usually Disparaging and Offensive. (of a person) gay or lesbian."); Marissa Higgins, *Is the Word "Queer" Offensive? Here's a Look at Its History in the LBTQA+ Community*, BUSTLE, Feb. 4, 2016, https://www.bustle.com/articles/

139727-is-the-word-queer-offensive-heres-a-look-at-its-history-in-the-lgbtqa-community ("This movement to reclaim 'queer' started in the 1980s and has become progressively more popular in the decades since, though it's still a divisive concept.").

(13) DYKES ON BIKES (Reg. No. 3323803); DYKE NIGHT (Reg. No. 4146588); VELVET PARK DYKE CULTURE IN BLOOM (Reg. No. 3128707). *See* MERRIAM-WEBSTER DICTIONARY, https://www.merriam-webster.com/dic tionary/ dykes ("dyke": "often disparaging: lesbian"); DICTIONARY.COM, http://www.dictionary.com/browse/ dyke?s=t ("dyke": "Slang: Disparaging and Offensive.1. a contemptuous term used to refer to a lesbian.").

(14) N.W.A. (acronym for Niggaz Wit Attitudes) (Reg. No. 2522163). *See* DICTIONARY.COM, http://www.dictionary.com/browse/nigga ("Nigga is used mainly among African Americans, but also among other minorities and ethnicities, in a neutral or familiar way and as a friendly term of address....However, nigga is taken to be extremely offensive when used by outsiders. Many people consider this word to be equally as offensive as nigger.").

As the federal registrations above show, whether § 2(a) bars registration apparently "depend[s] on the identity of the person or group that the mark disparages," to borrow the Solicitor General's description of viewpoint discrimination. *Cf.* U.S. Br. 46.

Tam was denied federal registration because the Trademark Office found that his mark "may disparage" people of Asian or Asian American descent. Yet,

as shown above, the Trademark Office has allowed numerous federal registrations to other marks that also "may disparage" other (non-Asian) groups, including registrations by the musical groups N.W.A. and HILLBILLY ROCKSTARZ. *See also* Emily M. Kustina, *Discriminatory Discretion: PTO Procedures and Viewpoint Discrimination Under Section 2(a) of the Lanham Act*, 164 U. PA. L. REV. 513, 559 (2016) (compiling in Table 2 survey of Trademark Office decisions on trademarks using following terms: "chink," "dyke," "fag," "faggot," "hebe," "heeb," "jap," "nigga," "nigger," "queer," "redskin," "slant," "squaw"); *id.* (indicating numerous federal registrations involving "dyke," "fag," "hebe," "queer," "redskin," "slant," and "squaw").

As such, the Trademark Office practice creates a "significant danger that 'favored' private viewpoints will be furthered" at the expense of disfavored viewpoints of other groups. *Cf.* U.S. Br. 46. Both facially and in operation §2(a) violates the First Amendment. *See generally R.A.V. v. City of St. Paul*, 505 U.S. 377, 391 (1992) (finding city "hate speech" law constituted viewpoint discrimination in operation); *accord Sorrell v. IMS Health Inc.*, 564 U.S. 552, 565 (2011) ("'In its practical operation,' Vermont's law 'goes even beyond mere content discrimination, to actual viewpoint discrimination.'") (quoting *R.A.V.*, 505 U.S. at 391).

3. The Reasonable Restrictions of Trademark Ownership in the Lanham Act

Almost all of the other Lanham Act's restrictions are "'reasonable in light of the purpose served by the

forum.'" *Good News Club*, 533 U.S. at 107 (quoting *Rosenberger*, 515 U.S. at 829); *see also Walker*, 135 S. Ct. at 2262 (Alito, J., dissenting) (applying same approach to state license plates). As this Court recognized, "The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers. See S. Rep. No. 1333, at 3, 5. National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation." *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985).

Most of the requirements of § 2 of the Lanham Act are reasonable in light of the legitimate trademark purposes in protecting source-identification of trademarks and in avoiding registration of marks that could lead to consumer confusion with other marks, various forms of deception and false information to consumers, misappropriation, unfair competition, dilution of famous marks, or inappropriate extension of trademarks to functional elements. *See* 15 U.S.C. § 1052(a), (b), (c), (d), and (e).

Accordingly, contrary to the argument of *Amici Curiae* Law Professors in Support of Petitioner, scrutinizing § 2(a)'s disparagement bar will not put in jeopardy "numerous provisions of the Trademark Act." Brief of Law Professors as *Amici Curiae* in Supp. of Pet. 1. Nearly all of the Lanham Act's restrictions are both viewpoint neutral and reasonable to trademark's purposes. Besides § 2(a)'s disparage-

ment bar, the only other provision that appears susceptible to concerns for viewpoint discrimination is § 2(a)'s bar of "immoral ... or scandalous" marks. *See* Megan M. Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 CARDOZO ARTS & ENT. L.J. 321, 332-34 (2015) (study of 232 Trademark Office decisions based on scandalousness that showed inconsistent use of dictionaries and context); Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls**t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 465, 468-74 (2011) (criticizing Trademark Office's lack of standards and evidence in applying scandalousness bar); Regan Smith, Note, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 471 (2007) (discussing possible viewpoint discrimination of scandalousness bar). However, this issue is not before the Court and should await a future controversy.

In any event, the limited public forum doctrine of *Good News Club* and *Rosenberger* will not expose the Lanham Act to First Amendment scrutiny beyond reasonableness and viewpoint neutrality—an approach consonant with trademark law's own development of internal First Amendment safeguards through the common law and legislation, as well as this Court's general approach to copyright law. *Cf.* Pierre N. Leval, *Trademark: Champion of Free Speech*, 27 COLUM. J.L. & ARTS 187, 189-95 (2004) (contending that trademark law internalizes free speech accommodations through common law development); *Eldred v. Ashcroft*, 537 U.S. 186, 221 (2002) (copyright law is not categorically immune from First

Amendment scrutiny, but "copyright's built-in free speech safeguards are generally adequate to address" speech concerns).

B. Federal Registration Is Not a Government Subsidy, Government Funding, or Government Speech

Section 2(a)'s viewpoint discrimination is not saved by attempts to shield it from any First Amendment scrutiny. Trademark registration is not a government subsidy or funding. It is exactly the opposite. Registrants pay between $225 to $325 per registration and $400 for maintenance fees each decade to the federal government, which raises substantial revenues from the registrations. *See* USPTO, Trademark Application Fee Structure, https://www.uspto.gov/trademarks-application-process/filing-online/trademark-application-fee-structure; USPTO, Trademark Fee Information, https://www.uspto.gov/trademarks-application-process/filingonline/trade-mark-application-fee-structure. Indeed, in FY 2016, the federal government collected $146.1 million in revenues from registrations. *See* USPTO, 2016 PERFORMANCE AND ACCOUNTABILITY REPORT 42 (2016).

None of the subsidy or union cases cited by the Solicitor General involved a citizen paying the federal government. *See* U.S. Br.15-18, *citing Regan v. Taxation With Representation of Wash.*, 461 U.S. 540 (1983) (federal tax exemptions); *Rust v. Sullivan*, 500 U.S. 173 (1991) (federal family-planning funds); *NEA v. Finley*, 524 U.S. 569 (1998) (federal arts grants); *United States v. American Library Ass'n*, 539 U.S.

194 (2003) (federal library funding); *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177 (2007) (use of payroll deduction by union of public employees to collect agency-shop fees); *Ysursa v. Pocatello Educ. Ass'n*, 555 U.S. 353 (2009) (same as *Davenport*). While the government does have some power to condition uses of its own funding and subsidies disbursed—thereby attaching strings to its purse—to people in ways that burden their speech, no such power exists where the government itself is collecting funds from citizens—particularly where, as here, it involves access to a limited public forum. *See Rust*, 500 U.S. at 198-99 (differentiating government's legitimate exercise of "public fisc" versus speech restrictions of a public forum). The First Amendment still applies.

Federal registration of trademarks is also not the government speaking. The nationwide expression of ownership of a registered mark, along with the underlying mark and assertions of priority, are made by the registrant, *not* by the government. *Cf. Walker*, 135 S. Ct. at 2251 (holding state license plates were not limited public forum because government owned "each specialty plate design"). No one can reasonably think that a federally registered trademark—such as BOB DYLAN ®—is the government itself speaking. Indeed, the historical practice of the Trademark Office expressly rejected the notion that federal registration should be viewed as the Office's "endorsement" or "imprimatur" backing the underlying trademark. *See In re Tam*, 808 F.3d 1321, 1347 (Fed. Cir. 2015) (en banc) (citing *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1219-20 n.3 (T.T.A.B. Mar. 3, 1993)); Jeffrey Lefstin, Note, *Does the First*

Amendment Bar Cancellation of Redskins?, 52 STAN. L. REV. 665, 684 (2000) ("both the Court of Customs and Patent Appeals and the Trademark Trial and Appeal Board have unequivocally rejected the notion that trademark registration connotes government imprimatur").

Indeed, if the system of federal registration were considered the federal government speaking, the consequences would be dire. All sorts of controversial trademarks (such as the ones mentioned above in section A) would now be considered the speech of the federal government, with its official backing. Even the controversial name and logo of the Sons of Confederate Veterans—the very subject matter Texas rejected for a specialty license plate in *Walker*, 135 S. Ct. at 2243-44—would be considered the speech of the federal government. Both the name and the logo of the Sons of Confederate Veterans, including the symbol of the confederate flag—have long been federally registered marks. *See* SONS OF CONFEDERATE VETERANS 1896 (Reg. No. 2764268, registered in 2003); SONS OF CONFEDERATE VETERANS (Reg. No. 4130767, registered in 2012). To characterize these federal registrations as the federal government's own speech is, put simply, untenable.

The parade of horribles the Petitioner imagines in allowing offensive trademarks to be federally registered has not materialized, notwithstanding the numerous arguably offensive trademarks already registered. *See* U.S. Br. 10-11. The marketplace of ideas, as well as the economic market (such as consumer boycotts and public shaming), provides the constitu-

tionally permissible antidote to offensive words used as trademarks. *See generally N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 270 (1964) (recognizing "a profound national commitment to the principle that debate on public issues should be uninhibited, robust, and wide-open, and that it may well include vehement, caustic, and sometimes unpleasantly sharp attacks..."). Consumers and the public at large have the power to persuade registrants of offensive marks "that they are wrong." *Texas v. Johnson*, 491 U.S. 397, 419 (1989).

CONCLUSION

The decision of the Federal Circuit should be affirmed.

Respectfully submitted.

EDWARD LEE
Counsel of Record
CHICAGO-KENT COLLEGE OF LAW
565 W. Adams Street
Chicago, IL 60661
(312) 906-5212
elee@kentlaw.iit.edu

December 2016

Appendix A. Top 50 Artists by Certified Sales with Registered Trademarks*

* indicates multiple ®s but only earliest one is listed

Rank in sales (certified)	Artist	Registered Trademark No.
1	The Beatles	1752120*
2	Elvis Presley	1342551*
3	Michael Jackson	1908209*
4	Madonna	none
5	Elton John	none
6	Led Zeppelin	2212548*
7	Pink Floyd	2194702*
8	Rihanna	3621108*
9	Mariah Carey	2024932*
10	Celine Dion	2850587*
11	AC/DC	2721830*
12	Whitney Houston	4636296*
13	Queen	none
14	The Rolling Stones	3853613*

15	ABBA	3862613*
16	Taylor Swift	3809274*
17	Garth Brooks	2443657*
18	Eminem	2544555*
19	Eagles	none
20	U2	1820220*
21	Billy Joel	1233992*
22	Phil Collins	none
23	Aerosmith	1552802*
24	Frank Sinatra	1817035*
25	Barbra Streisand	2225638*
26	Kanye West	3648799*
27	Bruce Springsteen	1697409*
28	Bee Gees	1142133*
29	Lady Gaga	3960468*
30	Metallica	1923477*
31	Katy Perry	3682086*
32	Adele	4260010

33	Bruno Mars	4143492*
34	Justin Bieber	4396533*
35	Jay-Z	2485104*
36	Bon Jovi	1484670*
37	Lil Wayne	none
38	Rod Stewart	none
39	Britney Spears	2302300*
40	Fleetwood Mac	1238825*
41	Guns N' Roses	1762599*
42	George Strait	2039665
43	Backstreet Boys	3896747
44	Neil Diamond	2607316
45	Prince	2151863
46	Paul McCartney	2407693*
47	Kenny Rogers	1199918*
48	Janet Jackson	3046492*
49	Julio Iglesias	none
50	Chicago	1006059

RECORD AND BRIEFS

FILED
NOV 16 2016
OFFICE OF THE CLERK

No. 15-1293

In the Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES AND TRADEMARK OFFICE,
Petitioner,

v.

SIMON SHIAO TAM,
Respondent.

On Writ of Certiorari to United States Court of Appeals for the Federal Circuit

BRIEF OF *AMICI CURIAE* NATIVE AMERICAN ORGANIZATIONS IN SUPPORT OF PETITIONER

RICHARD A. GUEST
Native American Rights Fund
1514 P St. NW, Ste. D
Washington, DC 20005

LARRY S. GONDELMAN
BRANDI A. TAYLOR
Powers Pyles Sutter & Verville PC
1501 M St. NW
Washington, DC 20005

CHARLES A. ROTHFELD
Counsel of Record
ANDREW J. PINCUS
PAUL W. HUGHES
MICHAEL B. KIMBERLY
Mayer Brown LLP
1999 K Street, NW
Washington, DC 20006
(202) 263-3000
crothfeld@mayerbrown.com

Counsel for Amici Curiae

TABLE OF CONTENTS

Page

Table of Authorities iii

Interest of *Amici Curiae* 1

Introduction and Summary of Argument 3

Argument 5

I. Section 2(a) Regulates Commercial Speech. 5

A. Trademarks are inherently commercial in character. 5

1. Throughout history, trademarks have served as instruments of commerce. 7

2. The Lanham Act defines and regulates trademarks solely as instruments of commerce. 8

3. Noncommercial uses are not the proper subject of trademark. 10

B. Trademarks are commercial speech. 12

1. In all cases, trademarks are properly regulated as commercial speech. 13

2. Alternatively, only trademarks whose commercial component is "inextricably intertwined" with an expressive component are noncommercial speech. 15

II. The Government's Regulation Of Disparaging Trademarks Satisfies *Central Hudson*. 17

A. Section 2(a) directly advances substantial governmental interests in limiting disparaging speech in commercial contexts. 17

TABLE OF CONTENTS—continued

Page

1. The orderly flow of commerce. 18

2. Privacy and welfare 21

B. Section 2(a) is narrowly tailored. 25

III. The Long History Of Trademarks That Disparage Native Americans Confirms That Section 2(a) Is Permissible Regulation. 28

Conclusion 35

TABLE OF AUTHORITIES

Page(s)

Cases

Amoskeag Mfg. Co. v. *D. Trainer & Sons*,
101 U.S. 51 (1879) 8

Bd. of Trs. of the State Univ. of N.Y. v. *Fox*,
492 U.S. 469 (1989) 22, 27

Bob Jones Univ. v. *United States*,
461 U.S. 574 (1983) 21

Bolger v. *Youngs Drug Prods. Corp.*,
463 U.S. 60 (1983) 12, 18

Brown v. *Bd. of Educ.*,
347 U.S. 483 (1954) 25

Cent. Hudson Gas & Elec. Corp. v.
Pub. Serv. Comm'n,
447 U.S. 557 (1980) 17, 20, 25

Cincinnati v. *Discovery Network, Inc.*,
507 U.S. 410 (1993) 25

Columbia Mill Co. v. *Alcorn*,
150 U.S. 460 (1893) 8

Del. & Hudson Canal Co. v. *Clark*,
80 U.S. 311 (1871) 8

Edenfield v. *Fane*,
507 U.S. 761 (1993) 18, 22

Estate of P.D. Beckwith, Inc. v.
Comm'r of Patents,
252 U.S. 538 (1920) 8

Faragher v. *City of Boca Raton*,
524 U.S. 775 (1998) 19

Fla. Bar v. *Went For It, Inc.*,
515 U.S. 618 (1995) 22, 26

TABLE OF AUTHORITIES—continued

Page(s)

Friedman v. *Rogers*,
440 U.S. 1 (1979) ..... *passim*

In re Geller,
751 F.3d 1355 (Fed. Cir. 2014) 26

Grutter v. *Bollinger*,
539 U.S. 306 (2003) 21

Hanover Star Milling Co. v. *Metcalf*,
240 U.S. 403 (1916) 8

Harris v. *Forklift Sys., Inc.*,
510 U.S. 17 (1993) 19

Harris v. *Quinn*,
134 S. Ct. 2618 (2014) 12

Heart of Atlanta Motel, Inc. v. *United States*,
379 U.S. 241 (1964) 19

Katzenbach v. *McClung*,
379 U.S. 294 (1964) 19

KP Permanent Make-Up, Inc. v.
Lasting Impression I, Inc.,
543 U.S. 111 (2004) 11

In re Lebanese Arak Corp.,
94 U.S.P.Q.2d 1215 (T.T.A.B. 2010) 26

Lorillard Tobacco Co. v. *Reilly*,
533 U.S. 525 (2001) ..... *passim*

Manhattan Med. Co. v. *Wood*,
108 U.S. 218 (1883) 8

Mattel, Inc. v. *MCA Records, Inc.*,
296 F.3d 894 (9th Cir. 2002) 11, 14, 16

TABLE OF AUTHORITIES—continued

Page(s)

New Kids on the Block v. *News Am. Publ'g, Inc.*, 971 F.2d 302 (9th Cir. 1992) 11

Ohralik v. *Ohio State Bar Ass'n*, 436 U.S. 447 (1978) 16, 20, 22

Posadas de P.R. Assocs. v. *Tourism Co. of P.R.*, 478 U.S. 328 (1986) 22

Pro-Football, Inc. v. *Blackhorse*, No. 15-1874 (4th Cir. 2016) 28, 29, 35

Radiance Found., Inc. v. *NAACP*, 786 F.3d 316 (4th Cir. 2015) 11, 16

Riley v. *Nat'l Fed'n of the Blind of N.C., Inc.*, 487 U.S. 781 (1988) 15

Rogers v. *Grimaldi*, 875 F.2d 994 (2d Cir. 1989) 15

Rubin v. *Coors Brewing Co.*, 514 U.S. 476 (1995) 22

S.F. Arts & Athletics, Inc. v. *U.S. Olympic Comm.*, 483 U.S. 522 (1987) 8, 12, 14, 27

Smith v. *Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302 (N.D. Ga. 2008) 16

Two Pesos, Inc. v. *Taco Cabana, Inc.*, 505 U.S. 763 (1992) 10

In re Tam, 808 F.3d 1321 (Fed. Cir. 2015) 26

TABLE OF AUTHORITIES—continued

Page(s)

Statutes

15 U.S.C.
§ 1051 ..... 4, 9
§ 1058 9
§ 1114 ..... 4, 10, 11, 16
§ 1115 4
§ 1125 ..... 10, 11, 16, 26
§ 1127 9

42 U.S.C.
§ 2000a(a) 19
§ 2000e-3(b) 19
§ 3604(a) 19
§ 3604(c) 19

Civil Rights Act of 1964 ..... 4, 19

Other Authorities

6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:139.25 (4th ed. 2016) 13

Justin W. Angle et al., *Activating Stereotypes with Brand Imagery: The Role of Viewer Political Identity*, 26 J. Consumer Psychol. (forthcoming 2016) 23

John Chaney et al., *Do American Indian Mascots = American Indian People? Examining Implicit Bias Towards American Indian People and American Indian Mascots*, 18 Am. Indian & Alaska Native Mental Health Res. 42 (2011) 32

TABLE OF AUTHORITIES—continued

Page(s)

Christian S. Crandall & Amy Eshleman, *A Justification-Suppression Model of the Expression and Experience of Prejudice*, Psychol. Bull. 414 (2003) 24

Stephen Fishman, *Copyright and the Public Domain* § 12.02 (2016) 6

Thomas E. Ford et al., *Not All Groups Are Equal: Differential Vulnerability of Social Groups to the Prejudice-Releasing Effects of Disparagement Humor*, 17 Group Processes & Intergroup Rel. 178 (2013) 24

Stephanie A. Fryberg et al., *Of Warrior Chiefs and Indian Princesses: The Psychological Consequences of American Indian Mascots*, 30 Basic & Applied Soc. Psychol. 208 (2008) 31

David C. Hilliard et al., *Trademarks and Unfair Competition Deskbook* § 8.02 (2015) 7

H.R. Rep. No. 104-374 (1995) 14

Jamie Jaramillo et al., *Ethnic Identity, Stereotype Threat, and Perceived Discrimination Among Native American Adolescents*, J. Res. on Adolescence (2015) 33

Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. Rev. 960 (1993) 13

Anne Gilson LaLonde, Gilson on Trademarks § 1.03 (2016) 7

TABLE OF AUTHORITIES—continued

Page(s)

Robert Longwell-Grice & Hope Longwell-Grice, *Chiefs, Braves, and Tomahawks: The Use of American Indians as University Mascots*, 40 NASPA J. 1 (2003).....23

Nat'l Congress Am. Indians, *Ending the Legacy of Racism in Sports & the Era of Harmful "Indian" Sports Mascots* (2013).....31, 32, 33, 35

Cornel D. Pewewardy, *Playing Indian at Halftime: The Controversy over American Indian Mascots, Logos, and Nicknames in School-Related Events*, 77 Clearing House 180 (2004) 30

S. Rep. No. 79-1333 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274 .....9, 10

Toni Schmader, Michael Johns & Chad Forbes, *An Integrated Process Model of Stereotype Threat Effects on Performance*, 115 Psychol. Rev. 336 (2008).....23

Claude M. Steele, *A Threat in the Air: How Stereotypes Shape Intellectual Identity and Performance*, 52 Am. Psychol. 613 (1997).....23

Erik Stegman & Victoria Phillips, *Missing the Point: The Real Impact of Native Mascots and Team Names on American Indian and Alaska Native Youth*, Ctr. for Am. Progress (2014).....32, 34

TABLE OF AUTHORITIES—continued

Page(s)

Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, Notre Dame L. Rev. (forthcoming 2016) 6, 14

INTEREST OF *AMICI CURIAE*[1]

Amici have a long history of involvement in cultural, economic, educational, health, policy, and social justice issues affecting the Native American nations and tribes, and their citizenry. As a result, they speak authoritatively about the harm caused by racially based "Indian" names and their belief that the "REDSKINS" marks are disparaging to all Native Americans, subjecting them to ridicule, contempt, and disrepute.

Although *amici* support the government in this case, they take a balanced approach to trademark law as a general matter. Several *amici* themselves own valuable trademarks, which some *amici* assert in litigation when infringed. *Amici* thus recognize the importance of robust trademark protection, but they nonetheless believe that the government may regulate disparaging marks.

Amicus National Congress of American Indians ("NCAI") was established in 1944 and is the oldest, largest, and most representative national intertribal organization. It represents over 250 tribes, nations, pueblos, and Alaska Native villages with a combined enrollment of over 1.2 million. NCAI promotes the enhanced quality of life of Native people and strives to educate the general public regarding Native people and their rights. NCAI represents its individual and tribal members on a variety of political, cultural,

---

[1] Pursuant to Rule 37.6, *amici* affirm that no counsel for a party authored this brief in whole or in part and that no person other than *amici* or their counsel made a monetary contribution to its preparation or submission. The parties' letters consenting to the filing of *amicus* briefs have been filed with the Clerk's office.

and social policy issues. NCAI has historically opposed the use of a racially disparaging term as a mascot. NCAI has held this position since before its leaderhip met with the president of the Washington team in 1972, and it continues to stand in opposition to the term today.

Amicus the Cherokee Nation, with 345,193 enrolled citizens, is the largest federally recognized Indian tribe in the United States. Cherokee citizens reside within the Tribe's 14-county jurisdictional area in Northeastern Oklahoma and throughout the 50 states. The Cherokee Nation is committed to eradicating the use of disparaging Native American names and imagery and reducing their negative impact on all Native Americans, but particularly, on Indian children.

Amicus the Navajo Nation is the largest Indian nation by land holdings with over 17 million acres of largely contiguous land in New Mexico, Arizona, and Utah. The Nation is larger than ten of the states and is roughly the size of West Virginia and twice the size of Massachusetts. The Nation has over 300,000 enrolled citizens. The Nation is a sovereign with two ratified treaties with the United States, entered into in 1850 and 1868.

Amicus the Yocha Dehe Wintun Nation is a federally-recognized sovereign tribal government located in Northern California. Yocha Dehe has taken a lead role in the nationwide "Change the Mascot" campaign to combat racist trademarks offensive to and demeaning of Native American people. In 2014, Yocha Dehe paid to run the "Proud to Be" commercial during the NBA Finals, raising awareness about, and protesting, the racist name of the National Football League's Washington team. On a local level, the

Tribe has worked with local school districts to change disparaging names and mascots.

Amicus the Morning Star Institute, founded in 1984, is a national, nonprofit Indigenous rights organization based in Washington, D.C. and devoted to traditional and cultural advocacy, arts promotion, and research. It is governed by a national Board of Directors who are tribal, traditional, cultural rights, and arts leaders. It leads in the areas of Native Peoples' religious freedom and repatriation, protection of sacred lands and cultural property rights, and in campaigns to eliminate stereotyping of Native Peoples in popular culture. Through its Just Good Sports project, Morning Star assists schools, students, and families who are addressing race-based names and imagery in their local athletic programs.

INTRODUCTION AND SUMMARY OF ARGUMENT

Amici fully support the position advanced by the government in this case—including its arguments that Section 2(a) is not a restriction on speech rights at all, that trademark registration functions as a subsidy that the government may regulate, and that maintenance of trademark registration is government speech.

Amici, however, focus on an additional argument that independently supports the constitutionality of Section 2(a). Trademarks are necessarily instruments of commercial speech, and Section 2(a) is a permissible regulation of commercial speech.

I. Trademarks are inherently commercial in character. Trademarks exist solely in relationship to goods or services in commerce; indeed, the Lanham Act limits trademarks to those marks that have in

fact been or will be "used in commerce." 15 U.S.C. § 1051. And trademarks are enforceable only when another uses an infringing mark in commerce. 15 U.S.C. § 1114. Noncommercial uses, including uses that are expressive, do not infringe the trademark monopoly. 15 U.S.C. § 1115.

Because trademarks are inherently commercial, trademark regulation is premised on permissible government regulation of commercial speech. Indeed, the commercial speech doctrine *must* be the doctrinal underpinning of the trademark regime, as a trademark provides a monopoly over certain speech rights to the mark owner—the result of which is to suppress the speech rights of the public at large. Trademarks can function as instruments of speech-suppression precisely because they regulate commercial speech.

II. Section 2(a) satisfies the *Central Hudson* standards for regulation of commercial speech. The government has a significant interest in the orderly flow of commerce, which includes elimination of disparaging and racist barriers to commerce. The Civil Rights Act of 1964, for example, includes significant speech limitations that are supported by these governmental interests. Title VII restricts employment advertisements that indicate racial preferences. Likewise, the Fair Housing Act bars discrimination in real estate advertising. Section 2(a) advances the government's well-established interests in preventing racially disparaging trademarks in commerce.

Likewise, the government has a significant interest in privacy and social welfare. Trademarks are intractably tied to advertising, as the purpose of a mark is to provide recognition to consumers. The government has a longstanding interest in regulat-

ing such commercial speech for the privacy and welfare of the public.

Section 2(a), moreover, provides a "reasonable fit" between these interests and the regulatory scheme. It is applied on a case-by-case basis that assesses the effect a trademark will have on commerce. Additionally, Section 2(a) does not bar use of a trademark in the whole; instead, it merely withholds certain federal benefits. Finally, those regulated have near limitless alternative options that may be used to advertise products and services.

III. The longstanding use of derogatory Native American imagery confirms the governmental interests at stake. The adoption of racial names by sports teams is an especially pernicious form of derogatory trademark that warrants regulation. Abundant social science research demonstrates that the use of Native American words as sports mascots demean and dehumanize. They create harmful stereotypes. And these uses have outsized effects on Native American youth. For these reasons, Native American organizations have broadly condemned the use of such sports mascots—especially use of the slur "REDSKINS."

ARGUMENT

I. Section 2(a) Regulates Commercial Speech.

A. Trademarks are inherently commercial in character.

When a speaker uses a trademark, he or she is engaging in a form of speech. But it is, by definition, a particular and limited form of expression: it is speech that is commercial in character. In fact, trademarks are inherently a creature of commerce.

From their initial emergence to the present day, trademarks have served commercial purposes as source identifiers, mechanisms of quality assurance and accountability, and have aided in consumer choice. The Lanham Act defines trademarks in relation to commerce, stipulates that prospective registrants demonstrate a mark's use in commerce to qualify for registration, and confers exclusively commercial rights upon the mark-holder. Thus, the purpose of a trademark is to advance the economic interests of the mark-holder, reference a specific service or product, and serve to advertise, propose, or otherwise aid in commercial transactions—thereby constituting commercial speech.

Indeed, a trademark "grants one private entity the right to suppress others' commercial speech." Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, Notre Dame L. Rev. (forthcoming 2016) (manuscript at 2) (on file with author). Because the very purpose of a trademark is to supply the mark-holder a lawful monopoly on *speech*—the effect of which is to stifle speech of third parties—the trademark system *must* be premised on a permissible regulation of commercial speech.

Judge Reyna observed in dissent that "[w]hatever standard of scrutiny protects" the content of a trademark, "that same standard must necessarily be overcome by the government's substantial interest in the orderly flow of commerce, or no trademark could issue." Pet. App. 113a. One treatise has likewise explained that "the Lanham Act is constitutional because it regulates only commercial speech, which is entitled to reduced protections under the First Amendment." Stephen Fishman, *Copy-*

right and the Public Domain § 12.02 (2016). See also David C. Hilliard et al., *Trademarks and Unfair Competition Deskbook* § 8.02 (2015) ("Commercial speech * * * includes trademarks").

Put differently, "if the expressive *content* of the mark precludes regulation, on what authority may the government grant Mr. Tam the exclusive right to use this mark in commerce?" Pet. App. 112a-113a (Reyna, J., dissenting). Since the purpose of a trademark is to limit the speech rights of the public at large, it follows that the trademark system rests on principles of commercial speech.

1. Throughout history, trademarks have served as instruments of commerce.

Historically, trademarks have served a variety of purposes—but those purposes have all been connected by the unifying thread of commerce. Trademarks serve the objectives of "denot[ing] a particular standard of quality embodied in the product or service, symboliz[ing] the good will of its owner, and represent[ing] an advertising investment;" "protect[ing] the public from confusion and deception[;] and mak[ing] it easier for consumers to choose the products and services they want." Anne Gilson LaLonde, Gilson on Trademarks § 1.03 (2016).

One of the oldest forms of trademark was the "production" mark, whereby medieval craftsmen labeled their products with an identifying personal mark such that defective products could be traced back to their producer. *Ibid.* The production mark served as an accountability mechanism, punishing producers of defective products and helping guilds maintain high standards of production and craftsmanship. *Ibid.* In addition, the production mark

identified goods that originated from craftsmen outside the guild, helping guilds exclude outsiders and protect their local monopolies. *Ibid.*

As American commerce grew less localized and less relationship-based, the function of trademarks expanded—now with a focus on quality assurance. *Ibid.* Merchants began to use trademarks on goods they did not personally produce, signifying that the associated goods met quality standards and carried the mark-holder's reputation behind them. *Ibid.*

This Court has long recognized the commercial nature of trademarks. In the nineteenth and early twentieth centuries, the Court consistently described the purpose of trademarks as identifying for consumers the "origin or ownership" of the product with which the mark was associated. See *Estate of P.D. Beckwith, Inc.* v. *Comm'r of Patents*, 252 U.S. 538, 543 (1920); *Hanover Star Milling Co.* v. *Metcalf*, 240 U.S. 403, 412 (1916); *Columbia Mill Co.* v. *Alcorn*, 150 U.S. 460, 463 (1893); *Manhattan Med. Co.* v. *Wood*, 108 U.S. 218, 223 (1883); *Amoskeag Mfg. Co.* v. *D. Trainer & Sons*, 101 U.S. 51, 54 (1879); *Del. & Hudson Canal Co.* v. *Clark*, 80 U.S. 311, 323 (1871). And since then, the Court has continued to acknowledge trademarks' intrinsically commercial character, noting their "strictly business" purpose. *Friedman* v. *Rogers*, 440 U.S. 1, 11 (1979). See also *S.F. Arts & Athletics, Inc.* v. *U.S. Olympic Comm.*, 483 U.S. 522, 535-536 (1987).

2. The Lanham Act defines and regulates trademarks solely as instruments of commerce.

The Lanham Act incorporates this commercial understanding of trademark, defining it in terms of

commercial use and purpose. The Act's definition specifies that a trademark must be used or intended to be used in commerce for the commercial functions of identifying, distinguishing, and indicating the source of the mark-holder's goods. 15 U.S.C. § 1127. Accordingly, registered trademarks exist for, and are defined by, their commercial use.

In particular, the Lanham Act ties trademark registration and renewal to the use of the mark in commerce. The Act stipulates that "[t]he owner of a trademark *used in commerce* may request registration of its trademark." 15 U.S.C. § 1051 (emphasis added). The Act also requires that a trademark application specify "the date of the applicant's first *use of the mark in commerce*, the *goods in connection with which the mark is used*," and that "the mark is *in use in commerce*." *Ibid.* (emphasis added). Finally, to renew a trademark, the owner must "state that the mark is *in use in commerce*," "set forth the *goods and services recited in the registration on or in connection with which the mark is in use in commerce*," and "be accompanied by [evidence] showing *current use of the mark in commerce* as may be required." 15 U.S.C. § 1058 (emphasis added). At each step in the registration process—whether to qualify for registration, to complete a trademark application, or to renew a trademark—the mark-holder must demonstrate the nexus between the trademark and commerce.

The Lanham Act's background and history confirms that its protections are directed at trademarks used for commercial purposes. In passing the Act, the Senate specified that the Act would serve "[t]o provide for the registration and protection of trademarks *used in commerce*." S. Rep. No. 79-1333, at 1

(1946) (emphasis added), *reprinted in* 1946 U.S.C.C.A.N. 1274. The Senate declared that two purposes motivated the enactment of the Lanham Act:

> One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats.

Two Pesos, Inc. v. *Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (Stevens, J., concurring) (quoting S. Rep. No. 79-1333, at 3). Each of these stated purposes is inextricably bound up with a commercial goal.

3. Noncommercial uses are not the proper subject of trademark.

On the other side of the coin, the noncommercial use of a trademarked word, symbol, or device is not protected by the Lanham Act. Congress carefully permitted the fair use of trademarks in descriptive, nominative, and expressive manners.

Trademark protections have force only in the commercial sphere, where they serve important but limited commerce-specific goals. The Lanham Act sets forth two potential trademark infringement offenses, each of which is inherently tied to commerce. Traditional infringement, where an unauthorized user uses another's mark in a misleading manner, is prohibited. 15 U.S.C. §§ 1114, 1125(a). Similarly, the Act allows commerce-bound claims for dilution,

where an unauthorized use may diminish the uniqueness of a famous mark. 15 U.S.C. § 1125(c). Both traditional infringement and dilution offenses exempt noncommercial uses from liability. 15 U.S.C. §§ 1114(3), 1125(c)(3).

Noncommercial uses, such as parody, commentary, and artistic expression, can be exempted because they present only slight risks of consumer confusion as to a good's source; they are "non-trademark use[s] of a mark." *New Kids on the Block* v. *News Am. Publ'g, Inc.*, 971 F.2d 302, 307 (9th Cir. 1992). They may create some confusion as to the political or social position of the mark-holder, but they are typically do not create "confusion as to source, sponsorship, or affiliation." *Radiance Found., Inc.* v. *NAACP*, 786 F.3d 316, 329 (4th Cir. 2015).

Even if noncommercial uses pose some threat of confusion, the public interest in free expression mitigates against application of trademark rights to noncommercial uses. Thus, the law provides for good-faith "fair use[s]" of a trademarked term or symbol to describe (*KP Permanent Make-Up, Inc.* v. *Lasting Impression I, Inc.*, 543 U.S. 111, 118 (2004)), or to identify the mark-holder's product for comparative purposes (*New Kids on the Block*, 971 F.2d at 307-308).

In other instances, a trademark may assume a meaning of its own, making it difficult for a member of the public to express themselves without reference to a trademarked term. See *Mattel, Inc.* v. *MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002). "Once imbued with such expressive value," trademarks may "transcend their [commercial] identifying purpose," "becom[ing] a word in our language and assum[ing] a role outside the bounds of trademark

law." *Ibid.* When a mark becomes genericized, it loses its secondary meaning and thus is generally no longer enforceable as a matter of trademark law.

For all of these reasons, trademarks have no effect as to noncommercial and expressive speech.

B. Trademarks are commercial speech.

Against this background, a speaker's use of a federally registered trademark involves a form of commercial speech. In fact, this Court already has said as much: in *Friedman*, the Court recognized that "[t]he use of trade names in connection with optometrical practice * * * is a form of commercial speech and nothing more." 440 U.S. at 11. The Court subsequently agreed in *San Francisco Arts & Athletics* that the SFAA's use of the term "Olympic" for its sporting event was commercial speech, such that limits on the speech imposed only "incidental restrictions on First Amendment freedoms." 483 U.S. at 536-537. And the point is confirmed by looking to the particulars of the Court's commercial speech inquiry.

The Court has set forth two principal tests for determining whether expression constitutes commercial speech. First, under the baseline definition, speech is commercial if it "does no more than propose a commercial transaction." *Harris* v. *Quinn*, 134 S. Ct. 2618, 2639 (2014) (citation omitted). Second, for expression that goes beyond this baseline definition, speech will nonetheless be deemed commercial in character where it (1) was an advertisement, (2) referenced a specific product, and (3) stemmed from economic motivations. *Bolger* v. *Youngs Drug Prods. Corp.*, 463 U.S. 60, 66-67 (1983). While no single factor is dispositive, the combination of all three ren-

ders speech commercial even where it "contain[ed] discussions of important public issues." *Id.* at 67-68.

1. In all cases, trademarks are properly regulated as commercial speech.

Trademarks are inextricably connected to the commercial context and, under the governing tests, fall within the definition of commercial speech. The point is not novel. "[A] firm's trademark is perhaps the most important element of commercial speech which is communicated to customers, [and] [a]ll other elements of advertising revolve around, relate to, and are symbolized by the trademark." 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:139.25 (4th ed. 2016). Indeed, without a trademark to reliably associate a product with its source, sellers would be unable to accrue the benefits of advertising.

Trademarks, by definition, reference a specific service or product. They are, by definition, bound up in the economic interests of the mark-holder and, also by definition, confer purely commercial rights. And trademarks serve to advertise, propose, or otherwise aid in a commercial transaction. Or, as Judge Kozinski put it, "[w]hatever First Amendment rights you may have in calling the brew you make in your bathtub 'Pepsi' are easily outweighed by the buyers' interest in not being fooled into buying it." Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. Rev. 960, 973 (1993). Given their historical and contemporary function as well as the Lanham Act's text, purpose, and application, trademarks are properly considered commercial speech.

This remains true even when a trademark is used by one engaged in what is typically viewed as

core First Amendment speech. Thus, "nonprofits and noncommercial speakers in the First Amendment sense such as the *New York Times* can own trademarks" because the Lanham Act only governs the "function of the trademark"—which is "to identify them as sources of goods or services in commerce." Tushnet, *supra*, at 23. This is because "the trademark function can be separated from the other communicative functions of a symbol," and "what is communicated by the trademark function * * * is the only thing trademark law regulates: this is who I am/this is my source." *Id.* at 15. At bottom, "denying trademark rights regulates *only* the commercial aspects of the speaker's message." *Ibid.*

Moreover, as Justice Brennan observed, "[t]rademark protection has been carefully confined to the realm of commercial speech by * * * important limitations in the Lanham Act." *S.F. Arts & Athletics*, 483 U.S. at 564 (Brennan, J., dissenting). The Act "limits the impact of trademarks on noncommercial speech [by way of] the rule that a trademark violation occurs only when an offending trademark is applied to *commercial* goods and services." *Id.* at 566. Thus, Congress "relied on the 'noncommercial use' exemption to allay First Amendment concerns," (*Mattel*, 296 F.3d at 906), "expressly incorporat[ing] the concept of 'commercial' speech from the 'commercial speech' doctrine" and seeking to avoid the extension of trademark restrictions to "'noncommercial' expression, as that term has been defined by the courts" (H.R. Rep. No. 104-374, at 4, 8 (1995)). Conscious of the First Amendment, Congress applied the Lanham Act only to commercial speech, immunizing noncommercial uses from trademark enforcement.

Case law in lower courts applying the Lanham Act has respected the balance that Congress struck between commercial interests and free expression. "Because overextension of Lanham Act restrictions * * * might intrude on First Amendment values," lower courts have adopted a balancing test for enforcing trademark protections against noncommercial uses. *Rogers* v. *Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989). This test generally "insulates from restriction [any mark] with at least minimal [expressive] relevance." *Id.* at 1000. An expressive use will be prohibited by the Lanham Act only if that use is "explicitly misleading as to source or content, or that [has] no [expressive] relevance at all." *Ibid.* Thus, the Lanham Act only excludes unauthorized commercial uses of a mark—*i.e.*, commercial speech.

2. *Alternatively, only trademarks whose commercial component is "inextricably intertwined" with an expressive component are noncommercial speech.*

If, contrary to our principal submission, trademarks embody any component of core First Amendment speech, the Court should extend that protection to only the limited subset of marks whose expressive aspect is "inextricably intertwined" with the commercial component. See *Riley* v. *Nat'l Fed'n of the Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988).

Even if some marks "have an expressive component, it would seem beyond debate that many do not." Pet. App. 89a (Dyk, J., dissenting). That is certainly "the case with respect to routine product identifiers." *Ibid.* When a manufacturer assigns an arbitrary or fanciful name to a commercial product—*e.g.*, "PEPSI" to a soda or "DOMINOS" to a pizza—the trademark acts in solely a commercial speech capaci-

ty. Such marks do not seek to "editorialize" or make "generalized observations" about social matters. *Friedman*, 440 U.S. at 11.

This rests on a "'common-sense' distinction" between marks that are expressive from those that are purely commercial. *Ohralik* v. *Ohio State Bar Ass'n*, 436 U.S. 447, 455-456 (1978). Courts and the Trademark Trial and Appeal Board ("TTAB") are well-eqipped to make this determination; indeed, they often must distinguish between a commercial use of a mark and a noncommercial, expressive use. As we described, noncommercial use of a mark does not constitute infringement. 15 U.S.C. §§ 1114(3), 1125(c)(3). Likewise, courts regularly determine whether use of certain trademarked content is nonactionable as social commentary, artistic work, or parody. See, *e.g.*, *Radiance Found.*, 786 F.3d at 319 (holding use of NAACP mark in the title "NAACP: National Association for the Abortion of Colored People" did not infringe NAACP's trademark); *Mattel*, 296 F.3d at 907 (holding "Barbie Girl" song did not infringe Mattel's BARBIE trademark); *Smith* v. *Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302, 1317 (N.D. Ga. 2008) (holding that t-shirts with various phrases, including "WAL-QAEDA," were parody of Wal-Mart's business tactics and impact on the United States).

Given that trademark law necessitates distinguishing between commercial and noncommercial use of the same content, these same considerations may properly govern the applicable First Amendment framework.

II. The Government's Regulation Of Disparaging Trademarks Satisfies *Central Hudson*.

If the Court agrees that trademarks are commercial speech, the remaining question here is whether a rule that precludes the registration of disparaging trademarks—in particular, those that incorporate racial slurs—is a permissible regulation of that commercial speech. Our submission is that this regulation is constitutionally supportable.

For a regulation of commercial speech to comport with the First Amendment, it must satisfy the four-prong test of *Central Hudson*, which asks: (1) whether the speech at issue "concern[s] lawful activity and [is not] misleading"; (2) whether "the asserted governmental interest is substantial"; (3) "whether the regulation directly advances the governmental interest asserted"; and (4) whether the regulation "is not more extensive than is necessary to serve that interest." *Cent. Hudson Gas & Elec. Corp.* v. *Pub. Serv. Comm'n*, 447 U.S. 557, 566 (1980).

A. Section 2(a) directly advances substantial governmental interests in limiting disparaging speech in commercial contexts.

The government satisfies the second prong of *Central Hudson* because its "asserted governmental interest[s]" in regulating disparaging trademarks are "substantial." 447 U.S. at 566. The government has two substantial interests underlying Section 2(a): (1) ensuring the orderly flow of commerce; and (2)

combatting discrimination in order to protect the privacy and welfare of its citizens.[2]

And Section 2(a) satisfies the third prong of *Central Hudson* because it "directly advances th[ose] governmental interest[s]." *Ibid.* This third prong "concerns the relationship between the harm that underlies the State's interest and the means identified by the State to advance that interest." *Lorillard Tobacco Co.* v. *Reilly*, 533 U.S. 525, 555 (2001). To satisfy this element of the test, the government must demonstrate: (1) "that the harms it recites are real," and (2) that "its restriction will in fact alleviate them to a material degree." *Ibid.* (quoting *Edenfield* v. *Fane*, 507 U.S. 761, 770-771 (1993)). Anecdotal, psychological, and historical evidence—as well as jurisprudential consensus and common sense—illustrate that the harms underlying the government's interests are real, and that Section 2(a) directly and materially combats those harms.

1. The orderly flow of commerce.

a. The government undoubtedly has a substantial interest in preventing disparagement in advertising to ensure the ordely free flow of commerce: disparaging trademarks "undermine[] commercial activity and the stability of the marketplace in much the same manner as discriminatory conduct." Pet. App. 117a (Reyna, J., dissenting). This Court has recognized in the context of public accommodations,

---

[2] Some applications of Section 2(a) may also satisfy the first prong of *Central Hudson*, because disparaging trademarks may well involve "false, deceptive, or misleading sales techniques." *Bolger*, 463 U.S. at 69. For example, the team name "WASHINGTON REDSKINS" may deceive the public by implying a false relationship with or approval by Native people.

housing, and employment law that discriminatory conduct—including speech—disrupts commerce.

The Civil Rights Act of 1964 was intended to resolve "what the Congress found to be a national commercial problem of the first magnitude." *Katzenbach* v. *McClung*, 379 U.S. 294, 305 (1964). Under the public accommodations title of the Civil Rights Act of 1964, the speech of public-serving businesses and their employees is regulated to prevent disparagement of customers "on the ground of race, color, religion, or national origin." 42 U.S.C. § 2000a(a). In upholding the constitutionality of this statute, the Court acknowledged the overwhelming "evidence of the burdens that discrimination by race or color places upon interstate commerce." *Heart of Atlanta Motel, Inc.* v. *United States*, 379 U.S. 241, 252 (1964).

Other provisions of the civil rights act were similarly addressed to the "national commercial problem" of discriminatory conduct and speech. Title VII prohibits racially and sexually disparaging speech in the workplace to the extent such speech harasses the disparaged person, or creates a hostile work environment. See, *e.g.*, *Faragher* v. *City of Boca Raton*, 524 U.S. 775, 787-788 (1998); *Harris* v. *Forklift Sys., Inc.*, 510 U.S. 17 (1993). Title VII also restricts employers from advertising employment opportunities in a manner "indicating any preference, limitation, specification, or discrimination, based on race, color, religion, sex, or national origin." 42 U.S.C. § 2000e-3(b). Similarly, the Fair Housing Act prohibits both discrimination in the sale or rental of housing (42 U.S.C. § 3604(a)) and discrimination in the advertisement of housing (42 U.S.C. § 3604(c)).

The conclusion that the government has an interest in avoiding the disruption of commerce that would follow from the use of disparaging trademarks therefore is not "based on mere speculation," but rather follows from this Court's precedent. *Lorillard Tobacco*, 533 U.S. at 561 (quotations omitted). As such, this interest in ensuring efficient commerce is closely aligned with other substantial interests the Court has recognized in considering the regulation of commercial speech. See, *e.g.*, *Central Hudson*, 447 U.S. at 569 ("The State's concern that rates be fair and efficient represents a clear and substantial governmental interest."); *Ohralik*, 436 U.S. at 460 (noting that states have a "general interest in protecting consumers and regulating commercial transactions"). Therefore, this interest clearly satisfies the second prong of *Central Hudson*.

b. In addition to targeting the real harms of disparagement in advertising, the government advances its interest in a direct and material way through Section 2(a). By refusing to register disparaging trademarks, the government disincentivizes use of such marks in interstate commerce. Because Congress could reasonably conclude that commercial actors are more likely to choose marks for which the advantages of federal registration are available through Section 2(a), it is encouraging the selection of non-disparaging marks. When non-disparaging marks are selected over disparaging marks, disruption to the orderly flow of commerce is averted.

This effect satisfies the third prong of the *Central Hudson* test as presented in *Lorillard Tobacco Co.* In that case, the government argued that by regulating the outdoor advertising of smokeless tobacco and cigars near schools and playgrounds, it would reduce

the youth demand for these products. 533 U.S. at 556-561. The Court agreed, noting that it has previously "acknowledged the theory that product advertising stimulates demand for products, while suppressed advertising may have the opposite effect." *Id.* at 557. The same common-sense logic applies to trademarks and harmful stereotypes: disincentivizing harmful stereotypes in trademarks will suppress the use of these stereotypes in society and their concurrent harms to commerce.

2. Privacy and welfare.

a. Declining to register disparaging trademarks also advances a discrete but related interest: encouraging racial tolerance and protecting the privacy and welfare of individuals. The government unquestionably has a substantial interest in combatting racial discrimination and promoting racial tolerance. The Court has found this interest to be substantial in multiple contexts. In *Bob Jones University*, the Court upheld the government's denial of tax benefits to a religious university that engaged in racial discrimination, citing the government's "fundamental, overriding interest" in "denying public support to racial discrimination in education." *Bob Jones Univ.* v. *United States*, 461 U.S. 574, 604 & n.29 (1983). See also *Grutter* v. *Bollinger*, 539 U.S. 306, 330 (2003) (recognizing a compelling interest in the "educational benefits" of diversity, including "cross-racial understanding, [which] helps to break down racial stereotypes" (internal quotation marks omitted)). This interest in racial tolerance is analogous to interests that have been deemed compelling for the purpose of strict scrutiny; necessarily, then, it qualifies as "substantial" for the purposes of *Central Hudson*.

Incorporated within this interest in combatting discrimination is the government's concern for the privacy and welfare of residents. These concerns are closely aligned with interests the Court has previously found to be substantial for the purposes of regulating commercial speech, such as those at stake in protecting the privacy and tranquility of residents from intrusions by advertising. See, *e.g.*, *Fla. Bar* v. *Went For It, Inc.*, 515 U.S. 618, 624-625 (1995); *Edenfield* v. *Fane*, 507 U.S. 761, 769 (1993); *Ohralik*, 436 U.S. at 461-462.

The Court has also recognized the broad prerogative of states to protect the welfare of their residents. See, *e.g.*, *Lorillard Tobacco*, 533 U.S. at 555 (protecting minors from harms of tobacco use); *Rubin* v. *Coors Brewing Co.*, 514 U.S. 476, 485 (1995) (protecting welfare of citizens from "alcoholism and its attendant social costs"); *Bd. of Trs. of the State Univ. of N.Y.* v. *Fox*, 492 U.S. 469, 475 (1989) (protecting students from "commercial exploitation" and intrusions on "residential tranquility"); *Posadas de P.R. Assocs.* v. *Tourism Co. of P.R.*, 478 U.S. 328, 341 (1986) (protecting citizens from harms of "casino gambling"). The Court's acceptance of these analogous governmental interests in protecting the privacy and welfare of citizens demonstrates that the government's interests in this case are sufficiently "substantial" to satisfy *Central Hudson*.

That interest is very much at stake in this case: combatting discrimination and fostering tolerance seeks to prevent "concrete, nonspeculative harm[s]" within the meaning of *Central Hudson*. *Went For It*, 515 U.S. at 629. Psychological and sociological evidence demonstrate that disparagement in advertising is detrimental to the welfare of the disparaged

group. Disparagement demeans, dehumanizes, and undercuts the dignity of the targeted group; normalizes racial discrimination and ingrains racial stereotypes in American commerce and society; spreads misinformation about disparaged individuals; and damages their self-esteem and mental health.

For example, the use of racial epithets in the trademark context may induce members of the targeted group to conform with stereotypes, including stereotypes they do not consciously accept. This concept, called stereotype threat, is a heavily-researched phenomenon within psychology. Claude M. Steele, *A Threat in the Air: How Stereotypes Shape Intellectual Identity and Performance*, 52 Am. Psychol. 613 (1997). Psychological studies have revealed a negative relationship between stereotype salience and academic outcomes for adolescent members of minority groups. Toni Schmader, Michael Johns & Chad Forbes, *An Integrated Process Model of Stereotype Threat Effects on Performance*, 115 Psychol. Rev. 336 (2008). Members of minority groups tend to internalize the stereotypes in which they have been steeped. Such stereotypes lessen minority youth's conceptions of self-efficacy, and, when primed, these stereotypes become a self-fulfilling prophecy.

Furthermore, the use of disparaging slurs in commercial advertising normalizes racial discrimination and ingrains racial stereotypes in American commerce and society at large. Racialized mascots reinforce stereotypes and set forth a simplistic, distorted version of that community and culture. See Robert Longwell-Grice & Hope Longwell-Grice, *Chiefs, Braves, and Tomahawks: The Use of American Indians as University Mascots*, 40 NASPA J. 1, 9 (2003); Justin W. Angle et al., *Activating Stereotypes*

with Brand Imagery: The Role of Viewer Political Identity, 26 J. Consumer Psychol. (forthcoming 2016).

Disparaging trademarks also serve a modeling function and send a message that it is acceptable to discriminate against the targeted group. Responding to societal pressures, many prejudiced people would otherwise suppress their prejudice and restrain themselves from acting, at least explicitly, in a discriminatory fashion that aligns with their biases. Christian S. Crandall & Amy Eshleman, *A Justification-Suppression Model of the Expression and Experience of Prejudice*, 129 Psychol. Bull. 414, 416-417, 421 (2003). Racially disparaging trademarks, however, communicate societal approval of discrimination against and disparagement of that group, therefore serving as "releasers" of that otherwise-suppressed prejudice. Thomas E. Ford et al., *Not All Groups Are Equal: Differential Vulnerability of Social Groups to the Prejudice-Releasing Effects of Disparagement Humor*, 17 Group Processes & Intergroup Rel. 178, 179 (2013). As such, racial epithets in trademarks fuel the verbal and physical harassment of the targeted group. These harms—including stereotype threat and normalizing the prejudice and harassment—are real and not speculative, as required by the third prong of *Central Hudson*.

b. Section 2(a) directly and materially addresses the government's anti-discrimination interest by the same means it advances the commerce-protective interest. By disincentivizing the use of disparaging trademarks, it will decrease the prevalence of negative stereotypes in commerce and, in turn, mitigate the various harms suffered by members of disparaged groups and citizens generally.

Furthermore, the government's decision not to register disparaging trademarks is itself directly addressing the harms caused by disparaging slurs in society. By taking a position against harmful stereotypes in disparaging trademarks, the government communicates its own support for the well-being and equality of all citizens. Communicating that the government opposes disparaging speech and supports the well-being of disparaged groups directly combats the harms to their dignity and self-esteem. Cf. *Brown* v. *Bd. of Educ.*, 347 U.S. 483, 494 (1954) (recognizing that "[t]he impact" of discrimination "is greater when it has the sanction of the law"). In doing so, the government signals to others to oppose harmful stereotypes as well, decreasing their overall salience in society.

By materially disincentivizing the selection of disparaging mark and declining to support disparaging slurs, the government directly addresses the harms caused by disparaging stereotypes.

B. Section 2(a) is narrowly tailored.

Finally, the government's regulation of disparaging trademarks satisfies the remaining prong of *Central Hudson* because it is "not more extensive than is necessary." 447 U.S. at 566. This prong "requires a reasonable fit between the means and ends of the regulatory scheme." *Lorillard Tobacco*, 533 U.S. at 561. Ultimately, the structure of the regulation must support the inference that the government "'carefully calculat[ed] the costs and benefits associated with the burden on speech imposed' by the regulations." *Ibid.* (quoting *Cincinnati* v. *Discovery Network, Inc.*, 507 U.S. 410, 417 (1993)). Section 2(a) satisfies this requirement because it is applied on a case-by-case basis, it constitutes a minimal burden on speech, and

the need for it is not outweighed by countervailing First Amendment concerns.

First, the denial of federal registration is not a complete ban on using disparaging trademarks in advertising. Rather, Section 2(a) requires case-specific determinations by the TTAB that a particular mark "may be disparaging to" "a substantial composite of the referenced group." *In re Geller*, 751 F.3d 1355, 1360-1361 (Fed. Cir. 2014) (quoting *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010)). There are not "numerous and obvious less-burdensome alternatives" that weigh against the conclusion that this regulation is narrowly tailored. *Went For It*, 515 U.S. at 633.

Second, Section 2(a) constitutes only a limited, indirect burden on the speech of trademark applicants. Failed applicants can still use their desired mark in commerce without federal registration. States remain free to grant trademark registration to these marks. Section 43(a) of the Lanham Act extends to trademarks that are not registered. Brief of Amicus Curiae International Trademark Association in Support of Neither Party at 10-15, *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (No. 14-1203). See also 15 U.S.C. § 1125(a). These "many alternative channels" left open by the regulation for applicants to use their desired trademark support the conclusion that the regulation properly fits the government's interest. *Went For It*, 515 U.S. at 634. Indeed, this Court in *Friedman* recognized the limited burden on the speaker worked by trademark regulations: "the restriction on the use of trade names has only the most incidental effect on the content of the commercial speech of" the applicant because all the commercial information that can be conveyed by one trade name

through association—identification of service, price, and quality—can be conveyed by another name, or through advertising. 440 U.S. at 15-16.

Third, the substantial government interest in regulating disparaging trademarks outweighs any countervailing First Amendment concerns. To a degree, this narrow tailoring prong of *Central Hudson* incorporates "an analysis of the countervailing First Amendment interests." *Lorillard Tobacco*, 533 U.S. at 564. A State need not "demonstrate that there is no incursion on legitimate speech interests, but a speech regulation cannot unduly impinge on the speaker's ability to propose a commercial transaction and the adult listener's opportunity to obtain information about products." *Id.* at 565. As the Court recognized in *Friedman*, trademark regulation incidentally affects the ability to propose a transaction, and listeners can obtain the information through other means. 440 U.S. at 16. Therefore, the applicant's minor interest in being able to use a disparaging trademark with the imprimatur of the federal government is outweighed by the government's substantial interests in ensuring the orderly flow of commerce and protecting the privacy and welfare of citizens.

In conclusion, "[t]he restrictions of [Section 2(a)] are not broader than Congress reasonably could have determined to be necessary to further [its] interests." *S.F. Arts & Athletics*, 483 U.S. at 539. Section 2(a) is unlike "almost all of the restrictions disallowed under *Central Hudson's* fourth prong [that] have been substantially excessive, disregarding far less restrictive and more precise means." *Fox*, 492 U.S. at 479. Incorporating a case-by-case analysis for application, and imposing only a minor burden on applicant's

speech, the government's regulation of disparaging trademarks is sufficiently narrowly tailored to satisfy the final prong of *Central Hudson*. Therefore, Section 2(a) is a permissible regulation of commercial speech.

III. The Long History Of Trademarks That Disparage Native Americans Confirms That Section 2(a) Is Permissible Regulation.

It bears emphasis that the harms imposed by racially disparaging trademarks are not theoretical or academic; such trademarks cause real and concrete injury. The point is illustrated by examining, as an example, the injuries caused by the use of sports mascots employing racist Native American imagery. That is notably true of one particular racially disparaging trademark: the Washington, D.C. professional football team's use of the trademark "REDSKINS."

Pro-Football first registered the "REDSKINS" mark in 1967, and the Native American community mobilized against the slur's use in a series of publicized events almost immediately thereafter. In 1972, an attorney from *amicus* NCAI sent a letter to the team's president explaining that "Native American" sports imagery "perpetuates stereotypes in which American Indians are seen as participating in scalp taking, war-whooping, and expressing themselves in ungrammatical grunts, ughs and other tontoisms." Brief of Amici Curiae Native American Organizations in Support of Appellees at 21, *Pro-Football, Inc.* v. *Blackhorse*, No. 15-1874 (4th Cir. 2016). "[M]any of the 25 million Americans who watch televised professional football know nothing more about American Indians." *Ibid.*

Later that year, leaders of the Native American community and the team president met to discuss the disparaging mark, and "[a]t the meeting, each of the leaders of the various [Native American] organizations took turns explaining [their] united reason as to why the Washington football team's name should be changed, namely that [they] believe the name to be discriminatory, demeaning, and offensive." *Ibid.* While the team subsequently changed the cheerleaders' costumes to remove the faux Cherokee hair extensions and revised the fight song to remove offensive language like "Scalp 'em, swamp 'em — we will take 'em big score / Read 'em, weep 'em, touchdown! — we want heap more!", the disparaging team name remained. *Id.* at 22.

This use of "REDSKINS"—like other racially disparaging sports mascots—inflicts real injury. These mascots demean and dehumanize the target group; they foster misinformation and inappropriate stereotype; and they hinder development of self-esteem and other preconditions for social success.

First, the use of Native American words and images as sports mascots demeans and dehamunzes—thus entrenching racist attitudes.

To begin with, these mascots preclude society "from understanding the historical and current culture of indigenous people." Longwell-Grice, *supra*, at 9. This is because "[t]he wearing of feathers, buckskin, and war paint all lend themselves to an imagery that degrades Native Americans and their culture and distorts people's perceptions." *Ibid.* Likewise, "[t]he symbols mascots use—tomahawks, spears, war whoops, and headdresses—also are a stereotyped vision of Native Americans as savages." *Ibid.* In these representations, Native Americans are often charac-

terized as primitive, savage, and clownish, and as a people frozen in the past. Cornel D. Pewewardy, *Playing Indian at Halftime: The Controversy over American Indian Mascots, Logos, and Nicknames in School-Related Events*, 77 Clearing House 180, 182-183 (2004).

Because sports mascots are so socially pervasive, these team images "represent the default impression of [American Indian] people for most Americans." John Chaney et al., *Do American Indian Mascots = American Indian People? Examining Implicit Bias Towards American Indian People and American Indian Mascots*, 18 Am. Indian & Alaska Native Mental Health Res. 42, 43 (2011). As a result, "the boundary between *American Indian as human* and *American Indian as mascot* has become blurred in American culture." *Ibid.* The "invented images have become the majority culture's definition of what *being Indian means*." *Ibid.*

Empirical research thus demonstrates that use of Native American mascots entrenches racist attitutudes. The results of the Chaney study showed that, "[d]espite outward claims that [American Indian] mascots reflect honorable representations of [American Indian] people," the "data reveal that non-[American Indian] people tend to evaluate [American Indian] mascots more negatively than Caucasian mascots on an implicit level." *Id.* at 54. For these reasons, "it is difficult to defend the use of [American Indian] mascot images as truly positive, honorable representations of [American Indian] people." *Ibid.*

Second, racially disparaging team mascots spread harmful stereotypes.

"Stereotypes are particularly powerful when the target group * * * is unfamiliar." Stephanie A. Fryberg et al., *Of Warrior Chiefs and Indian Princesses: The Psychological Consequences of American Indian Mascots*, 30 Basic & Applied Soc. Psychol. 208, 209 (2008). And "most Americans have no direct, personal experience with American Indians." *Ibid.* This "relative invisibility * * * is, in part, the result of population size and segregated residential lving." *Ibid.* The consequences are clear—"the views of most Americans about American Indians are formed and fostered by *indirectly* acquired information"—mainly "media representations of American Indians." *Ibid.* For a large number of people, Native Americans may be principally defined by and socially represented in terms of mascot stereotypes.

This is a loss both to Native Americans and to the public as a whole. Native Americans suffer from the ensuing stereotyping, as native sports mascots ply on "[h]armful and negative stereotypes." Nat'l Congress Am. Indians, *Ending the Legacy of Racism in Sports & the Era of Harmful "Indian" Sports Mascots* 5 (2013) ("*Racism in Sports*"). The "'savage' and 'clownish' caricatures used by sports teams with 'Indian' mascots contribute to the 'savage' image of Native peoples and the myth that Native peoples are an ethic group 'frozen in history.'" *Ibid.*

Studies refute the contention from "pro-mascot advocates" who "suggest that American Indian mascots are complimentary and honoroific and should enhance well-being." Fryberg et al., *supra*, at 216. The reason that mascots demean may not stem from an "inherently negative" representation—it is "because, in the contexts in which they appear, there are relatively few alternate characterizations of

American Indians." *Ibid.* Thus, the mascots necessarily communicate stereotypes "to natives and nonnatives alike" as to "how American Indians should look and behave." *Ibid.*

As a result, "rather than honoring Native peoples, these caricatures and stereotypes contribute to a disregard for the personhood of Native peoples." *Racism in Sports*, *supra*, at 5. In sum, studies reveal "that non-[American Indian] people do not perceive a distinct difference between [American Indian] mascot imagery and actual [American Indian] people—they perceive them in a negative light and as essentially interchangeable." Chaney et al., *supra*, at 57.

The public, likewise, loses out on important educational experiences and historical and cultural context. Erik Stegman & Victoria Phillips, *Missing the Point: The Real Impact of Native Mascots and Team Names on American Indian and Alaska Native Youth*, Ctr. for Am. Progress 4 (2014). Stereotypic representations paint Native Americans as a static image, with an outdated and caricatured presentation that makes the non-native public feel like Native Americans are far removed from their own way of life. Pewewardy, *supra*, at 182.

Third, the use of racist Native sports mascots inflicts especially profound injuries on youth.

The "negative images, symbols, and behaviors" associated with Native American sports mascots "play a crucial role in distorting and warping American Indian children's cultural perceptions of themselves." *Id.* at 181. When exposed to these mascots, "the self-esteem of Native youth is harmfully impacted, their self-confidence erodes, and their sense of

identity is severely damaged." *Racism in Sports*, *supra*, at 5.

These implications are real. Children "develop racial awareness at an early age, perhaps as early as three or four years old." Pewewardy, *supra*, at 182. When Native American children "constantly see themselves being stereotyped and their cultures belittled," they develop "low self-esteem and feel shame about their cultural identity." *Ibid.* As Native American children grow up surrounded by degrading representations and the trivialization of their culture, they may internalize a feeling of inferiority and comport themselves outwardly in accord with that feeling—that is, they may "grow into adults who feel and act inferior to other people." *Ibid.*

The Fryberg study, published in 2008, identifies how "[e]xposure to American Indian mascot images has a negative impact on American Indian high school and college students' feelings of personal and community worth." Fryberg et al., *supra*, at 215-216. This restricts their "achievement-related possible selves." *Id.* at 216. In short, the stereotypes embodied by sports mascots "affect how Native youth view the world and their place in society." *Racism in Sports*, *supra*, at 5. In the aggregate, these individual harms can produce adverse academic and psychological outcomes. Jamie Jaramillo et al., *Ethnic Identity, Stereotype Threat, and Perceived Discrimination Among Native American Adolescents*, J. Res. on Adolescence 1 (2015).

This impact on Native youth is particuly odious insofar as this group exhibits high rates of depression and suicidal ideation, outpacing that of other racial groups within the country. *Ibid.* Suicide is the second leading cause of death for Native American

youth aged 15-24, at a rate that exceeds the national average by 2.5 times. Stegman & Phillips, *supra*, at 7.

Sports mascots affect non-Native children, too. Through exposure to "stereotypes at early ages," individuals may "grow into adults who may unwittingly or unknowingly discriminate against American Indians." Pewewardy, *supra*, at 182. That is because, as children, they were "prevented from developing authentic, healthy attitudes about Indians." *Ibid.*

Given these real-world consequences, it is little surprise that a broad-spectrum of Native entities object to the use of Indian imagery in sports mascots, especially the term REDSKINS. For example, the elected legislative body of *amicus* the Navajo Nation has enacted a resolution stating that the term "Redskins" as used by Pro-Football "constitutes a disparaging epithet." Res. No. NABIAP-22-14, ¶ 2 (2014). The Naabik'íyáti Committee of the Navajo Nation Council, a "committee of the whole" made up of all Council Delegates (elected by and representative of all voting-eligible Navajo people), with the power to state the policy of the Navajo Nation on important public policy matters, unanimously passed a resolution clearly stating the official view of the Nation that:

> The Navajo Nation * * * opposes the use of the terms "redskin" and "redskins," and other disparaging epithets and references to Native Americans in professional sports franchises.

Id. ¶ 10.

Likewise, in 1993, *amicus* NCAI adopted two resolutions to stop the use of the racial slur "REDSKINS" as a team name. One of these resolutions

was adopted by the Executive Council during its meeting of January 18-19 and stated in part:

> [T]he term REDSK[*]NS is not and has never been one of honor or respect, but instead, it has always been and continues to be a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation * * * and continues to be * * * damaging to Native Americans.

Brief of Amici Curiae Native American Organizations in Support of Appellees at 24, *Blackhorse*, No. 15-1874 (4th Cir. 2016).

In light of the clear evidence that Native American mascots inflict significant social harm, it is perhaps little surprise that teams across the country have abandoned "Indian" references in sports mascots. Over the past 35 years, about two-thirds of teams that use such mascots—about 2,000 teams—have eliminated these references. *Racism in Sports*, *supra*, at 8. In particular, 28 high schools have ceased using the name "REDSKINS." *Ibid.*

The government has enormous, legitimate interests in regulating trademarks that ply on such racist imagery.

CONCLUSION

The judgment of the court of appeals should be reversed on commercial speech grounds.

Respectfully submitted.

RICHARD A. GUEST
Native American Rights Fund
1514 P St. NW, Ste. D
Washington, DC 20005

LARRY S. GONDELMAN
BRANDI A. TAYLOR
Powers Pyles Sutter & Verville PC
1501 M St. NW
Washington, DC 20005

CHARLES A. ROTHFELD
Counsel of Record
ANDREW J. PINCUS
PAUL W. HUGHES
MICHAEL B. KIMBERLY
Mayer Brown LLP
1999 K Street, NW
Washington, DC 20006
(202) 263-3000
crothfeld@mayerbrown.com

Counsel for Amici Curiae

NOVEMBER 2016

RECORD AND BRIEFS

No. 15-1293

IN THE

Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF THE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF NEITHER PARTY

WALTER E. HANLEY JR.
President
NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION
ANDREWS KURTH KENYON LLP
One Broadway
New York, NY 10004
(212) 425-7200

DYAN FINGUERRA-DUCHARME
Counsel of Record
DANIELLE E. TEPPER
PRYOR CASHMAN LLP
Seven Times Square
New York, NY 10036
(212) 421-4100
dfinguerra-ducharme@pryorcashman.com

CHARLES R. MACEDO
DAVID P. GOLDBERG
Co-Chair of Amicus Briefs Committee
NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION
AMSTER, ROTHSTEIN & EBENSTEIN LLP
90 Park Avenue
New York, NY 10016
(212) 336-8000

Counsel for Amicus Curiae New York Intellectual Property Law Association
(For Continuation of Appearances See Signature Page)

Library of Congress Law Library

269395

TABLE OF CONTENTS

Page

TABLE OF CONTENTS i

TABLE OF CITED AUTHORITIES iii

INTEREST OF *AMICUS CURIAE* 1

SUMMARY OF ARGUMENT 2

BACKGROUND 3

I. IN THE PATENT AND TRADEMARK OFFICE 3

II. IN THE FEDERAL CIRCUIT 5

A. Decision of the Three-Judge Panel 5

B. Decision of the Federal Circuit Sitting *En Banc* 6

ARGUMENT 8

I. THIS COURT SHOULD CLARIFY WHETHER AN APPLICANT WHO HAS BEEN DENIED FEDERAL REGISTRATION ON THE BASIS OF SECTION 2(a) MAY NEVERTHELESS INVOKE PROTECTION UNDER SECTION 43(a) 8

Table of Contents

Page

A. The Legislative History Supports That Section 43(a) Was Intended to Apply Broadly Even to Marks Not Entitled to Federal Trademark Registration 10

B. This Court's Statement in *Two Pesos* Does Not Preclude the Availability of Section 43(a) to Marks Refused Under Section 2(a).....12

C. The Purpose of Section 43(a) Supports That *Two Pesos* Should Not Limit Section 43(a)'s Availability by "Registrability" Under Section 2(a).....15

CONCLUSION 17

TABLE OF CITED AUTHORITIES

Page

CASES

Brothers of Wheel M.C. Exec. Council, Inc. v. Mollohan,
909 F. Supp. 2d 506 (S.D. W. Va. 2012) 13

EMI Catalogue Partnership v. Hill, Holliday, Connors, Cosmopulos Inc.,
228 F.3d 56 (2d Cir. 2000) 10, 15

In re City of Houston,
731 F.3d 1326 (Fed. Cir. 2013) 13

In re Lebanese Arak Corp.,
94 U.S.Q.P.2d 1215 (T.T.A.B. 2010) 15

In re McGinley,
660 F.2d 481 (C.C.P.A. 1981) 5, 6

In re Simon Shiao Tam,
108 U.S.P.Q.2d 1305 (T.T.A.B. Sept. 26, 2013) 4

In re Tam,
785 F.3d 567 (Fed. Cir. 2015) 5, 6

In re Tam,
808 F.3d 1321 (Fed. Cir. 2015) 6, 9, 15

Orient Exp. Trading Co. v. Federated Dep't Stores, Inc.,
842 F.2d 650 (2d Cir. 1988) 14

Page

Patsy's Italian Restaurant v. Banas,
658 F.3d 254 (2d Cir. 2011) 10

Renna v. County of Union,
88 F. Supp. 3d 310 (D.N.J. 2014) 9

Rescuecom Corp. v. Google Inc.,
562 F.3d 123 (2d Cir. 2009) 12

Sugar Busters LLC v. Brennan,
177 F.3d 258 (5th Cir. 1999) 14

Two Pesos v. Taco Cabana, Inc.,
505 U.S. 763 (1995) . . . . . *passim*

Wal-Mart Stores, Inc. v. Samara Bros., Inc.,
529 U.S. 205 (2000) 9, 12

Walt-W. Enters. v. Gannett Co.,
695 F.2d 1050 (7th Cir. 1982) 15

Warner Bros. v. Gay Toys, Inc.,
658 F.2d 76 (2d Cir. 1981) 11

Yarmuth-Dion, Inc. v. D'ion Furs, Inc.,
835 F.2d 990 (2d Cir. 1987) 9

STATUTES

Sup. Ct. R. 37.6 1

15 U.S.C. §§ 1051 et seq 2

Cited Authorities

Page

15 U.S.C. § 1052(a) 4

15 U.S.C. § 1125 . . . . . 7, 10, 11

15 U.S.C. § 1125(a) 9

LEGISLATIVE MATERIALS

100 Cong. Rec. S 16973 (Oct. 20, 1988) 14

134 Cong. Rec. S5864-02 (May 13, 1988) 11

ADMINISTRATIVE MATERIALS

The United States Trademark Ass'n Trademark Review 11

Comm. Report and recommendations to USTA President and Board of Directors, 77 Trademark Rep. 375, 426 (1987) 11

INTEREST OF *AMICUS CURIAE*

The New York Intellectual Property Law Association ("NYIPLA" or "Association") respectfully submits this *amicus curiae* brief in support of neither party.[1]

The arguments set forth herein were approved on November 17, 2016 by an absolute majority of the officers and members of the Board of Directors of the NYIPLA, including any officers or directors who did not vote for any reason, including recusal, but do not necessarily reflect the views of a majority of the members of the Association, or of the law or corporate firms with which those members are associated. After reasonable investigation, the NYIPLA believes that no officer or director or member of the Committee on Amicus Briefs who voted in favor of filing this brief, nor any attorney associated with any such officer, director or committee member in any law or corporate firm, represents a party in this litigation. Some officers, directors, committee members or associated attorneys may represent entities, including other *amici curiae*, which have an interest in other matters that may be affected by the outcome of this litigation.

---

1. Petitioner consented to the filing of *amicus curiae* briefs in support of either party or neither party in a docket entry dated November 14, 2016, and Respondent consented to the filing of *amicus curiae* briefs in support of either party or neither party in a docket entry dated September 30, 2016. Pursuant to Sup. Ct. R. 37.6, no counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than the NYIPLA, its members, or its counsel made a monetary contribution to its preparation or submission.

The NYIPLA is a professional association of over 1,000 attorneys whose interests and practices lie in the area of patent, trademark, copyright, trade secret and other intellectual property law. The Association's members are frequent participants in federal litigations with respect to trademark claims brought under the Trademark Act of 1946 (the "Lanham Act"), 15 U.S.C. §§ 1051 *et seq.*, state law and common law and in administrative proceedings before the Trademark Trial and Appeal Board ("TTAB") of the United States Patent and Trademark Office ("PTO"). In addition, the Association's members file thousands of federal trademark applications each year with the PTO. Accordingly, the Association's members are interested in the development of trademark law principles that are clear, consistent and equitable.

The NYIPLA's members and their respective clients have a strong interest in this case because it necessarily involves the interplay between the "may disparage" bar to registration in Section 2(a) of the Lanham Act directly at issue in the case and a common law trademark owner's ability to pursue remedies under Section 43(a) of the Lanham Act.

SUMMARY OF ARGUMENT

Section 2 of the Lanham Act makes clear that "[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless" the mark is disqualified for such registration by one of the separate subparagraphs in that section. At issue here is whether the prohibition against registration of marks that "may disparage" persons under Section

2(a) of the Lanham Act is constitutional. While NYIPLA does not take a position regarding whether Section 2(a) is constitutional, NYIPLA respectfully submits this Amicus Brief to address an important trademark law issue inherent in this Court's determination of the merits of the question presented.

In *Two Pesos v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1995), this Court stated that Section 43(a) of the Lanham Act "protects qualifying unregistered trademarks and . . . the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)" (citation omitted). The court below read this statement to imply that an entity whose application is denied under Section 2(a) may not invoke Section 43(a) to enforce its mark because the mark has been deemed "unregistrable" matter. The Lanham Act and *Two Pesos* do not support this interpretation. Accordingly, NYIPLA respectfully requests that the Court to clarify that its statements in *Two Pesos* should not be read to preclude the owners of common law marks from availing themselves of Section 43(a) even if the PTO denied an application for the mark at issue on Section 2(a) grounds.

BACKGROUND

I. IN THE PATENT AND TRADEMARK OFFICE

Section 2(a) of the Lanham Act provides, in relevant part:

> No trademark by which the goods of the applicant may be distinguished from the goods

> of others shall be refused registration on the principal register on account of its nature unless it—
>
> (a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage . . . persons . . . .

15 U.S.C § 1052(a). Simon Shiao Tam, the "front man" for the all Asian-American dance-rock band named "The Slants," filed an application with the PTO to register THE SLANTS as a trademark for use in connection with "entertainment in the nature of live performances by a musical band."

In June 2012, the PTO issued a final rejection of the application on the grounds that, under Section 2(a), the mark may disparage persons of Asian descent. Tam thereafter requested reconsideration of the final rejection, and also appealed the rejection to the TTAB. The request for reconsideration was denied in December 2012, and in September 2013, the TTAB affirmed the PTO's final rejection. *In re Simon Shiao Tam*, 108 U.S.P.Q.2d 1305, *5 (T.T.A.B. Sept. 26, 2013). In reaching this conclusion, the TTAB stated:

> We emphasize that this decision only pertains to applicant's right to register the term and "it is clear that the PTO's refusal to register [applicant's] mark does not affect [his] right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, [applicant's] First Amendment rights would not be abridged by the refusal to register [his] mark."

Id. at *8 (quoting *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981)).

The PTO refused the mark solely on Section 2(a) grounds – neither Section 2(e) nor Section 2(d) was at issue in its non-registration determination for THE SLANTS mark.

II. IN THE FEDERAL CIRCUIT

A. Decision of the Three-Judge Panel

In November 2013, Tam appealed the TTAB's decision directly to the Court of Appeals for the Federal Circuit ("Federal Circuit"). *In re Tam*, 785 F.3d 567, 573 (Fed. Cir. 2015). In an opinion by Judge Kimberly A. Moore, the court affirmed the TTAB's decision, finding that there was substantial evidence supporting the TTAB's holding that "'THE SLANTS [mark] is likely offensive to a substantial composite of people of Asian descent." *Id.* at 571. The court further concluded that:

> [w]ith respect to [Tam's] First Amendment rights, it is clear that the PTO's refusal to register appellant's mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark.

Id. at 572 (quoting *In re McGinley*, 660 F.2d at 484). Judge Moore appended to the court's opinion a statement of "additional views" suggesting that the Federal Circuit

revisit the holding in *In re McGinley*, given that more than thirty years had passed since the decision issued. Judge Moore noted that during that period, not only had the Federal Circuit's reliance on *McGinley* been heavily criticized, but First Amendment jurisprudence had evolved significantly. *Id.* at 573–74.

B. Decision of the Federal Circuit Sitting *En Banc*

In response to Judge Moore's "additional views," the Federal Circuit vacated the three-judge panel's decision and ordered that the appeal be heard, in the first instance, by the court sitting *en banc* to address one question: does the bar in Section 2(a) on registration of disparaging marks violate the First Amendment? *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015).

Before the *en banc* court, the PTO argued that, as a threshold matter, the refusal to register the mark did not implicate the First Amendment because Section 2(a) did not suppress expression; the trademark owner still maintained a right to use the mark. *In re Tam*, 808 F.3d 1321, 1340 (Fed. Cir. 2015) (*en banc*). A majority of the *en banc* court rejected this argument and found that the proscription of the registration of disparaging trademarks under Section 2(a) – whether examined under the strict scrutiny standard applied to the expressive aspects of speech, or under the intermediate scrutiny standard applied to the commercial aspects of speech – violated the First Amendment's guarantee of freedom of speech. *Id.* at 1339, 1355–57.

Constitutional arguments aside, the government coupled its "right to use" point with its claim that the

trademark owner "may" have the ability to enforce the owner's unregistered trademarks under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). *Id.* at 1344 n.11. The Federal Circuit expressed skepticism as to whether Section 43(a) is available to owners of trademarks that are denied registration because of the prohibitions in Section 2(a):

> [I]t is not at all clear that Mr. Tam could bring a § 43(a) unfair competition claim. Section 43(a) allows for a federal suit to protect an unregistered trademark, much like state common law. *But there is no authority extending § 43(a) to marks denied under § 2(a)'s disparagement provision. To the contrary, courts have suggested that § 43(a) is only available for marks that are registrable under § 2. See Two Pesos*, 505 U.S. at 768 (section 43(a) "protects qualifying unregistered trademarks and . . . the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)"); *Yarmuth-Dion, Inc. v. D'ion Furs, Inc.*, 835 F.2d 990, 992 (2d Cir. 1987) (requiring a plaintiff to "demonstrate that his [unregistered] mark merits protection under the Lanham Act"); *see also Renna v. County of Union*, 88 F. Supp. 3d 310, 320 (D.N.J. 2014) ("Section 2 declares certain marks to be unregistrable because they are inappropriate subjects for trademark protection. It follows that such unregistrable marks, not actionable as registered marks under Section 32, are not

> actionable under Section 43, either."). And we have found no case allowing a § 43(a) action on a mark rejected or cancelled under § 2(a).

Id. at 1344 n.11 (emphasis added).

Although observing that "there is no authority extending § 43(a) to marks denied under § 2(a)'s disparagement provision," the Federal Circuit also did not identify any provision in Section 43(a) that excludes disparaging trademarks from its scope. And, while it cited case law "suggest[ing] that § 43(a) is only available for marks that are registrable under § 2," the Federal Circuit also did not identify any case holding that a trademark was not protectable under Section 43(a) because it was disparaging, as opposed to being not protectable on other grounds, such as because the mark is descriptive, generic, or likely confusing with a similar mark. *Id.* Irrespective of how this Court decides the constitutional question raised by this appeal, the Association respectfully submits that the Federal Circuit's interpretation of *Two Pesos* and Section 43(a) is erroneous as a matter of law and should be corrected by this Court.

ARGUMENT

I. THIS COURT SHOULD CLARIFY WHETHER AN APPLICANT WHO HAS BEEN DENIED FEDERAL REGISTRATION ON THE BASIS OF SECTION 2(a) MAY NEVERTHELESS INVOKE PROTECTION UNDER SECTION 43(a)

Section 43(a) of the Lanham Act is clear that a plaintiff need not have a registration to bring a civil action based

on another's use of a confusingly similar mark. *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000). Specifically, Section 43(a) permits a civil action to be brought by "any person who believes that he or she is or is likely to be damaged by" the actions of another "who, on or in connection with any goods or services . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin" which "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person." 15 U.S.C. § 1125(a).

In the opinion below, however, the Federal Circuit suggests that the law is not clear as to whether the owner of a mark that has been rejected by the PTO on disparagement grounds under Section 2(a) is equally entitled to invoke the protections of Section 43(a). *In re Tam*, 808 F.3d at 1344 n.11. Judge Moore's *en banc* opinion further notes that "the government has not pointed to a single case where the common-law holder of a disparaging mark was able to enforce that mark, nor could [the Federal Circuit] find one." *Id.* at 1344.

Judge Moore's footnote suggests that the dearth of case law tends to support the conclusion that Section 43(a) is only available for marks that are registrable under Section 2. *See id.* (citing *Two Pesos v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1995); *Yarmuth-Dion, Inc. v. D'ion Furs, Inc.*, 835 F.2d 990, 992 (2d Cir. 1987); *Renna v. County of Union*, 88 F. Supp. 3d 310, 320 (D.N.J. 2014)). Thus, Judge Moore's footnote raises a question as to whether

the possession of registrable matter is a prerequisite for Lanham Act protection. *See id.* In other words, if "any word, term, name, symbol or device" as described in Section 43(a) is deemed not entitled to registration because it is disparaging, can the owner nevertheless enforce its common law rights against others using similar marks that are likely to cause consumer confusion, mistake or deception, or does the unregistrable status deprive the owner of the potential Section 43(a) claim?

As shown in the analysis that follows, nothing in the statute or case law prevents the owner of a mark that has been rejected on Section 2(a) disparagement grounds from availing itself of Section 43(a). In light of the language contained in the decision below, NYIPLA believes it is important for the Court to clarify that, if the PTO denies registration under Section 2(a), such denial should not, in and of itself, preclude a claim under Section 43(a) if a mark is otherwise protectable and enforceable under common law.

A. The Legislative History Supports That Section 43(a) Was Intended to Apply Broadly Even to Marks Not Entitled to Federal Trademark Registration

Section 43(a) provides individuals with a federal cause of action to enforce common law trademark rights arising under unregistered marks, *see, e.g.*, *Patsy's Italian Rest. v. Banas*, 658 F.3d 254, 267 (2d Cir. 2011) (citing *id.* § 1125(a)), and serves the primary function of deterring consumer confusion, *see EMI Catalogue P'ship v. Hill, Holliday, Connors, Cosmopulos Inc.*, 228 F.3d 56, 61 (2d Cir. 2000). In 1988, Congress amended Section 43(a) to

"codify the law laid down by [the] Federal courts," 134 Cong. Rec. S5864-02 (May 13, 1988) (statement of Sen. Grassley), which "had expanded the [S]ection beyond its original language in 1946," *Two Pesos*, 505 U.S. at 783 (Stevens, J., concurring). *See also, e.g.*, *Warner Bros. v. Gay Toys, Inc.*, 658 F.2d 76, 79 (2d Cir. 1981) (noting that Section 43(a) "should be interpreted and applied broadly so as to effectuate its remedial purpose") (citations omitted). In so doing, and in line with the federal courts' then-trend to permit "a broad class of suitors . . . likely to be injured by such wrong" to enforce their trademarks without registration, Congress' intention was to "create, in essence, a federal law of unfair competition." *Two Pesos*, 505 U.S. at 779-80 (Stevens, J., concurring) (quoting The United States Trademark Ass'n Trademark Review Comm. Report and recommendations to USTA President and Board of Directors, 77 Trademark Rep. 375, 426 (1987)).

Given this expansive purpose of Section 43(a), it follows that independent of federal registration, a trademark owner should be permitted to prevent and enjoin "any word, term, name, symbol or device" or "any false designation of origin likely to cause confusion" as to source or origin. 15 U.S.C. § 1125(a); *see also* 134 Cong. Rec. S5864-02 (May 13, 1988) (amending Section 43(a) from creating liability for "a" false designation of origin to creating liability for "any" false designation of origin). Whether the PTO has denied an application on the basis that the mark "may disparage" is entirely irrelevant to the analysis of whether the mark owner is able to utilize Section 43(a) to prevent a defendant's use of a mark is likely to cause consumer confusion, mistake or deception as to source or origin of it goods. As a result, the Court

should clarify that Section 43(a) may be invoked by the owner of any otherwise enforceable common law mark regardless of whether that mark was registered by the PTO.

B. This Court's Statement in *Two Pesos* Does Not Preclude the Availability of Section 43(a) to Marks Refused Under Section 2(a)

To support its suggestion that Section 43(a) may not be available to an owner of a mark that the PTO has deemed disparaging, the Federal Circuit relied on a statement from this Court in *Two Pesos*. *In re Tam*, 808 F.3d at 1344 n.11. In *Two Pesos*, this Court recognized that "it is common ground that §43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)." *Two Pesos*, 505 U.S. at 768; *Wal-Mart Stores, Inc.*, 529 U.S. at 210 (quoting the same phrase from *Two Pesos*). Other courts have also interpreted *Two Pesos* in a similar fashion as the Federal Circuit. *See Rescuecom Corp. v. Google Inc.*, 562 F.3d 123, 128 (2d Cir. 2009) (citing *Two Pesos* for the proposition that "Section 43(a) of the Lanham Act protects unregistered trademarks as long *as the mark could qualify for registration* under the Lanham Act" (emphasis added)).

The Court in *Two Pesos* was not considering Section 2(a) or the other bars to registration in Section 2. Nor did the Court even address the registrability of the restaurant trade dress at issue in that case. Instead, the issue determined was whether the trade dress could be

protected as inherently distinctive or whether secondary meaning was required. The Association respectfully submits that this passage from *Two Pesos* does not support using Section 2(a) to limit Section 43(a), but rather concerns only the issue of the overriding concern of the initial phrase in Section 2 to the effect that to qualify for protection a trademark must distinguish the mark owner's goods from the goods of others. The use of "qualifying" in the quote "§43(a) protects *qualifying* unregistered trademarks" relates only to whether the mark operates as a trademark, i.e., whether it is capable of distinguishing the source of goods or services. *See id.* at 768. This interpretation is consistent with limits in the quoted statement from *Two Pesos*, which refer to "general principles" for registration that are applicable "for the most part" in determining whether an unregistered mark is entitled to Section 43(a) protection. *Cf. In re City of Houston*, 731 F.3d 1326, 1331 (Fed. Cir. 2013) ("We note that Houston has other means to prevent 'pirates and cheats' from using its city seal to deceive the public, [notwithstanding its rejection for federal registration under § 2(b)]. . . . Other legal protections under the Lanham Act may exist as well. *See* 15 U.S.C. § 1125."); *Brothers of Wheel M.C. Exec. Council, Inc. v. Mollohan*, 909 F. Supp. 2d 506, 542 (S.D. W. Va. 2012) ("As noted earlier, the flag contained within the plaintiff's mark does not violate PTO guidelines [under § 2(b), but] even if it did, unregistered marks are protected under Section 43(a).").

While the Court in *Two Pesos* generally discussed Section 2 and Section 43(a), it did so only in the context of assessing requirements for establishing distinctiveness – that is, the mark's ability to distinguish the goods of the owner from those of others. The Court was asked to

decide only whether a plaintiff with unregistered trade dress for its restaurant could sue a potential infringer for infringement under Section 43(a) if plaintiff's trade dress was found to be inherently distinctive but without secondary meaning. *See id.* at 765. The jury and the lower courts found that the trade dress was not descriptive, was inherently distinctive, and that it was not functional and those findings were not before the Court. The only issue was whether the jury's finding that the trade dress had no secondary meaning disqualified the trade dress from protection under Section 43(a), when the jury also found that the trade dress was inherently distinctive. The Court held that trade dress that is "inherently distinctive" is protectable without secondary meaning, because that trade dress is "capable of distinguishing the goods of the users of these marks." *Id.* at 772.

Clearly, a mark may well be capable of distinguishing the source of goods or services even if the mark conveys a message that "may disparage." Importantly, there is no language or suggestion in either *Two Pesos* or the legislative history of Section 43(a) that tethers Section 43(a) to any determination by the PTO unrelated to the ability of the mark to function as a trademark. *See* 100 Cong. Rec. S 16973 (Oct. 20, 1988). Rather, Section 43(a) serves to provide a brand owner who has not received a federal registration the ability to enforce its trademark against another who is using a mark likely to cause confusion. *See Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999) (finding that "the descriptive nature of a literary title does not mean [ ] that such a title cannot receive protection under § 43(a)"); *Orient Exp. Trading Co. v. Federated Dep't Stores, Inc.*, 842 F.2d 650, 654 (2d Cir. 1988) ("Even if appellants' registered marks

are cancelled, . . . the use of the [disputed] name . . . could still be protected from unfair competition under section 43(a) of the Lanham Act.") (citation omitted); *Walt-W. Enters. v. Gannett Co.*, 695 F.2d 1050, 1054 n.6 (7th Cir. 1982) ("Although trade names . . . are not registrable under the Lanham Act, an action for trade name infringement is nonetheless proper under 15 U.S.C. § 1125(a)." (citations omitted)).

C. The Purpose of Section 43(a) Supports That *Two Pesos* Should Not Limit Section 43(a)'s Availability by "Registrability" Under Section 2(a)

"The purpose of [Section 43(a)] is "to prevent consumer confusion regarding a product's source . . . and to enable those that fashion a product to differentiate it from others on the market." *EMI Catalogue P'ship*, 228 F.3d at 61 (internal quotation marks omitted). On the other hand, the purpose of Section 2(a) is not to address consumer confusion, but rather to codify a statutory prerogative to refuse federal registration to marks "when its meaning may be disparaging to *a substantial composite of the referenced group.*" *In re Lebanese Arak Corp.*, 94 U.S.Q.P.2d 1215, 1217 (T.T.A.B. 2010) (emphasis added). "The PTO uses an objective test in making this determination, looking to dictionaries, the relationship of the matter to the other elements of the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services." *In re Tam*, 808 F.3d at 1364 (Dyk, J., concurring and dissenting in part). This test for disparagement is thus made against a factual record of the mark's meaning to a composite group of persons, without regard to the mark's ability to distinguish the applicant's goods from

those of others and thereby serve as a source identifier. The preamble of Section 2 states "[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration unless" and thus reflects Congress' intent and purpose that a mark which may in fact distinguish the owner's goods from goods of others may nevertheless be refused for reasons wholly unrelated to the mark's ability to distinguish and identify source.

The Association believes that when placed in this context and as necessarily limited by the issues decided in *Two Pesos*, the proper reading of *Two Pesos* is that Section 43(a) and Section 2 both preclude the protection of non-distinctive marks. And because the disparagement clause of Section 2(a), in particular, is not at all designed to address distinctiveness, the fact that a particular mark "may disparage" certain persons should not vitiate its owner's ability to protect its distinctive designation and sue for unfair competition under Section 43(a) to prevent consumer confusion.

CONCLUSION

For the foregoing reasons, the NYIPLA respectfully requests that this Court confirm the availability of Section 43(a) for an applicant whose mark has been denied under Section 2(a).

Respectfully submitted,

WALTER E. HANLEY JR.
President
NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION
ANDREWS KURTH KENYON LLP
One Broadway
New York, NY 10004
(212) 425-7200

CHARLES R. MACEDO
DAVID P. GOLDBERG
Co-Chair of Amicus Briefs Committee
NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION
AMSTER, ROTHSTEIN & EBENSTEIN LLP
90 Park Avenue
New York, NY 10016
(212) 336-8000

PINA M. CAMPAGNA
CARTER, DELUCA, FARRELL & SCHMIDT LLP
445 Broad Hollow Road, Suite 420
Melville, NY 11747
(516) 501-3526

DYAN FINGUERRA-DUCHARME
Counsel of Record
DANIELLE E. TEPPER
PRYOR CASHMAN LLP
Seven Times Square
New York, NY 10036
(212) 421-4100
dfinguerra-ducharme@pryorcashman.com

KATHLEEN E. MCCARTHY
KING & SPALDING LLP
1185 Avenue of the Americas
New York, NY 10036-4003
(212) 556-2345

ROBERT J. RANDO
THE RANDO LAW FIRM P.C.
6800 Jericho Turnpike, Suite 120W
Syosset, NY 11791
(516) 799-9800

MICHAEL C. CANNATA
STEPHEN J. SMIRTI, JR.
FRANK MISITI
RIVKIN RADLER LLP
926 RXR Plaza
Uniondale, NY 11556
(516) 357-3000

WILLIAM THOMASHOWER
SCHWARTZ & THOMASHOWER LLP
15 Maiden Lane, Suite 705
New York, NY 10038
(212) 227-4300

ROBERT M. ISACKSON
VENABLE LLP
Rockefeller Center
1270 Avenue of the Americas,
24th Floor
New York, NY 10020
(212) 307-5500

Counsel for Amicus Curiae
New York Intellectual Property Law Association

RECORD
AND
BRIEF

No. 15-1293

In the
Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,
Petitioner,

v.

SIMON SHIAO TAM,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF AMICUS CURIAE OF PACIFIC LEGAL FOUNDATION IN SUPPORT OF RESPONDENT

JOSHUA P. THOMPSON
Counsel of Record
CALEB R. TROTTER
Pacific Legal Foundation
930 G Street
Sacramento, California 95814
Telephone: (916) 419-7111
Facsimile: (916) 419-7747
Email: jpt@pacificlegal.org
Counsel for Amicus Curiae Pacific Legal Foundation

QUESTION PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), provides that the government shall not refuse a trademark registration on account of the mark's nature unless the mark "consists of . . . matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." The question presented is whether the disparagement clause of the Lanham Act is facially invalid under the First Amendment.

TABLE OF CONTENTS

Page

QUESTION PRESENTED i

TABLE OF AUTHORITIES iii

INTEREST OF AMICUS CURIAE 1

INTRODUCTION AND SUMMARY OF ARGUMENT 1

ARGUMENT 3

I. THE COMMERCIAL SPEECH DOCTRINE DOES NOT APPLY TO THIS CASE 3

II. *CENTRAL HUDSON* SHOULD BE OVERRULED AND THE COMMERCIAL SPEECH DOCTRINE REPUDIATED 8

A. Central Hudson Is Unworkable and Lacks Constitutional Principles 8

B. Principles of *Stare Decisis* Do Not Support Preserving *Central Hudson* 11

III. CONCERNS ABOUT APPLYING STRICT SCRUTINY TO COMMERCIAL SPEECH RESTRICTIONS ARE EXAGGERATED 13

CONCLUSION 15

TABLE OF AUTHORITIES

Page

Cases

44 Liquormart, Inc. v. Rhode Island, 517 U.S. 484 (1996) 3, 8-9, 12

B & B Hardware, Inc. v. Hargis Indus., Inc., 135 S. Ct. 1293 (2015) 5

Bolger v. Youngs Drug Prod.'s Corp., 463 U.S. 60 (1983) 5

Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n, 447 U.S. 557 (1980) . . . . . passim

Cincinnati v. Discovery Network, Inc., 507 U.S. 410 (1993) 5, 10

Citizens for Free Speech, LLC v. Cty. of Alameda, 114 F. Supp. 3d 952 (N.D. Cal. 2015) 11

Illinois ex rel. Madigan v. Telemarketing Associates, Inc., 538 U.S. 600 (2003) 6

In re Tam, 785 F.3d 567 (Fed. Cir. 2015) 1

In re Tam, 808 F.3d 1321 (Fed. Cir. 2015) 1, 4

Kasky v. Nike, Inc., 45 P.3d 243 (Cal. 2002) *cert. dismissed as improvidently granted*, 539 U.S. 654 (U.S. June 23, 2003). 9. 12

Lee v. Tam, 137 S. Ct. 30 (2016) 2

Montejo v. Louisiana, 556 U.S. 778 (2009) 11-12

Patterson v. McLean Credit Union, 491 U.S. 164 (1989) 11-12

Payne v. Tennessee, 501 U.S. 808 (1991) 11

TABLE OF AUTHORITIES—Continued

Page

R.A.V. v. City of St. Paul, Minn.,
505 U.S. 377 (1992) 5

Reed v. Town of Gilbert,
135 S. Ct. 2218 (2015) 7, 10-11, 13

Riley v. Nat'l Fed'n of the Blind,
487 U.S. 781 (1988) 4

Rosenberger v. Rector and Visitors of the Univ. of Va., 515 U.S. 819 (1995) 7-8

Rubin v. Coors Brewing Co.,
514 U.S. 476 (1995) 4

San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.,
483 U.S. 522 (1987) 3, 6-7

Smith v. Allwright,
321 U.S. 649 (1944) 11

Sorrell v. IMS Health Inc.,
564 U.S. 552 (2011) 4-5, 10-11

Swift & Co., Inc. v. Wickham,
382 U.S. 111 (1965) 12

Thomas v. Schroer,
127 F. Supp. 3d 864 (W.D. Tenn. 2015) 11

Turner Broadcasting Sys. v. Fed. Comm. Comm'n,
512 U.S. 622 (1994) 7

United States v. Alvarez,
132 S. Ct. 2537 (2012) 14

TABLE OF AUTHORITIES—Continued

Page

Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc., 425 U.S. 748 (1976) 3, 5, 13

Statutes

15 U.S.C. § 1052(a) 7

Amateur Sports Act of 1978, 36 U.S.C. §§ 371-396 6

Ted Stevens Olympic and Amateur Sports Act, 36 U.S.C. §§ 220501-220529. 6

Miscellaneous

Byrne, Alanna, *One Direction sued for $1 million over name dispute*, Inside Counsel (Apr. 11, 2012), http://www.insidecounsel.com/2012/04/11/one-direction-sued-for-1-million-over-name-dispute 5

Emord, Jonathan W., *Contrived Distinctions: The Doctrine of Commercial Speech in First Amendment Jurisprudence*, Cato Policy Analysis No. 161 (1991) 14

Halberstam, Daniel, *Commercial Speech, Professional Speech, and the Constitutional Status of Social Institutions*, 147 U. Pa. L. Rev. 771 (1999) 8

Kozinski, Alex & Banner, Stuart, *Who's Afraid of Commercial Speech?*, 76 Va. L. Rev. 627 (1990) 9, 14

TABLE OF AUTHORITIES—Continued

Page

La Fetra, Deborah J., *Kick It Up a Notch: First Amendment Protection for Commercial Speech*, 54 Case W. Res. L. Rev. 1205 (2004) 8-9

McCarthy, J. Thomas, *McCarthy on Trademarks and Unfair Competition* § 3:2 (4th ed. Westlaw) 4

Redish, Martin, *Commercial Speech, First Amendment Intuitionism and the Twilight Zone of Viewpoint Discrimination*, 41 Loy. L.A. L. Rev. 67 (2007) 3

INTEREST OF AMICUS CURIAE[1]

Pacific Legal Foundation (PLF) is a public interest legal foundation established in 1973 to litigate cases that advance the principles of limited government and economic liberty. Toward those ends, PLF has participated as amicus in many cases involving the speech rights of entrepreneurs and businesses. PLF attorneys have also published extensively on the need for full First Amendment protection for commercial speech. This case is important to PLF because it threatens the freedom of speech of individual entrepreneurs and commercial enterprises.

INTRODUCTION AND SUMMARY OF ARGUMENT

Simon Tam, an Asian-American, chose The Slants as a band name and recruited other Asian-Americans to join the band in order to provide an interesting and entertaining platform for discussion of discrimination against Asian-Americans. Resp. Cert. Br. 1-2. When Mr. Tam attempted to register The Slants as a trademark, however, the mark was refused as disparaging toward people of Asian descent. Resp. Cert. Br. 4. Mr. Tam appealed. Resp. Cert. Br. 4-5.

After a panel of the Federal Circuit affirmed, *In re Tam*, 785 F.3d 567, 571 (Fed. Cir. 2015), the full court sitting en banc reversed. *In re Tam*, 808 F.3d 1321, 1328 (Fed. Cir. 2015) (en banc). It held that the disparagement clause violates the First Amendment,

---

[1] No counsel for any party authored this brief in whole or in part, and no person or entity other than amicus curiae funded its preparation or submission. Counsel for both parties filed letters of consent to the filing of amicus curiae briefs, and are on file with the Clerk.

because it is a viewpoint- and content-based speech restriction. *Id.* at 1335. This Court granted review. *Lee v. Tam*, 137 S. Ct. 30 (2016).

Petitioners (government) primarily argue that the disparagement clause does not restrict speech. Pet. Br. 25-28. According to the government, the disparagement clause is merely a component of the government's system for registering trademarks. Pet. Br. 14-19. Alternatively, the government claims that if speech is restricted, it is only government speech or commercial speech, and thus unworthy of full First Amendment protection. Pet. Br. 37-48.

Mr. Tam's mark is not commercial speech, and the disparagement clause should be subject to strict scrutiny. Because the "commercial speech doctrine" only applies when the government regulates to protect the public from commercial harms or fraud, the doctrine is inapplicable here. This is not a case where the public is at risk from misleading advertising, nor is it a case where use of a trademark may potentially defraud the public. In fact, to the extent that The Slants is commercial speech, the government can best protect the public by granting the band trademark protection.

If the Court does hold Mr. Tam's mark to be commercial speech, an express overruling of *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557 (1980), and the intermediate scrutiny for commercial speech it sets forth, is long overdue. There is no principled distinction between commercial and noncommercial speech in the First Amendment, and the Court should clarify that the Constitution fully protects commercial speech.

ARGUMENT

I

THE COMMERCIAL SPEECH DOCTRINE DOES NOT APPLY TO THIS CASE

The disparagement clause of the Lanham Act is a content- and viewpoint-based speech restriction. Nevertheless, the government relies on *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987), and *Central Hudson* to urge the Court to apply intermediate scrutiny under the "commercial speech doctrine" rather than the strict scrutiny required for viewpoint- and content-based speech restrictions. Pet. Br. 48. The Court should decline the government's invitation.

In 1976, this Court reinstated the protections of the First Amendment for commercial speech. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 761-62 (1976). The Court later created a four-part test for evaluating commercial speech regulations in *Central Hudson*, 447 U.S. at 564, and modified the test in *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 504 (1996).

Commercial speech is best defined as speech that "does no more than propose a commercial transaction." *44 Liquormart*, 517 U.S. at 518 (Thomas, J., concurring) (quoting *Va. State Bd. of Pharmacy*, 425 U.S. at 762); *see also* Martin Redish, *Commercial Speech, First Amendment Intuitionism and the Twilight Zone of Viewpoint Discrimination*, 41 Loy. L.A. L. Rev. 67, 74-75 (2007) (the definition of commercial speech for the Court is "speech advocating the sale of commercial products or services").

Trademarks on the other hand—and Mr. Tam's mark in particular—do not propose a commercial transaction. On the contrary, trademarks serve many functions, and Mr. Tam is using The Slants to express ideas that the First Amendment is designed to protect. *See* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 3:2 (4th ed. Westlaw); *see also* Resp. Cert. Br. 14, 28-30; *In re Tam*, 808 F.3d at 1328 ("With his band name, Mr. Tam conveys more about our society than many volumes of undisputedly protected speech.").

When expressive speech is "inextricably intertwined" with commercial components—like The Slants trademark—then the Court "cannot parcel out the speech, applying one test to one phrase and another test to another phrase." *Riley v. Nat'l Fed'n of the Blind*, 487 U.S. 781, 796 (1988). With The Slants, Mr. Tam and his fellow Asian-American band members have reappropriated a traditionally derogatory word, and turned it into a badge of pride. Resp. Cert. Br. 1-2. The band name cleverly expresses their views on discrimination against Asian-Americans. Because of its function and purpose, The Slants cannot be categorized solely as commercial speech under even the broadest definition. *Cf. Rubin v. Coors Brewing Co.*, 514 U.S. 476, 492 (1995) (Stevens, J., concurring) ("[T]he Government should not be able to suppress . . . truthful speech merely because it happens to appear on the label of a product for sale.").

The rationale for affording commercial speech less protection does not apply to Mr. Tam's attempt to register The Slants. Government may restrict commercial speech to protect the public from "commercial harms," *Sorrell v. IMS Health Inc.*, 564

U.S. 552, 579 (2011) (citing *Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 426 (1993)), or lessen the risk of fraud. *R.A.V. v. City of St. Paul, Minn.*, 505 U.S. 377, 388-89 (1992) (citing *Virginia Bd. of Pharm.*, 425 U.S. at 771-72). Because neither concern is implicated here, the Court should not treat Mr. Tam's mark as commercial speech.

The Court's concern for protecting the public from "commercial harms" focuses on the financial loss suffered as a result of untruthful or misleading advertising. *See Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 81-82 (1983) (Stevens, J., concurring). But trademarks—and registration with the government—remedy this problem on their own. As the government readily admits, trademarks protect the public from being confused or misled by competing merchants. *See* Pet. Br. 2 (citing, e.g., *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015)). Indeed, to the extent there is concern about misleading or untruthful speech in this case, *granting* Mr. Tam registration of his trademark protects the public from confusion. Without such protection, other individuals could start a band called The Slants, and regardless of their intent, diminish the positive message expressed through Mr. Tam's use of the name.[2] Fans of Mr. Tam's band may mistakenly spend money to attend a show or purchase music from

---

[2] This is not merely a hypothetical concern. One of the more recent examples of this problem involves the "One Direction" name used by a popular British musical group after a lesser known northern California group had already been performing under the name. Alanna Byrne, *One Direction Sued for $1 Million Over Name Dispute*, Inside Counsel (Apr. 11, 2012), http://www.insidecounsel.com/2012/04/11/one-direction-sued-for-1-million-over-name-dispute.

an impostor band. Were Mr. Tam granted registration of The Slants, however, he would possess powerful tools to prevent and end this confusion.

Likewise, the risk of fraud is not present with Mr. Tam's use of The Slants. Nowhere does the government contend that denial of Mr. Tam's mark is necessary to combat fraud. Even if it had, fraud is best mitigated by granting Mr. Tam trademark registration for The Slants. In any event, "the First Amendment does not shield fraud." *Illinois ex rel. Madigan v. Telemarketing Associates, Inc.*, 538 U.S. 600, 612 (2003). Government can use anti-fraud laws to prosecute, and thereby deter, speech that defrauds the public without tailoring its laws to pass scrutiny under the First Amendment. *See id.* at 621.

The government's reliance on *San Francisco Arts & Athletics* is unavailing. That case concerned the constitutionality of the Amateur Sports Act of 1978, 36 U.S.C. §§ 371-96.[3] 483 U.S. at 524. The Amateur Sports Act granted the United States Olympic Committee "the right to prohibit certain commercial and promotional uses of the word 'Olympic' and various Olympic symbols." *Id.* at 526. The Court held that Congress intended the Amateur Sports Act to provide the Olympic Committee with additional protections beyond those available for trademarks under the Lanham Act. *See id.* at 530-31. In that context, the Court also held that "[t]o the extent that [the Amateur Sports Act] applies to uses 'for the purpose of trade [or] to induce the sale of any goods or services,' " then the commercial speech doctrine applies. *Id.* at 535.

---

[3] The current version of the Act, the Ted Stevens Olympic and Amateur Sports Act, is codified at 36 U.S.C. §§ 220501-29.

Therefore, *San Francisco Arts & Athletics* does not hold that trademark regulation under the Lanham Act receives intermediate scrutiny as commercial speech. Instead, to the extent that the Court used a broader definition for commercial speech, it did so in relation to the Amateur Sports Act, not trademarks in general. Moreover, recent decisions of this Court have narrowed the applicability of the commercial speech doctrine. *See Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2235 (2015) (Breyer, J., concurring) ("[T]he Court has applied the heightened 'strict scrutiny' standard even in cases where the less stringent 'commercial speech' standard was appropriate.").

Rather than classify Mr. Tam's mark as commercial speech worthy of only limited constitutional protection, the Court should hold that The Slants is fully protected expressive speech. However, the government refused to register Mr. Tam's mark because it adopted the viewpoint that the mark's content (The Slants) is disparaging, Pet. Br. 4-5, and the disparagement clause requires the government to reject marks it finds disparaging. 15 U.S.C. § 1052(a).

Yet, the First Amendment prohibits "governmental control over the content of messages expressed by private individuals." *Turner Broadcasting Sys. v. Fed. Comm. Comm'n*, 512 U.S. 622, 641 (1994). This Court applies "the most exacting scrutiny to regulations that suppress, disadvantage, or impose differential burdens upon speech because of its content." *Id.* at 642. Likewise, when the government targets "particular views taken by speakers on a subject, the violation of the First Amendment is all the more blatant." *Rosenberger v. Rector and Visitors of*

the Univ. of Va., 515 U.S. 819, 829 (1995). Thus, "[v]iewpoint discrimination is [ ] an egregious form of content discrimination." *Id.* Here, because the government refused to register The Slants on content- and viewpoint-based grounds, the disparagement clause should be subject to strict scrutiny.

II

CENTRAL HUDSON SHOULD BE OVERRULED AND THE COMMERCIAL SPEECH DOCTRINE REPUDIATED

Even if this Court were to find Mr. Tam's mark to be commercial speech, the intermediate scrutiny described in *Central Hudson*, 447 U.S. at 564, should be repudiated.

A. *Central Hudson* Is Unworkable and Lacks Constitutional Principles

Since *Central Hudson* was decided in 1980, confusion and inconsistency have been the only guarantees in cases analyzing commercial speech regulations. *See 44 Liquormart*, 517 U.S. at 526-28 (Thomas, J. concurring); Daniel Halberstam, *Commercial Speech, Professional Speech, and the Constitutional Status of Social Institutions*, 147 U. Pa. L. Rev. 771, 779-89 (1999) (discussing the inconsistent approach taken by courts and the calling into doubt of *Central Hudson* and the commercial speech doctrine); Deborah J. La Fetra, *Kick It Up a Notch: First Amendment Protection for Commercial Speech*, 54 Case W. Res. L. Rev. 1205, 1216-17 (2004) (noting that courts have acknowledged that the commercial speech doctrine is difficult to apply predictably). In all likelihood, confusion has resulted because there is no "philosophical or historical basis for asserting that

'commercial speech' is of 'lower value' than 'noncommercial' speech." *44 Liquormart*, 517 U.S. at 522 (Thomas, J., concurring) (citing authorities); *see also generally* Alex Kozinski & Stuart Banner, *Who's Afraid of Commercial Speech?*, 76 Va. L. Rev. 627 (1990) (concluding that there is no valid reason for distinguishing between commercial and noncommercial speech); La Fetra, *supra* at 1221 ("excluding corporate speech from the First Amendment's reach would almost inevitably have a detrimental impact on the most fundamental values underlying the protection of free speech.").

Indeed, it is increasingly the case that distinguishing between commercial and noncommercial speech is a fool's errand. *Kasky v. Nike, Inc.*, 45 P.3d 243, 269 (Cal. 2002) *dismissed as improvidently granted*, 539 U.S. 654 (U.S. June 26, 2003) (Brown, J., dissenting) ("the commercial speech doctrine, in its current form, fails to account for the realities of the modern world—a world in which personal, political, and commercial arenas no longer have sharply defined boundaries."). The line between commercial speech and fully protected speech has long been blurred, but advances in technology and social connectedness further cloud the distinction. *See* La Fetra, *supra*, 1231-36. Examples ranging from music videos, to press releases, to television show product placement, to letters to the editor, to "guerilla" marketing and virtual advertising show that it is quite difficult to distinguish whether speech "does no more than propose a commercial transaction," or expresses views on the issues of the day, or engages in artistic expression. *Id.* at 1231-34. Another modern example

is the common practice of airlines engaging on the Twitter social media platform.[4]

In two recent First Amendment decisions, the Court declined to distinguish between commercial and noncommercial speech. In *Sorrell*, the Court struck down a Vermont statute that imposed a content- and viewpoint-based ban on commercial speech. 564 U.S. at 563-65, 580. The Court declined to determine which level of scrutiny was appropriate, because the Vermont statute could not withstand intermediate scrutiny. *Id.* at 571. However, the Court did reaffirm the significant value of commercial speech, and explained that its focus was the challenged law's content- and viewpoint-based application. *Id.* at 566-67. Furthermore, the Court limited the availability of intermediate scrutiny to circumstances where the government's interest is to prevent commercial harm and fraud. *Id.* at 579. To the extent that the commercial speech doctrine remains after *Sorrell*, it is limited.

More recently, in *Reed*, this Court held that content- and viewpoint-based speech restrictions are subject to strict scrutiny. 135 S. Ct. at 2226-27. The Court did not limit the rule to noncommercial speech, and cited approvingly to commercial speech decisions to set out the rule. *See id.* at 2226-28 (citing *Sorrell* and *Cincinnati*, 507 U.S. 410). Indeed, the Court cited *Sorrell* as authority for the proposition that before considering the purpose or justification for a speech

---

[4] United Airlines, for example, uses its @united account to engage with customers, announce airline news, provide customer support, and generally promote itself. Aside from the occasional announcement of a fare sale, however, none of these communications neatly fit the definition for commercial speech.

restriction, the Court must first consider whether the law regulates based on content. *Id.* at 2228. There is no obvious reason to limit that proposition to noncommercial speech. In fact, were a court to consider whether a speech restriction applies to commercial or noncommercial speech first, it would violate *Reed*.

To be sure, *Reed* does not expressly hold that it applies to commercial speech. Yet, *Reed* set out broadly applicable rules for content-based speech restrictions, and did not seek to limit *Sorrell* or its application to commercial speech. Taking *Reed* at face value, some lower courts have begun applying it to content-based commercial speech restrictions. *See Thomas v. Schroer*, 127 F. Supp. 3d 864, 873-75 (W.D. Tenn. 2015) (applying strict scrutiny under *Reed* after determining Tennessee's Billboard Act was content-based); *but see Citizens for Free Speech, LLC v. Cty. of Alameda*, 114 F. Supp. 3d 952, 968-69 (N.D. Cal. 2015) (holding *Reed* does not apply to commercial speech). This Court should quell any remaining confusion by expressly overruling *Central Hudson*.

B. Principles of *Stare Decisis* Do Not Support Preserving *Central Hudson*

Respect for precedent and *stare decisis* are insufficient reasons to maintain *Central Hudson*. While *stare decisis* is "of fundamental importance to the rule of law," *Patterson v. McLean Credit Union*, 491 U.S. 164, 172 (1989), "when governing decisions are unworkable or are badly reasoned, 'this Court has never felt constrained to follow precedent.' " *Payne v. Tennessee*, 501 U.S. 808, 827 (1991) (quoting *Smith v. Allwright*, 321 U.S. 649, 665 (1944)). It is appropriate

to overrule previous decisions when they are detrimental to "coherence and consistency in the law . . . because of inherent confusion created by an unworkable decision." *Patterson*, 491 U.S. at 173. Once a previous decision has shown to be unworkable, "the mischievous consequences to litigants and courts alike from the perpetuation of an unworkable rule are too great" to justify upholding the decision. *Swift & Co., Inc. v. Wickham*, 382 U.S. 111, 116 (1965); *see also Montejo v. Louisiana*, 556 U.S. 778, 792 (2009) ("[T]he fact that a decision has proved 'unworkable' is a traditional ground for overruling it.").

Whether it is the confusing and inconsistent application of the four-part test for commercial speech, or the increasing difficulty in distinguishing between commercial and noncommercial speech, many have noted that *Central Hudson* is unworkable. *See, e.g.*, *44 Liquormart*, 517 U.S. at 526-27 (Thomas, J., concurring); *Kasky*, 45 P.3d at 269 (Brown, J., dissenting). Furthermore, the reasoning behind *Central Hudson*'s diminished protection of commercial speech has never been satisfactorily established. *44 Liquormart*, at 526 (Thomas, J., concurring). When a precedent's "logic threatens to undermine our First Amendment jurisprudence and the nature of public discourse more broadly—the costs of giving it *stare decisis* effect are unusually high." *Citizens United v. Fed. Election Comm'n*, 558 U.S. 310, 382 (2010). Therefore, considerations of *stare decisis* should not compel the Court to maintain a distinction between commercial and noncommercial speech founded on such questionable footing.

At a minimum, if *Central Hudson* remains good law, the Court should clarify that it only applies where

the government's interest is to prevent actual commercial harm or fraud. A better approach, more consistent with this Court's First Amendment precedents—including *Reed*—would explain that there is no principled distinction between commercial and noncommercial speech under the First Amendment. As a result, the Court should overrule *Central Hudson* and eliminate its unprincipled and limited protection of commercial speech.

III

CONCERNS ABOUT APPLYING STRICT SCRUTINY TO COMMERCIAL SPEECH RESTRICTIONS ARE EXAGGERATED

Anti-speech advocates suggest that subjecting commercial speech regulations to strict scrutiny could hamstring the government's ability to effectively regulate the economy and put consumers at risk. *See* Br. of Amicus Curiae Public Citizen, Inc., 18-21. But as discussed above, there is no good reason for distinguishing between commercial and noncommercial speech—assuming such a distinction is possible. Furthermore, fear that the government may need to scale back its role as regulator is not a persuasive argument for maintaining precedents lacking textual or principled support. Indeed, deciding between protecting speech or allowing government greater rein to restrict speech is a choice "that the First Amendment makes for us." *See Va. State Bd. of Pharmacy*, 425 U.S. at 770.

The government will still be able to protect consumers from fraud and commercial harms in a world where restrictions on commercial speech are subject to strict scrutiny. Kozinski & Banner, at 651-

52 (using anti-fraud statutes, libel laws, and securities regulations as examples that not much would need to change were commercial speech fully protected under the First Amendment). The government also has existing analyses for content-neutral regulations and mandated disclosures available to operate under without the need to satisfy strict scrutiny. Kozinski & Banner, at 651-52 (under content-neutral analysis, anti-fraud statutes and securities regulations would likely survive largely unchanged).

Protecting speech from government overreach is not a zero-sum game. *See* Kozinski & Banner, at 648 (rejecting the notion that fully protecting commercial speech will result in a "leveling process" that may weaken protection for noncommercial speech); *accord* Jonathan W. Emord, *Contrived Distinctions: The Doctrine of Commercial Speech in First Amendment Jurisprudence*, Cato Policy Analysis No. 161 (1991).[5] Concern that courts may improperly apply strict scrutiny or water down its strength is not a valid reason to avoid applying it to commercial speech restrictions. Instead, the Court should apply strict scrutiny to content- and viewpoint-based speech restrictions, and correct any misapplications of that standard. Failing to fully protect commercial speech does not ensure full protection for noncommercial speech, but it undoubtedly gives less protection to commercial speech. The only principled way to protect speech is to protect speech. *See United States v. Alvarez*, 132 S. Ct. 2537, 2563 (2012) (Alito, J., dissenting) (noting that the Court has found it necessary to protect false statements of fact in order to prevent chilling fully protected speech).

---

[5] https://object.cato.org/sites/cato.org/files/pubs/pdf/pa161.pdf

CONCLUSION

For the foregoing reasons, the decision of the Federal Circuit should be affirmed. Strict scrutiny is the appropriate standard to review the disparagement clause, and if this Court holds Mr. Tam's mark to be commercial speech, *Central Hudson* should be repudiated.

DATED: December, 2016.

Respectfully submitted,

JOSHUA P. THOMPSON
Counsel of Record
CALEB R. TROTTER
Pacific Legal Foundation
930 G Street
Sacramento, California 95814
Telephone: (916) 419-7111
Facsimile: (916) 419-7747
Email: jpt@pacificlegal.org

Counsel for Amicus Curiae
Pacific Legal Foundation

RECORD AND BRIEFS

Supreme Court, U.S.
FILED
DEC 16 2016
OFFICE OF THE CLERK

No. 15-1293

In The

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,
Petitioner,

v.

SIMON SHIAO TAM,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF *AMICUS CURIAE* PRO-FOOTBALL, INC. IN SUPPORT OF RESPONDENT

ROBERT L. RASKOPF
TODD ANTEN
JESSICA A. ROSE
Quinn Emanuel Urquhart & Sullivan LLP
51 Madison Ave., 22nd Floor
New York, NY 10010
(212) 849-7000
robertraskopf@quinnemanuel.com

LISA S. BLATT
Counsel of Record
ROBERT A. GARRETT
STEPHEN K. WIRTH
Arnold & Porter LLP
601 Massachusetts Ave., NW
Washington, DC 20001
(202) 942-5000
lisa.blatt@aporter.com

Counsel for Amicus Curiae Pro-Football, Inc.

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20002

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES iii

INTEREST OF *AMICUS CURIAE* 1

INTRODUCTION AND SUMMARY OF ARGUMENT 1

ARGUMENT 7

SECTION 2(a) VIOLATES THE FIRST AMENDMENT, PARTICULARLY IN THE CANCELLATION CONTEXT 7

A. Section 2(a) Triggers Strict Scrutiny 7

1. Trademarks Are Fully Protected Speech 7

2. Section 2(a) Impermissibly Burdens Disfavored Speech 11

3. This Court's Precedents Foreclose the Government's "But You Can Still Speak" Argument 13

B. Section 2(a) Fails Even Intermediate Scrutiny 16

1. Section 2(a) Cannot Be Justified As Protecting Underrepresented Groups 16

2. Section 2(a) Cannot Be Justified As Preventing Government Association 19

3. PTO's Arbitrary Application of § 2(a) Undercuts the Government's Asserted Interests 21

C. Registration Is Neither Government Speech Nor a Subsidy 24

D. Section 2(a)'s Application in the Cancellation Context Is Independently Unconstitutional 29

TABLE OF CONTENTS—continued

Page

1. Cancellation Does Not Further the Government's Asserted Interests 29
2. Cancellation Imposes Far Greater Burdens on Mark Owners 30

CONCLUSION 35

APPENDIX

TABLE OF AUTHORITIES

Page(s)

Cases

Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.,
133 S. Ct. 2321 (2013) 26

Ark. Writers' Project Inc. v. Ragland,
481 U.S. 221 (1987) 14

Autor v. Pritzker,
740 F.3d 176 (D.C. Cir. 2014) 26

B&B Hardware, Inc. v. Hargis Indus.,
135 S. Ct. 1293 (2015) 4, 7, 11

Bd. of Trs. of the State Univ. of N.Y. v. Fox,
492 U.S. 469 (1989) 8

Bolger v. Youngs Drug Prods. Corp.,
463 U.S. 60 (1983) 16

Bullfrog Films, Inc. v. Wick,
847 F.2d 502 (9th Cir. 1988) 26

Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.,
447 U.S. 557 (1980) 16

Citizens United v. Fed. Election Comm'n,
558 U.S. 310 (2010) 12

Cleveland v. United States,
531 U.S. 12 (2000) 11, 27

Davenport v. Wash. Educ. Ass'n,
551 U.S. 177 (2007) 26, 27

TABLE OF AUTHORITIES—continued

Page(s)

Dep't of Tex., Veterans of Foreign Wars of the U.S. v. Tex. Lottery Comm'n, 760 F.3d 427 (5th Cir. 2014) 26

FCC v. League of Women Voters of Cal., 468 U.S. 364 (1984) 12

Good News Club v. Milford Cent. Sch., 533 U.S. 98 (2001) 30

Greater New Orleans Broad. Ass'n v. United States, 527 U.S. 173 (1999) 23

Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539 (1985) 10

Harris v. McCrae, 448 U.S. 297 (1980) 26

Hustler Magazine, Inc. v. Falwell, 485 U.S. 46 (1988) 17

Legal Servs. Corp. v. Velazquez, 531 U.S. 533 (2001) 25, 26, 28

L.A. Police Dep't v. United Reporting Publ'g Corp., 528 U.S. 32 (1999) 15

Illinois ex rel. Madigan v. Telemarketing Assocs., Inc., 538 U.S. 600 (2003) 10

TABLE OF AUTHORITIES—continued

Page(s)

Minneapolis Star & Tribune Co. v. Minn. Comm'r of Revenue,
460 U.S. 575 (1983) 15

Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.,
316 U.S. 203 (1942) 7

N.Y. Times Co. v. Sullivan,
376 U.S. 254 (1964) 8

NEA v. Finley,
524 U.S. 569 (1998) 28

Nike, Inc. v. Kasky,
539 U.S. 654 (2003) 9

Pitt News v. Pappert,
379 F.3d 96 (3d Cir. 2004) 14

Pro-Football, Inc. v. Blackhorse,
112 F. Supp. 3d 439 (E.D. Va. 2015) 1

Qualitex Co. v. Jacobson Prods. Co.,
514 U.S. 159 (1995) 8

Reed v. Town of Gilbert,
135 S. Ct. 2218 (2015) 12

Regan v. Taxation With Representation of Wash.,
461 U.S. 540 (1983) 26, 28

Reno v. ACLU,
521 U.S. 844 (1997) 30

TABLE OF AUTHORITIES—continued

Page(s)

Rosenberger v. Rector & Visitors of the Univ. of Va.,
515 U.S. 819 (1995) 14, 28

Rust v. Sullivan,
500 U.S. 173 (1991) 25

Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.,
502 U.S. 105 (1991) 14

Snyder v. Phelps,
131 S. Ct. 1207 (2011) 17

Sorrell v. IMS Health Inc.,
564 U.S. 552 (2011) 10, 14, 15, 16

United States v. Stevens,
559 U.S. 460 (2010) 9

Walker v. Tex. Div., Sons of Confederate Veterans, Inc.,
135 S. Ct. 2239 (2015) 24, 25

Walt Disney Co. v. Powell,
698 F. Supp. 10 (D.D.C. 1988) 10

Ysursa v. Pocatello Educ. Ass'n,
555 U.S. 353 (2009) 27

Zacchini v. Scripps-Howard Broad. Co.,
433 U.S. 562 (1977) 10

Trademark Trial and Appeal Board Decisions

Application of Helene Curtis Indus., Inc.,
305 F.2d 492 (C.C.P.A. 1962) 20

TABLE OF AUTHORITIES—continued

Page(s)

Application of Nat'l Distillers & Chem. Corp.,
297 F.2d 941 (C.C.P.A 1962) 20

Blackhorse v. Pro-Football, Inc.,
111 U.S.P.Q.2d 1080 (T.T.A.B. 2014) 29

Harjo v. Pro-Football, Inc.,
50 U.S.P.Q.2d 1705 (T.T.A.B. 1999) 21

In re Heeb Media LLC,
89 U.S.P.Q.2d 1071 (T.T.A.B. 2008) 22

In re In Over Our Heads,
16 U.S.P.Q.2d 1653 (T.T.A.B. 1990) 21

Constitutional Provisions

U.S. Const. amend. I ..... *passim*

Statutes

15 U.S.C. § 1051(a)(3)(C) 8

15 U.S.C. § 1052(a) ..... *passim*

15 U.S.C. § 1063 27

15 U.S.C. § 1064 ..... 23, 29, 31

15 U.S.C. § 1067 ..... 23, 29

15 U.S.C. § 1070 27

15 U.S.C. § 1071 ..... 27, 29

15 U.S.C. § 1125(a) 16

18 U.S.C. § 48 9

TABLE OF AUTHORITIES—continued

Page(s)

35 U.S.C. § 153 20

Other Authorities

A. Taube & K. Richards, *15 Racist Brand Mascots and Logos that Make the Redskins Look Progressive*, Business Insider (June 19, 2014) 34

Brief of the United States, *Pro-Football, Inc. v. Blackhorse*, No. 15-1874 (4th Cir. Feb. 4, 2016) 34

Brief of the United States, *Nike, Inc. v. Kasky*, 539 U.S. 654 (2003) (No. 02-575) 31

Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the H. Comm. on Patents, 76th Cong. (1939) 17, 21

J.W. Cox et al., *New Poll Finds 9 in 10 Native Americans Aren't Offended by Redskins Name*, Wash. Post, May 19, 2016 30

L. Munoz, *Wearing Pride on Sleeve*, L.A. Times, Jan. 17, 2008 22

M. Kern-Foxworth, *Aunt Jemima, Uncle Ben, and Rastus: Blacks in Advertising, Yesterday, Today, and Tomorrow* (1994) 34

M.M. Manring, *Slave in a Box: The Strange Career of Aunt Jemima* (1998) 34

TABLE OF AUTHORITIES—continued

Page(s)

Opening Brief of Appellant, *Pro-Football, Inc. v. Blackhorse*, No. 15-1874 (4th Cir. Oct. 30, 2015) 17

PTO, *Basic Facts About Trademarks* 11

PTO, *Do I Need a Trademark Attorney?* 11

PTO, *Trademark Basics* 11

PTO, Trademark Electronic Search System 3

The Racial Slur Database 22

The Racially Charged Meaning Behind the Word Thug, National Public Radio (Apr. 30, 2015) 24

Reply Brief of Appellant, *Pro-Football, Inc. v. Blackhorse*, No. 15-1874 (4th Cir. Mar. 18, 2016) 17

There Are Far More People Named Hitler than You'd Think, Vice.com (Sept. 22, 2014) 16

TTAB Manual of Practice § 303.03 (June 2016) 31

U.S. Copyright Office, *Copyright Basics* 15

U.S. Copyright Office, Sample Certification of Registration 20

INTEREST OF *AMICUS CURIAE* [1]

Amicus Pro-Football, Inc. (the "Team" or "Redskins") owns and operates the National Football League's Washington Redskins. The Team has a substantial interest in whether the disparagement clause in § 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), violates the First Amendment. In 2014, the PTO invoked § 2(a) to schedule the cancellation of six of the Team's Redskins trademark registrations on the theory that the trademarks disparaged Native Americans when the PTO registered the first mark in 1967. The U.S. District Court for the Eastern District of Virginia affirmed the cancellations. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015). The Team appealed; the case is fully briefed; and the Fourth Circuit has placed the appeal in abeyance pending this Court's decision here. *Pro-Football, Inc. v. Blackhorse*, No. 15-1874.

INTRODUCTION AND SUMMARY OF ARGUMENT

Section 2(a)'s ban on the registration of disparaging trademarks is facially unconstitutional. At minimum, the ban is unconstitutional as applied to the cancellation of existing registrations.

A. The disparagement clause triggers strict scrutiny. Trademarks are names, symbols, and logos that communicate powerful messages: they allow audiences to connect trademark owners with their

---

[1] No counsel for a party authored this brief in whole or in part. No one other than *amicus curiae*, its members, its member association, or *amicus*'s counsel made a monetary contribution intended to fund the preparation or submission of this brief. The parties have consented to the filing of this brief, and copies of the letters of consent are on file with the Clerk's Office.

goods or services. When the PTO registers a trademark, the PTO confers on the mark special legal status and legal protections from interference by third parties. The PTO acts as regulator in registering trademarks, just like the government acts as regulator when it issues patents or registers copyrights.

Denying legal protection to disfavored speech blatantly violates the First Amendment. The disparagement clause impermissibly discriminates on the basis of both disfavored content and viewpoint. The government expressly concedes that the clause is content-based. Br. 11, 36. The government also implicitly concedes that it is viewpoint-based. The government acknowledges that the clause targets only racial *slurs*, *crude* references to women's anatomy, and *demeaning* depictions of religious figures, while leaving unburdened speech that expresses a positive or neutral viewpoint on those same subjects. Br. 10, 28.

B. Section 2(a) fails even intermediate scrutiny. Congress did not pass the Lanham Act as civil rights legislation. The Act does not directly further the government's interest in protecting underrepresented groups from racial slurs, misogyny, or demeaning religious messages. If social justice were the goal, the disparagement clause overshoots it by a mile. The clause applies to *all* persons, institutions, and beliefs. The statute therefore equally protects racists, misogynists, and blasphemers from disparagement. The same is true for racist, misogynist, and blasphemous institutions and beliefs.

The PTO does not rigorously enforce the statute. And when it does, the PTO's actions are arbitrary and wildly inconsistent. *Amicus* regrets that it is necessary to use offensive language in a brief to this

Court. But reference to the range and pervasiveness of the PTO's startling registrations disproves that § 2(a) furthers significant government interests, that these registrations reflect merely occasional errors, and that the PTO applies the statute rationally and evenhandedly. The PTO has registered marks such as YARDAPES landscaping services; AFRO-SAXONS and DAGO SWAGG clothing; BAKED BY A NEGRO baked goods; CRIPPLED OLD BIKER BASTARDS clothing; YID DISH online dating newsletter; CRACKA AZZ SKATEBOARDS skateboards and apparel; RETARDIPEDIA entertainment services, and many more similar marks. The PTO has registered BOOBS AS BEER HOLDERS adult-themed videos and photos; VAJAYJAY HAT party hats; and MATCH-A-SNATCH playing cards. The Appendix contains additional examples, and is by no means exhaustive.[2]

These registrations similarly defeat the government's assertion that § 2(a) "avoid[s] the incorporation of objectionable marks into official government communications, and the consequent association of the marks with the government itself." Br. 11, 28. Over two million registered marks for countless goods and services render the Principal Register incapable of communicating any government message.

C. The government argues that although no "discrete analytic" category supports upholding § 2(a), this Court should combine government speech and subsidy principles to hold that trademark regis-

---

[2] The PTO has registered all marks appearing in this brief in small-cap font. The registrations in the Appendix appear in alphabetical order. These and other registrations are available by searching the PTO's database. *See* PTO, Trademark Electronic Search System, http://tmsearch.uspto.gov.

tration permits rank discrimination against disfavored speech. Br. 43. The government's brief refers to trademark registration 89 times as a government program, 26 times as government assistance, and 25 times as a government subsidy. But to our knowledge, in the 70 years since the passage of the Lanham Act, the PTO has never described trademark registration in any of these terms, or treated registrations as government speech.

Instead, the PTO aptly describes the registration process as a legal proceeding, and this Court has explained that registration confers legal status, protection, and rights. *B&B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293, 1299–1301 (2015). Legal proceedings and advantages are not government subsidies, much less platforms for government speech. The government's theory would open the floodgates to discrimination based on disfavored content, viewpoint, and speakers in other government-regulatory schemes, including copyright registration.

But the consequences would be staggering even were this Court to adopt a for-this-case-only theory of the First Amendment. Two million registered trademarks would overnight become government-subsidized names and government speech. Marks like those set forth in the Appendix, including YO' ASS FACE; I WORK HARD BITCH; TRANNY SURPRISE; SMACK MY ASS & CALL ME SALLY; RELIGION KILLS; SEX SENT ME TO THE SLAMMER; LAUGHING MY VAGINA OFF; ANAL FANTASY COLLECTION; BUSH PANTY; BLACKGIRLSDOPORN.COM; and TEENSDOPORN.COM, would have the full backing of, and bear the official seal of approval from, Uncle Sam. What's more, Uncle Sam would be the one speaking. The same would be true for all registered logos, such as numerous

confederate flags and lewd depictions of women's anatomy, including those on the registered marks SPANK ME CARDS.COM, RIDE DOGGIE STYLE, and EWHIP.COM. The PTO cannot, on its own initiative, rid the registry of these or similar registrations. Registration is thus not analogous to government speech. Either the PTO has unfettered control over the government's message, or registration does not reflect the government's message.

D. However the Court rules with respect to the PTO's *initial* refusal to register marks, § 2(a) cannot be constitutionally applied to *cancel* existing registrations. If the government cancels a registration because it historically may have disparaged a group, the government's purported interests in protecting the affected group or disassociating itself from disfavored speech are incoherent. Those interests relate to the impact that the mark has on the group *today*, not its historical impact. The chilling of speech and the upending of reliance interests are magnified exponentially when the mark owner has relied on the protections of registration in investing in its brand. And cancellation forces mark owners to defend against claims of historical offense when relevant witnesses may no longer be alive and key documents may no longer exist.

The Redskins' case illustrates the fundamental constitutional principles at stake. The Redskins are one of the most storied franchises in sports. The Team adopted the Redskins name in 1933, and the PTO registered six Redskins marks on six separate occasions from 1967 to 1990, without objection from anyone. Yet in 2014, the PTO granted a petition brought by five Native Americans to cancel the Team's registrations because the Redskins' name

may have disparaged an unspecified percentage of Native Americans starting in 1967. The PTO was indifferent to whether Native Americans today overwhelmingly do not find the name disparaging. Likewise, the PTO expressed no concerns with transmitting the Team's name abroad for half of a century.

Upholding the statute in the cancellation context would permit extraordinary abuses of government power. Anyone offended by a registered mark can seek cancellation, no matter the registration's age, no matter the number of times that the PTO previously registered the mark, and no matter the consequences to the owner's brand or consumers. Any person belonging to the referenced group can seek cancellation based on the mark's allegedly disparaging meaning in the past, whether or not the person was alive at the time of registration, whether or not any member of the group objected at the time of registration, whether or not anyone besides the person seeking cancellation currently finds the mark disparaging, whether or not the person ever purchased the mark's good or service, whether or not a foreign country ever complained about the mark, and whether or not relevant witnesses or pertinent records still exist. And the PTO will cancel the registration so long as the person shows that some unspecified percentage of the referenced group *may* have perceived, to some unspecified non-trivial degree, that the mark was unflattering to the group (or for that matter, to any institution or belief) when the mark was registered.

The constitutional guarantees of free speech and fundamental fairness prevent this kind of madness.

ARGUMENT

SECTION 2(a) VIOLATES THE FIRST AMENDMENT, PARTICULARLY IN THE CANCELLATION CONTEXT

Section 2(a) bars registration of trademarks that "may disparage . . . persons, living or dead, institutions, [or] beliefs . . . or bring them into contempt, or disrepute." 15 U.S.C. § 1052(a). That language facially discriminates against protected speech based on disfavored content and viewpoint and is thus unconstitutional. At a minimum, the clause cannot be constitutionally applied to cancel existing registrations.

A. Section 2(a) Triggers Strict Scrutiny

Registration of trademarks, like any registration scheme, is purely regulatory. As such, Congress cannot condition the "procedural and substantive legal advantages" guaranteed by the Lanham Act, *B&B Hardware*, 135 S. Ct. at 1300, on a requirement that the mark owner change its name. Such burdens trigger strict scrutiny, and the government has never argued that the statute survives this exacting standard.

1. Trademarks Are Fully Protected Speech

Trademarks are names that are expressive in their own right, and they enable mark owners to associate all of their other speech—commercial or otherwise—with their brands. Just as an individual needs a name to function at home, work, and in society, individuals and organizations rely on trademarks to communicate to the public when providing a good or service. Their very "function" is "psychological," *Mishawaka Rubber & Woolen Mfg. Co. v.*

S.S. Kresge Co., 316 U.S. 203, 205 (1942)—to "carry[] meaning," *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

Countless marks speak for themselves: AMBULANCE CHASERS SUCK; I HATE MY TEENAGE DAUGHTER; and STOP COMPLAINING ABOUT YOUR BABY DADDY, YOU PICKED HIM! But all marks are inherently expressive, whether or not the speaker is motivated by profit. HERSHEY'S and MERCEDES-BENZ signal a certain quality of chocolate or automobile. THE NEW YORK TIMES and FOX NEWS CHANNEL signal certain types of news. THE CHURCH OF JESUS CHRIST OF LATTER-DAY SAINTS, MARCH OF DIMES, NATIONAL RIFLE ASSOCIATION, and REPUBLICAN NATIONAL COMMITTEE communicate certain religious, charitable, or political missions. HARVARD UNIVERSITY signals the source and quality of educational services.

The expressive value of marks is readily apparent for respondent's and the Team's marks for entertainment services. Entertainment is inherently expressive, and entertainers' names are inextricably intertwined with the entertainment services they provide. Names are powerful. The marks THE 2 LIVE CREW and NEW YORK PHILHARMONIC conjure up very different emotions and associations with music. The same is true for the names of sport teams, ballets, musicals, or improvisational comedies.

That mark owners act for a profit is of no moment. "Some of our most valued forms of fully protected speech are uttered for a profit." *Bd. of Trs. of the State Univ. of N.Y. v. Fox*, 492 U.S. 469, 482 (1989); *see, e.g., N.Y. Times Co. v. Sullivan*, 376 U.S. 254 (1964). It is thus irrelevant that registration requires that trademarks be "in use in commerce." 15 U.S.C. § 1051(a)(3)(C). Neither Congress's exercise

of Commerce Clause power nor an owner's profit motive insulates government burdens on speech from strict scrutiny. For instance, *United States v. Stevens* applied strict scrutiny to a statute criminalizing depictions of animal cruelty "done for 'commercial gain' in interstate or foreign commerce." 559 U.S. 460, 464–65 (2010) (quoting 18 U.S.C. § 48). For-profit companies also use their registered names to engage in *non*-commercial speech. *Nike, Inc. v. Kasky*, 539 U.S. 654, 656 (2003) (Stevens, J., concurring in dismissal of the writ).

In any event, countless non-profit organizations use registered trademarks to engage in purely political, religious, or similar speech not for profit. EVANGELICAL LUTHERAN CHURCH IN AMERICA, SOUTHERN POVERTY LAW CENTER, MEXICAN AMERICAN LEGAL DEFENSE AND EDUCATIONAL FUND, and UNITED STATES HOLOCAUST MEMORIAL MUSEUM are but a few. Although these non-profits must use their marks in commerce to obtain registration, they do not communicate with a commercial purpose or in a commercial capacity. Religious, charitable, political, and other non-profit speakers receive the federal protections that come from registration because these speakers use their marks across state lines. And because this case involves a facial challenge, the government must show that regulatory burdens on these marks would not trigger strict scrutiny. *Stevens*, 559 U.S. at 472–73.

Regardless of the type of mark at issue, § 2(a) "is squarely based on the expressive aspect of the speech, not its commercial-speech aspects." Pet. App. 61a–62a. The PTO looks to whether a mark disparages a referenced group, over and above the mark's source-identification function. And even

when marks operate purely in the commercial arena, because § 2(a) discriminates against viewpoint, *see infra* pp. 12–13, the disparagement clause is subject to at least "heightened scrutiny." *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011).

Several *amici* argue that trademarks deserve less protection because trademarks prevent third parties from speaking freely. *See, e.g.*, Brief for *Amici* Blackhorse et al. 9–12; *cf.* Gov't Br. 40. But trademark law prevents speech that causes consumer confusion or constitutes theft of intellectual property. The First Amendment does not protect speech that misleads consumers. *Illinois ex rel. Madigan v. Telemarketing Assocs., Inc.*, 538 U.S. 600, 612 (2003). It similarly "gives no right to steal another's statutorily protected intellectual property." *Walt Disney Co. v. Powell*, 698 F. Supp. 10, 12 n.2 (D.D.C. 1988); *see Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985); *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

Judge Dyk opined below that trademarks involve only commercial speech unless the mark communicates "core political expression" such as respondent's mark. Pet. App. 103a (Dyk, J., concurring in part and dissenting in part). The decision below explained that respondent seeks, through the name of his all Asian-American band, to reclaim a slur as a source of pride. *Id.* at 10a. The government rightly disavows Judge Dyk's approach as impermissibly viewpoint-based. Br. 46–47 n.12.

Such a distinction is also unconstitutionally *speaker*-based. *Sorrell*, 564 U.S. at 580. The PTO cannot treat two speakers differently depending on the speaker's motivation for choosing the name. Serious equal-protection concerns likewise would be

triggered if the government provided legal protection to disparaging names only when the mark owner belongs to the referenced group. The distinction also would be impossible to administer. What if one non-Asian-American joined The Slants. Two? And would the government be required to accept the mark owner's representation as to motive for choosing the name?

2. *Section 2(a) Impermissibly Burdens Disfavored Speech*

Registering trademarks—just like registering copyrights or issuing patents or video-poker licenses—is regulatory in nature and does not give rise to any proprietary government interest. *Cleveland v. United States*, 531 U.S. 12, 23–24 (2000). In exchange for meeting statutory criteria, the government confers on registered marks "legal rights" and "legal advantages" to "protect" those marks against interference from third parties. *B&B Hardware*, 135 S. Ct. at 1299–1301 (quotation marks omitted). The PTO similarly advises the public that registration is a "legal proceeding."[3]

Because registration is regulatory, this case is straightforward. "Content-based laws—those that

---

[3] *See, e.g.*, PTO, *Trademark Basics*, https://www.uspto.gov/trademarks-getting-started/trademark-basics ("The trademark registration process is a legal proceeding[.]"); PTO, *Basic Facts About Trademarks*, https://www.uspto.gov/sites/default/files/trademarks/basics/printable_transcript_Trademark_Basics_presentation.doc ("[T]he trademark registration process is pretty complex. It is, technically, a legal proceeding[.]"); PTO, *Do I Need a Trademark Attorney?*, https://www.uspto.gov/trademarks-getting-started/using-legal-services/do-i-need-trademark-attorney ("The filing of a trademark application begins a legal proceeding[.]").

target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests." *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015). "Government discrimination among viewpoints . . . is a more blatant and egregious form of content discrimination." *Id.* at 2230 (quotation marks omitted). The First Amendment "stands against attempts to disfavor certain subjects or viewpoints." *Citizens United v. Fed. Election Comm'n*, 558 U.S. 310, 340 (2010). And because the government has never argued that § 2(a) satisfies strict scrutiny, the statute is facially unconstitutional if it is either content- or viewpoint-based.

Section 2(a)'s bar on registering disparaging marks is content-based because it is a "speech regulation targeted at specific subject matter." *Reed*, 135 S. Ct. at 2230. Section 2(a) is viewpoint-based because it facially regulates speech based on a "particular point of view," *FCC v. League of Women Voters of Cal.*, 468 U.S. 364, 383–84 (1984), *i.e.*, the statute "discriminate[s] among viewpoints within [a] subject matter." *Reed*, 135 S. Ct. at 2230; *see* Pet. App. 21a–24a.

The government's brief concedes the former (at 11, 36) and inadvertently demonstrates the latter. The brief explains that § 2(a) bars registration of "marks containing *crude* references to women based on parts of their anatomy; the most repellent racial *slurs* and white-supremacist slogans; and *demeaning* illustrations of the prophet Mohammed and other religious figures." Br. 10, 28 (emphases added). Exactly. The words "crude," "slurs," and "demeaning" are unabashedly and paradigmatically viewpoint-based.

Section 2(a) does not target *all* references to women, *all* references to women's body parts, *all* commentary on race, or *all* depictions of religious figures. Rather, § 2(a) burdens speech only if and when it conveys a negative viewpoint towards the subject matter at issue. The statute targets viewpoint in its most injurious form: it bars registration of marks that express a critical opinion or perspective. *Id.* Accordingly, § 2 "driv[es] ideas from the market place." Gov't Br. 48.

The government argues that § 2(a) is viewpoint-neutral because it operates without regard to "the ideology, opinion, or perspective of the trademark owner." Br. 46 (quotation marks omitted). But that is non-responsive. The statute still discriminates on the basis of viewpoint. Section 2(a) bars registration based on the "ideology, opinion, or perspective" that the mark purportedly *expresses* to the referenced group. "It is thus the viewpoint of the message conveyed which causes the government to burden the speech." Pet. App. 23a.

3. This Court's Precedents Foreclose the Government's "But You Can Still Speak" Argument

Citing the text of the First Amendment, the government argues that § 2(a) "does not abridge respondent's freedom of speech" because "it does not restrict [his] ability to use [his] mark or to engage in any other speech." Br. 25–26. As such, the government argues that § 2(a) "is reviewed for a rational basis." Br. 48. But speech is restricted whenever the government denies protection to disfavored speech. Section 2(a) forces mark owners to change their names and brand identities to obtain the legal protections of registration. This is precisely what the First Amendment is designed to prevent. The gov-

ernment's theory would gut this Court's First Amendment jurisprudence and open up any number of regulatory programs, such as copyright registration, to discrimination based on disfavored content, viewpoint, and speakers.

The First Amendment's exacting scrutiny applies to regulatory burdens as well as outright bans on speech. The "government offends the First Amendment when it imposes financial burdens on certain speakers based on the content of their expression." *Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 828 (1995). "[T]he distinction between laws burdening speech is but a matter of degree[,] . . . and the Government's content-based burdens must satisfy the same rigorous scrutiny as its content-based bans." *Sorrell*, 564 U.S. at 565–66 (quotation marks omitted). "The threat to the First Amendment arises from the imposition of financial burdens that may have the effect of influencing or suppressing speech, and whether those burdens take the form of taxes or some other form is unimportant." *Pitt News v. Pappert*, 379 F.3d 96, 111–12 (3d Cir. 2004) (Alito, J.).

Sorrell invalidated a state law that did not abridge speech but nonetheless burdened pharmaceutical marketing by denying manufacturers access to, and the right to use, information that made their marketing more effective. After referencing burdens over 30 times, *Sorrell* held that "the State has burdened a form of protected expression," while leaving "unburdened those speakers whose messages are in accord with its own views." 564 U.S. at 580; *see also Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 115 (1991); *Ark. Writers' Project Inc. v. Ragland*, 481 U.S. 221, 227–

28 (1987); *Minneapolis Star & Tribune Co. v. Minn. Comm'r of Revenue*, 460 U.S. 575, 582–83 (1983). Moreover, as explained in *Sorrell*, 564 U.S. at 568–69, eight Justices in *Los Angeles Police Department v. United Reporting Publishing Corp.*, 528 U.S. 32 (1999), endorsed the principle that the First Amendment bars governments from denying generally available benefits based on content or speakers.

The government's "but you can still speak" theory has no logical stopping point and would insulate numerous denials of regulatory benefits from any First Amendment scrutiny. Take the similarities between copyright and trademark registration. "[R]egistration is not a condition of copyright protection" but only "provides several . . . advantages." U.S. Copyright Office, *Copyright Basics* 7, http://copyright.gov/circs/circ01.pdf. Cancelling a registration leaves copyright owners free to perform or sell their works. Cancellation neither restricts nor prevents copyright owners from expressing any message. Or in the government's words (at 26), cancelling respondent's copyright registrations would "not limit . . . what songs he may sing, how he may advertise, or what messages he may convey, through his band or in his own private speech." Indeed, trademarks and copyrights can protect the same speech, like Mickey Mouse, "crude" depictions of women's anatomy, or "demeaning illustrations of the prophet Mohammed." Gov't Br. 10, 28.

The government's position would permit it to penalize disfavored speakers by refusing to issue parade permits, repair roads or remove snow around their businesses, or provide fire or police protection. The same goes for birth certificates or any other registration or recordation scheme. States could cancel

the birth certificates of Joe Slants (or Joe Redskins) for any or no reason, without triggering First Amendment review. *Cf. There Are Far More People Named Hitler than You'd Think*, Vice.com (Sept. 22, 2014), http://www.vice.com/read/meet-the-hitlers-matt-ogens-interview-183. In all these cases, the First Amendment would be triggered even though the speakers can still communicate their views.

The government argues (at 26) that § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), gives limited protections to unregistered marks. That misses the point. Registration confers significant *additional* legal protections, and "[t]he loss of these rights, standing alone, is enough" to trigger the First Amendment. Pet. App. 40a. Indeed, if trademark registration did not confer more protection than § 43, no one would register their trademarks.

B. Section 2(a) Fails Even Intermediate Scrutiny

Even were this Court to apply intermediate scrutiny under *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*, § 2(a) does not directly advance a substantial governmental interest. 447 U.S. 557, 564–66 (1980); *see Sorrell*, 564 U.S. at 571–72.

1. Section 2(a) Cannot Be Justified As Protecting Underrepresented Groups

The government erroneously argues that § 2(a) protects underrepresented groups from demeaning messages. Br. 10, 28, 48.

Disapproval of speech or desire to prevent offense is "classically not a justification" for burdening speech, much less a substantial interest. *Bolger v.*

Youngs Drug Prods. Corp., 463 U.S. 60, 71–72 (1983) (alterations omitted); *Snyder v. Phelps*, 131 S. Ct. 1207, 1219–20 (2011); *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 55 (1988).

The disparagement clause is not designed to promote racial or social justice. Congress was not concerned with protecting underrepresented groups when it enacted § 2(a) in 1946. Congress instead worried about "Abraham Lincoln gin" and marks that disparaged "people of eminence" and institutions like "Harvard" and the "New York Athletic Club." *Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the H. Comm. on Patents*, 76th Cong. 18–21 (1939) (*Hearings*). The statute refers to *all* "persons, living or dead," "beliefs," or "institutions." 15 U.S.C. § 1052(a). The government interprets the statute to protect not just minority groups, but also any well-represented group, including politicians, billionaires, birders, bookworms, blondes, lawyers, and vegetarians. Gov't Br. 24–25, 46.[4]

The statute thus extends beyond groups that society admires, such as teachers, librarians, and clergy. The statute equally protects racists, white supremacists, misogynists, fascists, xenophobes, terrorists, and dictators. The government cannot justify § 2(a) as combatting racism if the statute protects racists. Similarly, because § 2(a) applies to "beliefs," the statute bars registration of marks that disparage

---

[4] The Team agrees with respondent that § 2(a) applies only to identifiable persons, not to groups as a whole. Resp. Br. 46–53. At a minimum, principles of constitutional doubt command a narrowing construction. *See* Opening Brief of Appellant at 45–46, *Pro-Football, Inc. v. Blackhorse*, No. 15-1874 (4th Cir. Oct. 30, 2015); Reply Brief of Appellant at 21–23, *Pro-Football, Inc. v. Blackhorse*, No. 15-1874 (4th Cir. Mar. 18, 2016).

racism and white supremacy. The same would be true for marks that disparage racist and white supremacist "institutions."

Section 2(a) does not directly protect underrepresented groups. Disparaging speech abounds on the Internet and in books and songs bearing government-registered copyrights. *Amici* Blackhorse et al. (at 20–21) reprint pre-1946 registered racist logos. But the PTO never cancelled those registrations as disparaging. The government has not shown that § 2(a), as opposed to changed times and the marketplace, prevents similar registrations today or that comparable marks would return in droves absent § 2(a). And civil rights laws, not the Lanham Act, are designed to prevent such speech from interfering with access to public accommodations and employment.

The PTO has registered countless marks that meet the government's exceptionally broad definition of disparagement, *i.e.*, potentially demeaning to even a small segment of a race, gender, or religious group. Just for musical bands, the PTO has registered WHITE TRASH COWBOYS; WHORES FROM HELL; N.W.A.; CHOLOS ON ACID; REFORMED WHORES; THE POP WHORES; HOOKERS & BLOW; THE ROAST BEEF CURTAINS; FLEA MARKET HOOKERS; THE PRICKS; and BARENAKED LADIES. As to religion, the PTO has registered marks such as BUDDHA BELLY KITCHEN granola snacks and KILL THE BUDDHA apparel. The Appendix contains more examples of disparaging marks, many of which were registered well after the PTO refused to register respondent's mark in 2012 and ordered the cancellation of the Redskins registrations in 2014.

The government acknowledges (at 52) that "errors may occasionally occur." Such euphemistic understatements provide no excuse. In the First Amendment context, "good enough for government work" is not a defense. In any event, the examples are far too numerous to write off as inadvertence. The government presumably does not know how many registered marks meet the PTO's loose definition of disparagement. Nor does the government indicate what error rate would render its argument meritless.

2. Section 2(a) Cannot Be Justified As Preventing Government Association

Section 2(a) likewise does not directly further the government's interest in preventing its association with certain marks. Gov't Br. 11, 28, 36–39, 49–50. The government offers no evidence that the public associates registration with the government. It hardly needs much explanation to conclude that the public does not associate the government with marks such as THE HEBREW HILLBILLY: FIFTY SHADES OF OY VEY; ASS FACE DOLLS; or NAZI WEREWOLVES FROM OUTER SPACE. But the same is true for all marks. No one associates the government with the names of the music bands listed above, nor with CIRCLE JERKS; DEAD KENNEDYS; SEX PISTOLS; WIMPY DICKS; STEELY DAN; or LIMP BIZKIT. No one thinks about the government when buying NIKE shoes, surfing GOOGLE, or watching NATIONAL FOOTBALL LEAGUE games. Many marks, such as ACLU and NATIONAL RIFLE ASSOCIATION, represent organizations that regularly oppose government regulation.

Consumers have no idea whether marks are "registered" or what that legalese means. "The purchasing public knows no more about trademark registra-

tions than a man walking down the street in a strange city knows about legal title to the land and buildings he passes." *Application of Nat'l Distillers & Chem. Corp.*, 297 F.2d 941, 949 (C.C.P.A 1962) (Rich, J., concurring); *Application of Helene Curtis Indus., Inc.*, 305 F.2d 492, 494 (C.C.P.A. 1962) ("We will not assume any knowledge on the part of the purchasing public of mere registrations in the Patent Office[.]"). Mark owners are not required to use the ®, and many (including both respondent and the Team) do not.

Further, like trademark registrations, patents are "issued in the name of the United States of America," "under the seal of the United States Patent and Trademark Office," and must be "signed by the Director" of the PTO. 35 U.S.C. § 153. Copyright registrations issue under the "Seal of the United States Copyright Office" and are signed by the "Register of Copyrights, United States of America." U.S. Copyright Office, Sample Certification of Registration, *available at* http://www.copyright.gov/docs/certificate_sample-1-21-05.pdf. But no one thinks that the government approves, or is associated with, every patented invention or registered copyright.

The government's argument, moreover, becomes a self-fulfilling prophecy. No one today thinks that registration reflects government approval or association. But if this Court holds that it does, how will the government explain its approval of all two million registrations for every conceivable good or service? *See, e.g.*, App. A. The same would be true for every copyrighted work or patented invention.

The government's brief observes that it transmits the names of registered marks abroad. Br. 10, 12, 22, 24, 28, 37, 39, 50. But not one instance is identi-

fied where a foreign country complained to the PTO about any proposed, existing, or past registration. Nor has the government asserted that foreign countries share the PTO's view of disparagement or that the PTO considers the views of foreign countries when registering marks. The statute is not designed to further foreign policy goals. The statute permits registrations that disparage foreign countries or even continents, *e.g.*, MADE IN CHINA, FIXED IN AMERICA; NUDEAFRICA; and NOTHINGMADEINCHINA.COM. And the PTO has registered marks such as CRAZY ITALIANS and THE MEXICAN MAFIA.

3. PTO's Arbitrary Application of § 2(a) Undercuts the Government's Asserted Interests

The government's wildly inconsistent and arbitrary enforcement of § 2(a) further belies the government's asserted interests. Arbitrariness is inherent in the disparagement clause. The PTO's Assistant Commissioner presciently informed Congress in 1939 that "the word 'disparage' . . . is going to cause a great deal of difficulty in the Patent Office, because . . . it is always going to be just a matter of the personal opinion of the individual parties as to whether they think it is disparaging." *Hearings* at 21.

The PTO explains: "[T]he guidelines for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one." *In re In Over Our Heads*, 16 U.S.P.Q.2d 1653, *1 (T.T.A.B. 1990) (brackets and quotation marks omitted). The PTO similarly observes that whether a mark is disparaging "is highly subjective and, thus, general rules are difficult to postulate." *Harjo v. Pro-Football, Inc.*, 50

U.S.P.Q.2d 1705, *35 (T.T.A.B. 1999). Prior registrations that are "similar to the applicant's . . . do[] not bind the [PTO]." *In re Heeb Media LLC*, 89 U.S.P.Q.2d 1071, *9 (T.T.A.B. 2008).

Not surprisingly, PTO decisions are arbitrary, unpredictable, and without rhyme or reason. The government cannot explain why REDSKINS disparages Native Americans but the following registered marks, all with Native American caricature logos, do not: RED MAN chewing tobacco; CHEROKEE RED soft drinks; BIG CHIEF beef jerky; BIG CHIEF snack foods; INDIAN MOTORCYCLE apparel and motorcycles; INDIAN RIVER TRANSPORT tankers; APACHE POWERBOATS apparel; APACHE bikes; EL APACHE bingo cards; FORT APACHE musical recordings; and ESKIMO JOE'S restaurant.

The PTO also cannot explain why the name The Slants for an all Asian-American rock band disparages Asian-Americans but YELLOWMAN for a tattoo-inspired clothing line founded by an Asian-American does not. L. Munoz, *Wearing Pride on Sleeve*, L.A. Times, Jan. 17, 2008, *available at* http://articles.latimes.com/2008/jan/17/business/fi-petermui17 ("With his YellowMan brand, [designer Peter] Mui has taken a slur and turned it on its head.").

The government acknowledges (at 51) that "superficially similar marks" might be justifiably distinguished based on context or the passage of time, but does not argue that such distinctions explain any identified inconsistency. The government will not even say what *was* a mistake. Should any of the immediately preceding marks have been registered? The PTO has registered numerous marks bearing the word redneck, whose "usage . . . now includes any racist white." *The Racial Slur Database*, www.rsdb.

org/search/redneck. Take AMERICAN REDNECK SOCIETY, a social club "promoting the interest of hard-working, proud Americans"; REDNECK GANGSTA apparel; REDNECK ARMY apparel; REDNECK DEBUTANTE books; REDNECK WOMAN underwear; REDNECK CHICKS apparel; REDNECK RECORDS music; REDNECK stickers; and REDNECK BIKINI swimwear. Were any of these marks mistakenly registered? All? Some? Why?

The Federal Circuit rightly "s[aw] no rationale for the PTO's seemingly arbitrary registration decisions." Pet. App. 33a n.7. That the PTO examines many trademarks does not excuse arbitrariness, Gov't Br. 51, but rather underscores the immense consequences. Contrary to the Government's argument (*id.*), moreover, agencies cannot defend against arbitrary enforcement by preemptively declaring that they will act arbitrarily. In the face of rampant inconsistencies, § 2(a)'s disparagement clause fails *Central Hudson*. *See Greater New Orleans Broad. Ass'n v. United States*, 527 U.S. 173, 190 (1999).

The government observes (at 52) that "erroneous registrations" may be "corrected through the process of administration cancellation." But the Act provides only for private parties or the Federal Trade Commission (FTC) to initiate cancellation. 15 U.S.C. §§ 1064, 1067; *infra* p. 29. To our knowledge, the FTC—whose mandate is to promote competition—has never sought to cancel a trademark registration for being disparaging. And the government cites no instance where the PTO cancelled a registration *sua sponte* for being disparaging or offensive. In other words, the PTO, on its own initiative, cannot cancel registrations. Thus, unless and until someone petitions for cancellation, disparaging marks remain reg-

istered *in perpetuity*. It is oxymoronic, however, to label registrations government speech if disassociation substantially depends on the action of private parties. Either the government has unfettered control over its own speech, or registration is not government speech.

It is also perverse for the government to invoke the protection of disadvantaged groups while imposing on those very groups the costly and burdensome responsibility of cleaning up the registry when the PTO doesn't get it right. For instance, women may have better things to do with their time and money than explain to PTO officials that BUCKSLUT is a crude, misogynist reference to oral sex, or that the acronym in FUPA POUCH is offensive. Nor should African-Americans have to explain to the PTO that the word "thug" in THUG PORN or THUG ARMY has a racial meaning. *See The Racially Charged Meaning Behind the Word Thug*, National Public Radio (Apr. 30, 2015), http://www.npr.org/2015/04/30/403362626/the-racially-charged-meaning-behind-the-word-thug ("[T]hug today is a nominally polite way of using the N-word.").

C. Registration Is Neither Government Speech Nor a Subsidy

1. The government asserts that "the government-speech doctrine . . . is implicated here because owners of registered marks are issued certificates in the name of the United States, and the government publishes the marks and transmits registration information to foreign countries." Br. 12. But registrations, of which there have been over three million in total since 1870, have never communicated a government message or been associated with the government. *See infra* pp. 26–28; *cf. Walker v. Tex.*

Div., Sons of Confederate Veterans, Inc., 135 S. Ct. 2239, 2248 (2015) (state license plates); *id.* at 2255, 2257, 2261 (Alito, J., dissenting) (noting Texas has "more than 350" types of specialty plates). Registration is "designed to facilitate private speech, not to promote a governmental message." *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 542 (2001).

That registration is reflected on a piece of paper issued by the government is insufficient to convert private speech into government speech. "If being listed in a government database or published in a list of registrations were enough to convert private speech to government speech, nearly every action the government takes—every parade permit granted, every property title recorded, every hunting or fishing license issued—would amount to government speech." Pet. App. 45a. "The government could record recipients of parade permits in an official database or publish them weekly, thus insulating content-based grants of these permits from judicial review." *Id.* And the government's position would convert all two million registrations, covering marks created by a diverse society for countless goods and services, into government-endorsed speech. *See infra* pp. 26–28.

The government's reliance on *Rust v. Sullivan*, 500 U.S. 173 (1991), is also misplaced. *Rust* permits the government to engage in viewpoint discrimination when it uses private parties to express the government's own message. *Velazquez*, 531 U.S. at 541. *Rust* upheld a Title X provision barring clinics receiving federal funds for family-planning services from advocating abortion. 500 U.S. at 192–95. Although "*Rust* did not place explicit reliance on the rationale that the counseling activities of the doctors

under Title X amounted to governmental speech; when interpreting the holding in later cases . . . [the Court has] explained *Rust* on this understanding." *Velazquez*, 531 U.S. at 541.

The PTO does not use mark owners "to transmit specific information pertaining to [the PTO's] own program." *Id.* Upholding § 2(a) under *Rust* would permit rank viewpoint discrimination. One administration would be free to cancel registrations for NATIONAL ABORTION FEDERATION and NARAL PRO-CHOICE AMERICA as disparaging toward pro-life "beliefs," and another administration would be free to cancel registrations for ABORTION MUST END NOW and REAL FEMINISTS ARE STILL PRO-LIFE as disparaging to pro-choice "beliefs." 15 U.S.C. § 1052(a).

2. Invoking the word "program" almost 90 times in its brief, the government labels trademark registration a government program to shoehorn the PTO's regulation into this Court's subsidy cases. But "[t]he Supreme Court has never extended the subsidy doctrine to situations not involving financial benefits." *Autor v. Pritzker*, 740 F.3d 176, 183 (D.C. Cir. 2014); *accord Dep't of Tex., Veterans of Foreign Wars of the U.S. v. Tex. Lottery Comm'n*, 760 F.3d 427, 436 (5th Cir. 2014); *Bullfrog Films, Inc. v. Wick*, 847 F.2d 502, 509 (9th Cir. 1988). The Court's subsidy cases involve financial assistance: tax exemptions (*Regan v. Taxation With Representation of Wash.*, 461 U.S. 540 (1983)); funding to fight AIDS (*Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321 (2013)); and Medicaid reimbursement for abortion (*e.g.*, *Harris v. McCrae*, 448 U.S. 297 (1980)). Cases like *Davenport v. Washington Education Association* involved "the unique context of public-sector agency-shop arrangements," where the

government, as employer, "act[s] in a capacity *other than as regulator*." 551 U.S. 177, 188, 190 (2007) (emphasis added); *accord Ysursa v. Pocatello Educ. Ass'n*, 555 U.S. 353 (2009).

Trademark registration is just like the regulatory registration of copyrights and patents, and fundamentally differs from anti-AIDS funding, Medicaid, and tax exemptions. This Court already has assumed that the patent system is regulatory. *Cleveland*, 531 U.S. at 23–24. The government has no basis for distinguishing the trademark system. The Lanham Act, just like the Copyright Act and Patent Act, is not a grant or funding statute. Trademark owners, just like copyright and patent owners, are neither government employees nor grant recipients.

The government cites no instance where any court has treated a self-described "legal proceeding" (*supra* p. 11 n.3) as a government subsidy. The registration process does not operate like a subsidy: any person who believes that he will be damaged by a registration may file an opposition with the PTO, 15 U.S.C. § 1063; and either the applicant or opposing party may seek a trial-like administrative appeal before the PTO's Trademark Trial and Appeal Board (TTAB), *id.* § 1070, with a subsequent right to judicial review, *id.* § 1071. Likewise, the benefits conferred by registration are legal rights. *Supra* p. 11. A legal right is not a subsidy, as that term has ever been understood. Legal protections for trademarks are less of a subsidy than taxpayer-funded police and fire protection for rallies. The government's position sweeps within the subsidy doctrine "every benefit or regulatory program provided by the government." Pet. App. 58a.

Even were registrations subsidies, § 2(a) is still unconstitutional because it is viewpoint-based. The government may not discriminate based on viewpoint in the "provision of financial benefits." *Rosenberger*, 515 U.S. at 834 (citing *Regan*, 461 U.S. at 548); *see, e.g.*, *Velazquez*, 531 U.S. at 548–49; *NEA v. Finley*, 524 U.S. 569, 587–88 (1998).

The disparagement clause is independently invalid because disparagement is not related to a trademark's function, operation, and purpose. Disparaging marks prevent consumer confusion and secure to owners the fruits of their investments every bit as much as non-disparaging marks. Under the government's theory, moreover, Congress could withhold registration based on content that also has nothing to do with the function of trademarks. The government could deny registration for goods it disfavors (*e.g.*, guns, fast food); services that risk injury (*e.g.*, sports, skydiving); goods that appeal to prurient interests (*e.g.*, sex toys, pornography); or marks that touch upon controversial topics regardless of viewpoint (*e.g.*, abortion, gun control).

Section 2(a) also burdens disfavored expressions in ways that denying subsidies does not. People who are denied subsidies have "a ready work-around to maintain private speech without significant disadvantage," whereas "[m]ark-holders cannot . . . realistically have two brand names." Pet. App. 52a. For instance, the owners of the registered marks DONALD TRUMP, YO-YO MA, ITZHAK PERLMAN, TAYLOR SWIFT, JENNIFER LOPEZ, JAY-Z, ADELE, CHER, MADONNA, and MARTHA STEWART cannot readily change their names.

D. Section 2(a)'s Application in the Cancellation Context Is Independently Unconstitutional

The Lanham Act permits a petition for cancellation by "any person who believes that he is or will be damaged . . . by the registration of a mark on the principal register." 15 U.S.C. § 1064. An adversarial proceeding before the TTAB then ensues, *id.* § 1067, after which the losing party may seek judicial review, *id.* § 1071. When a party seeks cancellation of a registration for being disparaging, the PTO asks whether the mark was disparaging when registered, not whether it is disparaging today. *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, *10, *28–29 (T.T.A.B. 2014). Even were § 2(a)'s disparagement clause constitutional for initial refusals to register, the clause is plainly unconstitutional in the context of cancellation.

1. Cancellation Does Not Further the Government's Asserted Interests

The government's purported interests in protecting the affected group and disassociation from the mark are nonsensical in the cancellation context. The PTO never considers the meaning of the mark today; how the mark impacts the affected group; or whether any foreign country deems the mark disparaging.

For instance, the PTO granted the petition to cancel the Redskins registrations not because they disparage anyone today, but because the marks supposedly disparaged Native Americans 50 years ago, starting in 1967, when the government first registered the marks. *Id.* at *1. The PTO determined that the five Native American petitioners opposed the name, *id.* at *14, but did not otherwise consider

whether any of the other five million Native Americans today find the name disparaging. Nor did the PTO determine what foreign countries today think of the name.

Cancellation *today* does not further any legitimate government interest based on Native Americans' perception of the mark a half century ago. *Today*, the vast majority of Native Americans do not find the name offensive. A Washington Post poll this year found that "[n]ine in 10 Native Americans say they are not offended by the Washington Redskins name." J.W. Cox et al., *New Poll Finds 9 in 10 Native Americans Aren't Offended by Redskins Name*, Wash. Post, May 19, 2016. And "a 2004 poll by the Annenberg Public Policy Center found the same result." *Id.* Nor could cancellation conceivably further any need to disassociate the government from the Redskins name or to avoid transmitting the name abroad.

2. Cancellation Imposes Far Greater Burdens on Mark Owners

The burdens imposed by § 2(a) are exponentially magnified with cancellation. The government invites anyone who thinks a disparaging mark has been erroneously registered to petition the PTO to cancel the registration. This is an astonishing proposition. Delegating to over 300 million private citizens the authority to trigger the cancellation of up to two million registrations based on their subjective view of what is offensive is unconstitutional in its own right. The First Amendment does not tolerate a "heckler's veto" where the most sensitive of listeners dictate the propriety of speech for the rest of us. *E.g.*, *Good News Club v. Milford Cent. Sch.*, 533 U.S. 98, 119 (2001); *Reno v. ACLU*, 521 U.S. 844, 880 (1997).

Similarly, "[t]o arm millions of private citizens with such potent relief . . . unacceptably chills speech." Brief of the United States at 25, *Nike, Inc. v. Kasky*, 539 U.S. 654 (2003) (No. 02-575).

Mark owners can reasonably expect that competitors or those who want to infringe a mark may seek cancellation of a registration because the mark does not meet the criteria for being a trademark. But it is a different proposition altogether to expect that anyone who claims to be offended by a name may seek cancellation, at any time, even if no one opposes the name now except the person bringing the petition. 15 U.S.C. § 1064. To our knowledge, of the over three million trademarks registered since 1870, the PTO has never granted a petition to cancel any other registration for being disparaging or offensive. This bears repeating: the Redskins are the first and only mark owner that the PTO has retroactively singled out for cancellation under the disparagement clause (or even the scandalous clause).

It is mindboggling to think the public can challenge any and all two million active trademark registrations that may disparage any and all groups (living or dead), any and all beliefs, and any and all institutions. For instance, CAPITALISM SUCKS DONKEY BALLS, AUTHORITY SUCKS, PESSIMISM SUCKS, WORK SUCKS, PEOPLE SUCK, DEAD PEOPLE SUCK, CHEATERS SUCK, NEGATIVE PEOPLE SUCK, and YOU SUCK! are all registered. DUMB BLONDE and MEN ARE STUPID are registered too. A challenger need not show any "personal interest . . . beyond that of the general public" or "actual damage" to "establish standing or to prevail in [a] . . . cancellation proceeding." TTAB Manual of Practice § 303.03 (June 2016) (quotation marks omitted).

The potential for unfairness is breathtaking. Section 2(a) vests 300 million private citizens and PTO officials with unprecedented power to act arbitrarily, retroactively, and without warning, regardless of the harm to mark owners, brands, or consumers who trust and rely on brands. Even as applied to initial refusals to register, § 2(a) seriously chills speech by "creat[ing] a serious disincentive to adopt a mark which the government may deem offensive or disparaging." Pet. App. 31a. But the threats to speech are enormous if registrations can be cancelled after the fact at any time. In the cancellation context, § 2(a) would upend decades of "investment-backed brand development." *Id.* Faced with the prospect of cancellation after decades of investment, people and companies will eschew potentially controversial names.

The Redskins' case vividly illustrates how perniciously cancellation works. The Team adopted the Redskins name in 1933, and the PTO registered six Redskins marks on six separate occasions from 1967 to 1990. On each of the six occasions spanning these 23 years, no member of the public or Native American community objected. No one. And not once did the PTO suggest that the marks disparaged anyone.

The Team has invested tens of millions of dollars in advertising and promoting its brand. *Pro-Football, Inc. v. Blackhorse*, No. 15-1874 (4th Cir.), SA12, SA30–31, SA63–69. According to public reports, as of August 2014, the Team was valued at $2.4 billion, approximately $214 million of which is attributable to the Redskins brand. *Id.*, JA240–46. Yet, the PTO in 2014 cancelled all six registrations on the theory that the Team's name may have disparaged some unspecified percentage of Native

Americans starting in 1967. In other words, the PTO announced that it would withdraw the legal protections the federal government had been providing to the Team for over fifty years.

But by the time the PTO forced the Team in 2014 to defend its marks, key witnesses were long deceased, and key records were long gone. Had the Team known in 1967 that the PTO would take this unprecedented step decades later, the Team could have conducted contemporaneous surveys of Native Americans, preserved relevant documents, or secured testimony from witnesses, such as Team owners, Native Americans who played on the Team, former Presidents, tribal leaders, tribal representatives, and officials from the Bureau of Indian Affairs who attended Team games and supported the name.

The government has never explained how arbitrary action like this can happen in America. If the Redskins marks were disparaging by 1967, why did the PTO repeatedly register them six times over more than two decades? Why was there no contemporaneous objection to the PTO—from anyone? By 1967, the Redskins had won two NFL championships. Native Americans, like all Americans, presumably knew of the Team, as did the PTO examiners who repeatedly registered the Redskins marks over two decades. The government's brief (at 52) surmises that the PTO's workload makes occasional errors inevitable. But the notion that the PTO accidently registered the same famous mark six times is not credible, even putting aside the dubious notion that the PTO was flooded with registration applications from 1967 to 1990.

In the government's view, countless private parties can seek cancellation of other registrations. The

Redskins name is hardly the only mark free from controversy. Some of the most controversial marks touching on race in America are over a century old. M. Kern-Foxworth, *Aunt Jemima, Uncle Ben, and Rastus: Blacks in Advertising, Yesterday, Today, and Tomorrow* (1994); M.M. Manring, *Slave in a Box: The Strange Career of Aunt Jemima* (1998). The ethnic caricature logos of CHIQUITA and LAND O LAKES are also ancient. *See* A. Taube & K. Richards, *15 Racist Brand Mascots and Logos that Make the Redskins Look Progressive*, Business Insider (June 19, 2014), http://www.businessinsider.com/15-racist-brand-mascots-and-logos-2014-6. And the government argues that the PTO's delay in seeking cancellation can *never* violate due process—no matter the length, circumstances, or prejudice—because the Lanham Act provides for a pre-cancellation hearing and judicial review. Brief of the United States at 48–49, *Pro-Football, Inc. v. Blackhorse*, No. 15-1874 (4th Cir. Feb. 4, 2016).

As discussed, countless registered marks refer to Native Americans, African-Americans, Hispanics, Asians, Caucasians, women, men, the disabled, and the elderly in ways that could satisfy the PTO's exceptionally broad definition of disparaging. Many charitable groups have registered marks with names that are no longer in common use. *E.g.*, UNITED NEGRO COLLEGE FUND; NEGRO LEAGUES BASEBALL MUSEUM; ASSOCIATION FOR RETARDED CITIZENS. The two million registered mark owners should not have to face the risk that private parties will seek cancellation or that the PTO will cancel the registrations of their valuable trademarks.

* * * * *

For the above reasons, § 2(a) facially violates the First Amendment. But in the cancellation context, the government's interests are even less defensible, and the effects on free speech are even more injurious. Accordingly, no matter the outcome here, this Court should not foreclose challenges to the disparagement clause as applied to cancellation of existing registrations.

CONCLUSION

The Court should affirm the decision of the Court of Appeals for the Federal Circuit.

Respectfully Submitted,

ROBERT L. RASKOPF
TODD ANTEN
JESSICA A. ROSE
Quinn Emanuel Urquhart & Sullivan LLP
51 Madison Ave., 22nd Floor
New York, NY 10010
(212) 849-7000
robertraskopf@quinnemanuel.com

LISA S. BLATT
Counsel of Record
ROBERT A. GARRETT
STEPHEN K. WIRTH
Arnold & Porter LLP
601 Massachusetts Ave., NW
Washington, DC 20001
(202) 942-5000
lisa.blatt@aporter.com

Counsel for Amicus Curiae Pro-Football, Inc.

December 16, 2016

APPENDIX

APPENDIX A

The following are examples of some of the PTO's current and live registrations. They are available through the PTO's database. *See* PTO, Trademark Electronic Search System, http://tmsearch.uspto.gov.

AFRO-SAXONS, apparel
Reg. No. 3726710 (Dec. 15, 2009)

AMERICAN REDNECK SOCIETY, social club
Reg. No. 4062574 (Nov. 29, 2011)

ANAL FANTASY COLLECTION, sex toys
Reg. No. 4507635 (Apr. 1, 2014)

ANAL INTENSIVE, adult entertainment
Reg. No. 2698644 (Mar. 18, 2003)

ANAL RING TOSS, live adult entertainment
Reg. No. 2950588 (May 10, 2005)

ASS FACE DOLLS, image database
Reg. No. 4733121 (May 5, 2015)

BABY DADDY INSURANCE, insurance brokerage
Reg. No. 4613011 (Sept. 30, 2014)

BAKED BY A NEGRO, baked goods
Reg. No. 4424120 (Oct. 29, 2013)

BARELY LEGAL XXX, adult entertainment
Reg. No. 3063002 (Feb. 28, 2006)

BARENAKED LADIES, live music, recordings, and apparel
Reg. No. 2637871 (Oct. 22, 2002)
Reg. No. 2461404 (June 19, 2001)

BETTER THAN SEX PEARL NECKLACE, wine
Reg. No. 5016155 (Aug. 9, 2016)

BIG TITTY BLEND, coffee
Reg. No. 4616854 (Oct. 7, 2014)

BITCH, handbags
Reg. No. 4822287 (Sept. 29, 2015)

BITCH DON'T KILL MY VIBE, apparel
Reg. No. 4653950 (Dec. 9, 2014)

BITCH FACE, cosmetics
Reg. No. 3819705 (July 13, 2010)

BITCH RELAX, apparel
Reg. No. 4559906 (July 1, 2014)

BITCH SLAP, movies
Reg. No. 3998853 (July 19, 2011)

BITCHY GAY, apparel
Reg. No. 4800962 (Aug. 25, 2015)

BLACK MAN WITH A GUN, website and podcast
Reg. No. 4320289 (Apr. 16, 2013)

BLACKGIRLSDOPORN.COM, adult entertainment
Reg. No. 4718284 (Apr. 7, 2015)

BLAQMAN R E C O R D S, music
Reg. No. 4295071 (Feb. 26, 2013)

BONERBAIT, apparel
Reg. No. 5035019 (Sept. 6, 2016)

BOOBS AS BEER HOLDERS, adult entertainment
Reg. No. 4334788 (May 14, 2013)

BOOTY CALL, sex toys
Reg. No. 4243279 (Nov. 13, 2012)

BOUND GANGBANGS, adult entertainment
Reg. No. 4618921 (Oct. 7, 2014)

BOYS ARE STUPID, THROW ROCKS AT THEM, apparel
Reg. No. 4173367 (July 17, 2012)

BUCKSLUT, apparel
Reg. No. 4942407 (Apr. 19, 2016)

BUDDHA BELLY KITCHEN, snack foods
Reg. No. 4777244 (July 21, 2015)

BUSH PANTY, adult novelty items
Reg. No. 4739893 (May 19, 2015)

BUTT MACHINE BOYS, adult entertainment
Reg. No. 4902952 (Feb. 16, 2016)

BUTT NAKED SHOTZ GAME, adult board game
Reg. No. 4608831 (Sept. 23, 2014)

BUTT NAKED TOKE GAME, adult board game
Reg. No. 4751015 (June 9, 2015)

CAPTAIN CANNABIS, comic books
Reg. No. 4782920 (July 28, 2015)

CELEBRETARDS, entertainment services
Reg. No. 3751638 (Feb. 23, 2010)

CHEAP AZZ BROTHA, online comic strips
Reg. No. 4908357 (Mar. 1, 2016)

CHEAP BASTARD, travel guides
Reg. No. 3268727 (July 24, 2007)

CHOLOS ON ACID, live music
Reg. No. 4977958 (June 14, 2016)

CIRCLE JERKS, live music, recordings, and apparel
Reg. No. 3323316 (Oct. 30, 2007)

COLLEGE DILDOS, sex toys
Reg. No. 4704544 (Mar. 17, 2015)

CONTEMPORARY NEGRO, apparel
Reg. No. 4186070 (Aug. 7, 2012)

COOCH COACH, online magazine
Reg. No. 4573557 (Feb. 11, 2014)

CRAZY BITCH TOYS, sex toys
Reg. No. 4886337 (Jan. 12, 2016)

CRIPPLED BASTARD CLOTHING CBC, apparel
Reg. No. 3102969 (June 13, 2006)

CRIPPLED OLD BIKER BASTARDS, apparel
Reg. No. 4263288 (Dec. 25, 2012)

D!RTY EVERYDAY SLANG FROM "WHAT'S UP?" TO "F*%# OFF!", books
Reg. No. 3928097 (Mar. 8, 2011)

DAGO SWAGG, apparel
Reg. No. 4347624 (June 4, 2013)

DEATH BY ORGASM, sex toys
Reg. No. 3910580 (Jan. 25, 2011)

DELIBERATE ORGASM, adult entertainment
Reg. No. 3727671 (Dec. 22, 2009)

DICK BALLS, apparel
Reg. No. 4512705 (Apr. 8, 2014)

DIRTY CROTCH, underwear
Reg. No. 4840419 (Oct. 27, 2015)

DIRTY GHETTO KIDS, skateboards and apparel
Reg. No. 3859749 (Oct. 12, 2010)
Reg. No. 3859748 (Oct. 12, 2010)

DIRTY HOOKER, bumper stickers
Reg. No. 4727386 (Apr. 28, 2015)

DIRTY LITTLE BASTARDS, apparel
Reg. No. 4395877 (Sept. 3, 2013)

DIRTY WHOOORE CLOTHING COMPANY, apparel
Reg. No. 4625425 (Oct. 21, 2014)

DONKEY PISS, tequila
Reg. No. 4113159 (Mar. 13, 2012)

DOUCHEBAG REHAB, merchandise and apparel
Reg. No. 5053050 (Oct. 4, 2016)

DRTYBTCH, entertainment services
Reg. No. 4617261 (Oct. 7, 2014)

DRUNK ASS BITCHES, apparel
Reg. No. 4171393 (July 10, 2012)

DUMB BLONDE, hair products
Reg. No. 2601964 (July 30, 2002)

DUMB BLONDE, beer
Reg. No. 3983953 (June 28, 2011)

DYKE NIGHT, events and entertainment services
Reg. No. 4146588 (May 22, 2012)

EDIBLE CROTCHLESS GUMMY PANTIES, underwear
Reg. No. 2859081 (June 29, 2004)

EGOTESTICLE, education services and apparel
Reg. No. 4618149 (Oct. 7, 2014)
Reg. No. 4614980 (Sept. 30, 2014)

EROS SHEMALE ESCORTS, website for escort services
Reg. No. 4208127 (Sept. 18, 2012)
Reg. No. 4203955 (Sept. 11, 2012)
Reg. No. 4203954 (Sept. 11, 2012)

EWHIP.COM, personal sexual lubricants, digital media, and adult sexual stimulation aids
Reg. No. 4804653 (Sept. 1, 2015)

F'D UP, apparel
Reg. No. 4495813 (Mar. 11, 2014)

FART RIGHT ANAL STRIPS, adult novelty items
Reg. No. 4435481 (Nov. 19, 2013)

FAT GIRL BEER, beer
Reg. No. 5069756 (Oct. 25, 2016)

FETISH FANTASY EXTREME, sex toys
Reg. No. 4088908 (Jan. 17, 2012)

FETISH FANTASY GOLD, sex toys
Reg. No. 4672795 (Jan. 13, 2015)

FETISH FANTASY SERIES, sex toys
Reg. No. 3556369 (Jan. 6, 2009)

FETISH PLEASURE PLAY, sex toys
Reg. No. 4722732 (Apr. 21, 2015)
Reg. No. 4683056 (Feb. 3, 2015)

FLEA MARKET HOOKERS, live music
Reg. No. 4913848 (Mar. 8, 2016)

FRATERNITY DILDOS, sex toys
Reg. No. 4704546 (Mar. 17, 2015)

FREE ORGASMS!, sex toys
Reg. No. 4250231 (Nov. 27, 2012)

FREE THE NIPPLE, apparel
Reg. No. 4626305 (Oct. 21, 2014)

FUPA POUCH, fanny pack
Reg. No. 5022590 (Aug. 16, 2016)

FUSTERCLUCK MAD IN THE USA, sporting events
Reg. No. 4477536 (Feb. 4, 2014)

FYBD FIND YOUR BABY DADDY, child-support-collection services
Reg. No. 4300185 (Mar. 12, 2013)

GANGSTER PIMPIN, apparel
Reg. No. 4879861 (Jan. 5, 2016)

GHETTO BOOTY, adult entertainment
Reg. No. 2604817 (Aug. 6, 2002)

GHETTO STYLE CLOTHING, apparel
Reg. No. 1987741 (July 16, 1996)

GIRLSDOPORN.COM, adult entertainment
Reg. No. 4811839 (Sept. 15, 2015)
Reg. No. 4557728 (June 24, 2014)

G-MARKS THE SPOT, sex toys and online marketplace
Reg. No. 4347566 (June 4, 2013)
Reg. No. 3074265 (Mar. 28, 2006)

GRINGO BBQ, food delivery services
Reg. No. 4301893 (Mar. 12, 2013)

GRINGO STYLE SALSA, salsa
Reg. No. 4252304 (Dec. 4, 2012)

GROW A PAIR, merchandise and apparel
Reg. No. 4900231 (Feb. 16, 2016)

G-SPOT ACTIVATOR, sex toys
Reg. No. 4246931 (Nov. 20, 2012)

GUYBRATOR, sex toys
Reg. No. 4865256 (Dec. 8, 2015)

GYPSIES AND THIEVES, apparel
Reg. No. 4978427 (June 14, 2016)

HALF-BREED, hats
Reg. No. 2108617 (Oct. 28, 1997)

HALF BREED, live music
Reg. No. 4401483 (Sept. 10, 2013)

HANDICRAP, education and charitable services
Reg. No. 4323416 (Apr. 23, 2013)

HAUTE BUTCH, apparel
Reg. No. 4343990 (May 28, 2013)

HISLUT, dating services
Reg. No. 4153920 (June 5, 2012)

HOME OF THE G SPOT, apparel
Reg. No. 4723599 (Apr. 21, 2015)

HOMO A GO GO, entertainment services
Reg. No. 3889915 (Dec. 14, 2010)

HOMOACTIVE, online marketplace for adult entertainment
Reg. No. 3806399 (June 22, 2010)

HOMORODEO, adult entertainment
Reg. No. 4343157 (May 28, 2013)

HOOCHIE MAMA BBQ RUB, dry rub
Reg. No. 4555477 (June 24, 2014)

HOOKERS & BLOW, live music and apparel
Reg. No. 3582446 (Mar. 3, 2009)

HOT OCTOPUSS, sex toys, anti-premature ejaculation creams, and apparel
Reg. No. 4630594 (Nov. 4, 2014)

I CLEAN I JERK AND I HAVE A NICE SNATCH, apparel
Reg. No. 4798333 (Aug. 25, 2015)

I LOVE VAGINA, apparel
Reg. No. 3364871 (Jan. 8, 2008)

I WORK HARD BITCH, apparel
Reg. No. 4575506 (July 29, 2014)

JERSEY SHORE HO'S: SEX ON THE BEACH, television series
Reg. No. 3939860 (Apr. 5, 2011)

JIZZ, underwear
Reg. No. 4661382 (Dec. 30, 2014)

KILL THE BUDDHA, apparel
Reg. No. 4641100 (Nov. 18, 2014)

KINKY BITCH, sex toys and apparel
Reg. No. 4291384 (Feb. 19, 2013)
Reg. No. 3612245 (Apr. 28, 2009)

KLITORIS, sex toys
Reg. No. 4398345 (Sept. 10, 2013)

LATINA PORN EXPOSED, adult entertainment
Reg. No. 4353767 (Jun 18, 2013)

LAUGHING MY VAGINA OFF, television series
Reg. No. 4401056 (Sept. 10, 2013)

LADYGASM, sex toys
Reg. No. 4097165 (Feb. 7, 2012)

LICENSED SERIAL KILLER, apparel
Reg. No. 3935945 (Mar. 22, 2011)

LIMP BIZKIT, live music, recordings, merchandise, and apparel
Reg. No. 3922850 (Feb. 21, 2011)
Reg. No. 2621762 (Sept. 17, 2002)
Reg. No. 2485894 (Sept. 4, 2001)
Reg. No. 2345604 (Apr. 25, 2000)
Reg. No. 2343660 (Apr. 18, 2000)

LUBED.COM RAW/WET/SEX, adult entertainment
Reg. No. 5063373 (Oct. 18, 2016)

MAD MAX WHITE TRASH BASH, entertainment services
Reg. No. 4821790 (Sept. 29, 2015)

MAKE YOUR OWN DILDO, sex toys
Reg. No. 4055162 (Nov. 15, 2011)

MAMMY JAMIA'S, fruit jellies and preserves
Reg. No. 4434997 (Nov. 19, 2013)

MARIJUANA FOR SALE, online advertising
Reg. No. 4805740 (Sept. 1, 2015)

MARRIAGE CAN BE MURDER, dinner theater
Reg. No. 4547581 (June 10, 2014)

MARY JANE VIBRATOR, sex toys
Reg. No. 4928917 (Mar. 29, 2016)

MATCH-A-SNATCH, playing cards
Reg. No. 3905408 (Jan. 11, 2011)

MIDGET-MAN, condoms and inflatable sex dolls
Reg. No. 4388228 (Aug. 20, 2013)

MILF WEED, apparel
Reg. No. 4495963 (Mar. 11, 2014)

MILFSDOPORN.COM, adult entertainment
Reg. No. 4736875 (May 12, 2015)

MONKEYPORN, live music
Reg. No. 4345772 (June 4, 2013)

MURDER MURDER AND ANARCHY.COM, apparel
Reg. No. 4207774 (Sept. 11, 2012)

N.W.A., musical recordings and apparel
Reg. No. 4675580 (Jan. 20, 2015)
Reg. No. 2522163 (Dec. 25, 2001)

NAPPY ROOTS, musical recordings and apparel
Reg. No. 4579250 (Aug. 5, 2014)
Reg. No. 4545474 (June 3, 2014)

NAUGHTY NIPPLES, flavored body balm for intimate use
Reg. No. 4800464 (Aug. 25, 2015)

NERD FAP, podcasts
Reg. No. 4897824 (Feb. 9, 2016)

NEW NEGRO, apparel
Reg. No. 4014618 (Aug. 23, 2011)

NO FACES.COM SUBMIT YOUR SEX TAPE AND MAKE MONEY, adult entertainment
Reg. No. 4187922 (Aug. 7, 2012)

OH! MY NAPPY HAIR, hair products
Reg. No. 4784122 (Aug. 4, 2015)

OL GEEZER, wine
Reg. No. 3331363 (Nov. 6, 2007)

OMAZING SEX TOYS, sex toys
Reg. No. 4677907 (Jan. 27, 2015)

ORGASM.COM, adult entertainment
Reg. No. 2657616 (Dec. 10, 2002)

PARTY WITH SLUTS, apparel
Reg. No. 4388020 (Aug. 20, 2013)

PECKER WRECKER, beer
Reg. No. 5022624 (Aug. 16, 2016)

PERV CITY, adult entertainment
Reg. No. 4759909 (June 23, 2015)

PIMP $LAP!, apparel
Reg. No. 4345555 (June 4, 2013)

PIXIEDYKES.COM, apparel
Reg. No. 3993448 (July 12, 2011)

POOR WHITE TRASH PRODUCTIONS, audio and video productions
Reg. No. 5021354 (Aug. 16, 2016)

PORN STAR HIP HOP, adult entertainment
Reg. No. 4582005 (Aug. 5, 2014)

PRETTY POT HEADS, apparel
Reg. No. 5065748 (Oct. 18, 2016)

PRINCESS SLUT, writing instruments
Reg. No. 4579748 (Aug. 5, 2014)

QUEER FOLK, musical recordings
Reg. No. 4742269 (May 26, 2015)

QUEER PAL FOR THE STRAIGHT GAL, social network
Reg. No. 4699581 (Mar. 10, 2015)

QUEERS OF COMEDY, entertainment
Reg. No. 3697251 (Oct. 13, 2009)

REALLY STUPID FAST GIRLS, apparel
Reg. No. 5073899 (Nov. 1, 2016)

REDNECK, stickers
Reg. No. 5005261 (July 19, 2016)

REDNECK ARMY, posters and apparel
Reg. No. 4813949 (Sept. 15, 2015)
Reg. No. 4800643 (Aug. 25, 2015)

REDNECK BIKINI, swimwear
Reg. No. 4839776 (Oct. 27, 2015)

REDNECK CHICKS, apparel
Reg. No. 4287081 (Feb. 5, 2013)

REDNECK DEBUTANTE, books and apparel
Reg. No. 4809719 (Sept. 8, 2015)
Reg. No. 4511651 (Apr. 8, 2014)

REDNECK GANGSTA, apparel
Reg. No. 4614716 (Sept. 30, 2014)

REDNECK RECORDS, musical recordings
Reg. No. 4350411 (June 11, 2013)
Reg. No. 3851319 (Sept. 21, 2010)

REDNECK WOMAN, apparel
Reg. No. 3804876 (June 15, 2010)

REFORMED WHORES, musical recordings
Reg. No. 4582985 (Aug. 12, 2014)

RELIGION KILLS, apparel
Reg. No. 4165976 (June 26, 2012)

RETARDAISSANCE, entertainment services
Reg. No. 3739648 (Jan. 19, 2010)

RETARDIPEDIA, entertainment services
Reg. No. 3750644 (Feb. 16, 2010)

RIDE DOGGIE STYLE, condoms
Reg. No. 4800908 (Aug. 25, 2015)
Reg. No. 4783251 (July 28, 2015)

RIGHT NOW I'M HAVING INTERCOURSE, beer
Reg. No. 4246966 (Nov. 20, 2012)

SALTY BALLZ, apparel
Reg. No. 5096691 (Dec. 6, 2016)

SEE MY SEX TAPES, adult television series
Reg. No. 4056045 (Nov. 15, 2011)

SEX & VIOLENCE, beer
Reg. No. 4959725 (May 17, 2016)

SEX . . . WITH MOM AND DAD, entertainment
Reg. No. 3717062 (Nov. 24, 2009)

SEX SENT ME TO THE SLAMMER, television series
Reg. No. 4736462 (May 12, 2015)

SEX. PROFANITY. IMPLIED VIOLENCE. DRAMA. EROTICA. REAL LIFE., books
Reg. No. 4641720 (Nov. 18, 2014)

SEXY SLAVE, sex toys
Reg. No. 4727713 (Apr. 28, 2015)

SHAGAHOLIC, online dating
Reg. No. 4865182 (Dec. 8, 2015)

SHAMELESS HUSSY, wine
Reg. No. 3749687 (Feb. 16, 2010)

SHANK THE B!T@H, board games
Reg. No. 4672035 (Jan. 13, 2015)

SHUCK 'N JIVE, restaurant and bar
Reg. No. 3422438 (May 6, 2008)

SLUTLOAD, adult entertainment
Reg. No. 4303708 (Mar. 19, 2013)

SLUTNATION.XXX, adult entertainment
Reg. No. 4997723 (July 12, 2016)

SLUTSSEEKER, online dating
Reg. No. 4167423 (July 3, 2012)

SLUTTY GIRL PROBLEMS, blog and apparel
Reg. No. 4534065 (May 20, 2014)
Reg. No. 4432001 (Nov. 12, 2013)

SNATCH IT BACK, exercise videos
Reg. No. 4822744 (Sept. 29, 2015)

SNATCH MY WAIST, shapewear
Reg. No. 4579783 (Aug. 5, 2014)

SONIC VIBRATOR, sex toys
Reg. No. 4690088 (Feb. 17, 2015)

SORORITY DILDOS, sex toys
Reg. No. 4704545 (Mar. 17, 2015)

SPANK ME, creams, oils, balms, and mists for enhancing sexual arousal
Reg. No. 4713317 (Mar. 31, 2015)

SPANK ME CARDS.COM, greeting cards
Reg. No. 3916434 (Feb. 8, 2011)

SPAZ, apparel
Reg. No. 4408228 (Sept. 24, 2013)

SMACK MY ASS & CALL ME SALLY, condiments
Reg. No. 2131823 (Jan. 27, 1998)

STINKY GRINGO, alcoholic beverages
Reg. No. 3078725 (Apr. 11, 2006)

STOP BLAMING WHITE PEOPLE. IT'S THE SYSTEM, STUPID., mentoring services
Reg. No. 3818354 (July 13, 2010)

STOP COMPLAINING ABOUT YOUR BABY DADDY, YOU PICKED HIM!, apparel
Reg. No. 4441583 (Nov. 26, 2013)

SUSIE'S WHITE TRASH, candy
Reg. No. 4656958 (Dec. 16, 2014)

TAKE YO PANTIES OFF, apparel
Reg. No. 4824028 (Sept. 29, 2015)

TEENSDOPORN.COM, adult entertainment
Reg. No. 4565821 (July 8, 2014)

THANK YOU FOR POT SMOKING, stickers and apparel
Reg. No. 4564730 (July 8, 2014)
Reg. No. 4308864 (Mar. 26, 2013)

THE AFRO-SAXONS, entertainment
Reg. No. 3797627 (June 1, 2010)

THEASSGIRL, apparel
Reg. No. 4121498 (Apr. 3, 2012)

THE DITCHY: BITCH – CLEAN IT UP!, kitchen towels
Reg. No. 4569864 (July 15, 2014)

THE GHETTO COOKING SHOW, entertainment
Reg. No. 377331 (Apr. 20, 2010)

THE GUIDOS OF COMEDY, entertainment
Reg. No. 4508998 (Apr. 8, 2014)

THE HUNGARY BUDDHA EATS THE WORLD, travel and food blogs
Reg. No. 4968419 (May 31, 2016)

THE PRICKS, live music
Reg. No. 4104810 (Feb. 28, 2012)

THE POP WHORES, live music and recordings
Reg. No. 4918215 (Mar. 15, 2016)
Reg. No. 4918214 (Mar. 15, 2016)

THE ROAST BEEF CURTAINS, live music and recordings
Reg. No. 3893722 (Dec. 21, 2010)

THE SHIKSA IN THE KITCHEN, food blog
Reg. No. 4273424 (Jan. 8, 2013)
Reg. No. 4273423 (Jan. 8, 2013)
Reg. No. 4047929 (Nov. 1, 2011)

THEDILDODR.COM, sex toys
Reg. No. 4261361 (Dec. 18, 2012)

THUG ARMY, apparel
Reg. No. 5033370 (Aug. 30, 2016)

THUG PORN, adult entertainment
Reg. No. 3129121 (Aug. 15, 2006)

TRAILER PARK BOYS, television series, apparel, and merchandise
Reg. No. 3655119 (July 14, 2009)
Reg. No. 3554558 (Dec. 30, 2008)
Reg. No. 3305282 (Oct. 9, 2007)
Reg. No. 3284288 (Aug. 28, 2007)

TRANNY SURPRISE, adult entertainment
Reg. No. 3497652 (Sept. 9, 2008)

TRUST NO BITCH, apparel
Reg. No. 4193629 (Aug. 21, 2012)
Reg. No. 4100406 (Feb. 14, 2012)

UPGRADE YOUR ORGASM, sex toys
Reg. No. 4764234 (June 30, 2015)

VAJAYJAY HAT, party hats
Reg. No. 4203818 (Sept. 4, 2012)

WET URANUS, personal sexual lubricants
Reg. No. 4362322 (July 2, 2013)

WHIPPEDASS, adult entertainment
Reg. No. 3323908 (Oct. 30 2007)

WHITE BOY COOL, apparel
Reg. No. 4682976 (Feb. 3, 2015)

WHITE GIRL PROBLEMS, books and entertainment
Reg. No. 4576196 (July 29, 2014)
Reg. No. 4310754 (Mar. 26, 2013)

WHITE GIRL WITH A BOOTY, apparel
Reg. No. 3793774 (May 25, 2010)

WHITE TRASH COWBOYS, live music
Reg. No. 2882408 (Sept. 7, 2004)

WHITE TRASH REBEL, apparel
Reg. No. 4687136 (Feb. 17, 2015)

WHITE TRASH ROYALTY, apparel
Reg. No. 4177307 (July 17, 2012)

WHO DAT BABY DADDY?, paternity testing and apparel
Reg. No. 4372705 (July 23, 2013)
Reg. No. 4371049 (July 23, 2013)

WHORES FROM HELL, live music
Reg. No. 4301873 (Mar. 12, 2013)

WHY MEN LOVE BITCHES, educational materials
Reg. No. 3146007 (Sept. 19, 2006)

WHY MEN MARRY BITCHES, educational materials
Reg. No. 3413164 (Apr. 15, 2008)

WIMPY DICKS, musical recordings
Reg. No. 2514607 (Dec. 4, 2001)

WONDROUS VULVA PUPPET, stuffed toys
Reg. No. 5043896 (Sept. 20, 2016)

WTF WORK?, IT help forum
Reg. No. 4332574 (May 7, 2013)

XXX TRUTH OR DARE, adult board games
Reg. No. 4523529 (Apr. 29, 2014)

YARDAPES, landscaping services
Reg. No. 2599627 (July 23, 2002)

YELLOWMAN, apparel
Reg. No. 3539211 (Dec. 2, 2008)

YID DISH, online dating newsletter
Reg. No. 4131892 (Apr. 24, 2012)

YO' ASS FACE, image database
Reg. No. 4821354 (Sept. 29, 2015)

YOUNG THUG, live music and recordings
Reg. No. 4737760 (May 19, 2015)

100% WHITE BOY, stickers and apparel
Reg. No. 4795075 (Aug. 18, 2015)
Reg. No. 4666332 (Jan. 6, 2015)

#FLOATINGORGASM, sex toys
Reg. No. 4880503 (Jan. 5, 2016)

AND 1
BRIEFS

Supreme Court, U.S.
FILED
NOV 16 2016
OFFICE OF THE CLERK

No. 15-1293

IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF AMICUS CURIAE PUBLIC CITIZEN, INC., IN SUPPORT OF NEITHER PARTY

SCOTT L. NELSON
Counsel of Record
ALLISON M. ZIEVE
JULIE A. MURRAY
PUBLIC CITIZEN LITIGATION GROUP
1600 20th Street NW
Washington, DC 20009
(202) 588-1000
snelson@citizen.org

Attorneys for Amicus Curiae

November 2016

Library of Congress

TABLE OF CONTENTS

TABLE OF AUTHORITIES iii

INTEREST OF AMICUS CURIAE 1

SUMMARY OF ARGUMENT 3

ARGUMENT 5

I. To the extent the statute restricts or burdens speech, the speech at issue is commercial speech. 6

A. Trademark law regulates commercial speech. 6

B. The Lanham Act's limitations on commercial trademark rights do not burden pure speech. 9

II. Commercial-speech regulations are subject to intermediate First Amendment scrutiny. 12

A. This Court has long applied intermediate scrutiny to content-based commercial-speech regulations. 12

B. *Sorrell* and *Reed* do not alter the intermediate scrutiny standard for restrictions on commercial speech. 15

C. Applying strict scrutiny to content-based commercial-speech regulations is neither necessary nor proper. 18

1. Applying strict scrutiny to commercial speech would threaten a broad range of commonsense regulations. 18

2. Applying strict scrutiny to commercial speech would harm protection of pure speech and is unnecessary to protect commercial speech. 21

CONCLUSION 23

TABLE OF AUTHORITIES

Cases **Page(s)**

Bd. of Cty. Comm'rs v. Umbehr,
518 U.S. 668 (1996) 11

Bd. of Trustees of State Univ. of N.Y. v. Fox,
492 U.S. 469 (1989) 4, 12

Bolger v. Youngs Drug Prods. Corp.,
463 U.S. 60 (1983) 13, 14, 22

Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n, 447 U.S. 557 (1980) ..... *passim*

Clark v. Jeter,
486 U.S. 456 (1988) 16

CTIA—The Wireless Ass'n v. City of Berkeley,
139 F. Supp. 3d 1048 (N.D. Cal. 2015), *app. filed*,
No. 16-15141 (9th Cir. Feb. 1, 2016) 18

Edenfield v. Fane,
507 U.S. 761 (1993) 12, 22

Fla. Bar v. Went For It, Inc.,
515 U.S. 618 (1995) 14, 18

Friedman v. Rogers,
440 U.S. 1 (1979) 4, 7

Greater New Orleans Broad. Ass'n, Inc. v. United States, 527 U.S. 173 (1999) 14

Int'l News Serv. v. Assoc. Press,
248 U.S. 215 (1918) 7

Jordan v. Jewel Food Stores, Inc.,
743 F.3d 509 (7th Cir. 2014) 8, 12

Lorillard Tobacco Co. v. Reilly,
533 U.S. 525 (2001) 1

Mattel, Inc. v. MCA Records, Inc.,
296 F.3d 894 (9th Cir. 2002) 8

Nixon v. Shrink Mo. Gov't PAC,
528 U.S. 377 (2000) 16

Ohralik v. Ohio State Bar Ass'n,
436 U.S. 447 (1978) 13, 21

Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.,
469 U.S. 189 (1985) 7

POM Wonderful, LLC v. FTC,
777 F.3d 478 (D.C. Cir. 2015) 1

Radiance Found., Inc. v. NAACP,
786 F.3d 316 (4th Cir. 2015) 8, 9

R.A.V. v. City of St. Paul,
505 U.S. 377 (1992) 20

Reed v. Town of Gilbert,
135 S. Ct. 2218 (2015) 15, 16, 17, 18, 19

Riley v. Nat'l Fed'n of the Blind,
487 U.S. 781 (1988) 11

In re R.M.J.,
455 U.S. 191 (1982) 14

Rubin v. Coors Brewing Co.,
514 U.S. 476 (1995) 14

S.F. Arts & Athletics, Inc. v. *U.S. Olympic Comm.*,
483 U.S. 522 (1987) 4, 6, 7, 9, 10, 11

Sorrell v. IMS Health Inc.,
564 U.S. 552 (2011) 4, 15, 16, 17, 18

Taubman Co. v. Webfeats,
319 F.3d 770 (6th Cir. 2003) 4, 8, 9

Trade-Mark Cases,
100 U.S. 82 (1879) 7

Two Pesos, Inc. v. Taco Cabana, Inc.,
505 U.S. 763 (1992) 7

United States v. Alvarez,
132 S. Ct. 2537 (2012) 21

United States v. Virginia,
518 U.S. 515 (1996) 16

Va. State Bd. of Pharm. v. Va. Citizens Consumer Council, Inc.,
425 U.S. 748 (1976) 1

Williams-Yulee v. Fla. Bar,
135 S. Ct. 1656 (2015) 3, 6, 20

Statutes and Rules

15 U.S.C. § 1052(a) 3, 20

15 U.S.C. § 1052(b) 20

15 U.S.C. § 1052(c) 20

15 U.S.C. § 1052(d) 20

15 U.S.C. § 1052(e) 20

15 U.S.C. § 1052(f) 20

15 U.S.C. § 1114 8

15 U.S.C. § 1116 8

15 U.S.C. § 1117 8

15 U.S.C. § 1125(c) 8

15 U.S.C. § 1692d(3)–(4) 19

49 U.S.C. § 32908(b) 19

21 C.F.R. § 101.9 19
21 C.F.R. § 101.14 19
21 C.F.R. § 107.10(b) 19
21 C.F.R. § 201.57 19

Legislative History

92 Cong. Rec. 7524 (1946) 7
S. Rep. No. 79-1333 (1946) 7
S. Rep. No. 100-515 (1988) 7

Other

Tamara Piety, *The First Amendment and the Corporate Civil Rights Movement*, 11 J. Bus. & Tech. L. 1, 20 (2016) 18

INTEREST OF AMICUS CURIAE[1]

Amicus curiae Public Citizen, Inc., is a nonprofit consumer advocacy organization that appears on behalf of its nationwide members and supporters before Congress, administrative agencies, and courts on a wide range of issues. Public Citizen has long played a role in the development of commercial-speech doctrine. Public Citizen has defended commercial-speech regulations in cases where those regulations were important to protecting public health or served other important public interests, such as in *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525 (2001), and *POM Wonderful, LLC v. FTC*, 777 F.3d 478 (D.C. Cir. 2015). Its attorneys have also represented parties seeking to invalidate overbroad commercial-speech restraints that harmed competition and injured consumers, including in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748 (1976).

Public Citizen has become increasingly concerned that overly stringent applications of commercial-speech doctrine may stifle legitimate economic regulatory measures and protections for consumers. This case implicates that concern because the respondent advocates application of strict scrutiny to a law that, if it regulates or burdens speech at all, does so only with respect to *commercial speech*. The application of strict scrutiny to commercial-speech regulations would

---

[1] This brief was not authored in whole or part by counsel for a party. No one other than amicus curiae or its counsel made a monetary contribution to preparation or submission of this brief. Letters of consent to filing from counsel for both parties are on file with the Clerk.

wrongly tilt the First Amendment balance against laws and regulations that serve important public interests.

In addition, Public Citizen has in recent years become involved in cases in which trademark holders have sought to use those marks to suppress noncommercial speech critical of the mark-holder or its products or services, particularly speech on the internet. Public Citizen's experience in those cases has confirmed its conclusion that the proper realm of trademark law is the regulation of commercial speech. When it strays outside that realm, trademark law may pose significant obstacles to freedom of speech; within that realm, its application to commercial uses of marks should be governed by the standards applicable to commercial-speech regulation generally.

Because the government's defense of the statute rests on the argument that it does not regulate or burden speech, the parties' arguments may suggest an all-or-nothing choice between no First Amendment scrutiny and the strict scrutiny applicable to content-based regulation of fully protected speech. Public Citizen submits this brief to advocate another possibility: that if the Court were to find that the statute regulates or burdens speech, the affected speech would be commercial speech, and thus the statute would be subject only to the intermediate scrutiny applicable to laws regulating commercial speech under *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557 (1980). Public Citizen believes that this view may be helpful to the Court as it considers the important issues posed by this case.

SUMMARY OF ARGUMENT

The positions staked out by the parties in this case could hardly be further apart. According to the government, the Lanham Act's prohibition on the registration of disparaging trademarks, 15 U.S.C. § 1052(a), neither regulates nor burdens speech. Thus, the government argues, the prohibition is not subject to any level of First Amendment scrutiny at all, but only to the rational-basis review applicable to laws that regulate or affect commerce without implicating fundamental rights. Pet. Br. 48.

By contrast, the respondent, Mr. Tam, asserts that the statute is a content- and viewpoint-based regulation of fully protected speech, subject to strict scrutiny under the First Amendment. Resp. Br. Opp. 23, 25, 29. Alternatively, he appears to argue that even if the statute is viewed as affecting commercial speech, its content-based nature should subject it to strict scrutiny. Resp. Br. Opp. 25, 29. Laws that survive First Amendment strict scrutiny are rare. *See Williams-Yulee v. Florida Bar*, 135 S. Ct. 1656, 1666–67 (2015). The government did not contend below, and does not appear to argue now, that this law is one of them. *See* Pet App. 23a–24a; Pet. Br. 48–50.

The parties' positions, however, do not exhaust the possible ways to answer the question that this Court issued the writ of certiorari to answer: "Whether the disparagement provision of the Lanham Act ... is facially invalid under the Free Speech Clause of the First Amendment." In particular, even assuming, contrary to the government's argument, that the statute does burden speech sufficiently to require First Amendment scrutiny, it does not follow that strict scrutiny applies. Rather, if assessed under the First

Amendment, the statute's constitutionality should be assessed under *Central Hudson*'s intermediate scrutiny standard for restrictions on commercial speech.

This Court has recognized repeatedly that trademarks and, more generally, trade names are a form of commercial speech. *See S.F. Arts & Athletics, Inc.* v. *U.S. Olympic Comm.*, 483 U.S. 522 (1987); *see also Friedman v. Rogers*, 440 U.S. 1 (1979). Moreover, trademark protection operates by permitting the mark-holder to restrain the commercial speech of competitors. *See, e.g., Taubman Co. v. Webfeats*, 319 F.3d 770 (6th Cir. 2003). To the extent that the prohibition on registration of disparaging marks burdens the mark-holder, it is only by limiting to some extent the ease with which he may use the mark to achieve that commercial objective.

Because the law affects the commercial-speech rights of the mark-holder and his commercial competitors, the First Amendment scrutiny to which it is subject should not exceed the level of scrutiny applicable to commercial-speech restrictions generally. That level of scrutiny is *Central Hudson*'s intermediate scrutiny, under which a substantial, not compelling, governmental interest suffices, *see* 447 U.S. at 566, and a law must be tailored to advance that interest directly, but need not do so in the least restrictive manner possible. *See Bd. of Trustees of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 476–77 (1989).

Intermediate scrutiny applies to commercial-speech regulations even when they may be characterized in a broad sense as content-based. *See Sorrell v. IMS Health Inc.*, 564 U.S. 552 (2011). Regulations of commercial speech are inherently dependent on the content of the speech subject to them; indeed, the cat-

egory of commercial speech is itself defined by the content of the speech. A holding that *Central Hudson*'s intermediate scrutiny must be supplanted by strict scrutiny whenever a commercial-speech restriction can be characterized as content-based would contradict decades of this Court's precedents, render *Central Hudson* a dead letter, and greatly impair the government's ability to engage in economic regulation.

ARGUMENT

Both parties to this case present arguments that, if accepted, would avoid the need to address the applicable level of First Amendment scrutiny. Consideration of the applicable level of First Amendment scrutiny would, of course, be unnecessary if the Court were to hold that the disparagement provision does not restrict or burden speech at all, as the government argues. *See* Pet. Br. 20–43. Likewise, the case would not present First Amendment issues if Mr. Tam's mark is not disparaging under the statute because he seeks to reclaim and turn to other uses a term that originated as one of disparagement, as Mr. Tam argued in his brief in opposition to the government's petition. *See* Resp. Br. Opp. 13–21. This brief will not attempt to improve upon either sides' arguments on those points.

Assuming, though, that the statute applies to this mark, and that its application affects Mr. Tam's speech in a way that calls the First Amendment into play, this Court must confront the question of what level of First Amendment scrutiny applies. As this Court's decisions reflect, determining at the outset the appropriate level of scrutiny based on the nature of the speech at issue is typically essential to arriving at the correct result in a First Amendment case. *See*,

e.g., *Williams-Yulee*, 135 S. Ct. at 1664–65; *Fox*, 492 U.S. at 473–74; *Cent. Hudson*, 447 U.S. at 561–66. In this case, however, neither party adequately comes to grips with that issue.

The government points out that "trademarks are 'commercial speech' and receive 'a limited form of First Amendment protection.'" Pet. Br. 48 (quoting *S.F. Arts*, 483 U.S. at 535). Beyond the "see generally" citation to *Central Hudson* that follows that statement, however, the government does not flesh out the point. Mr. Tam, on the other hand, contends that the statute is a content-based burden on fully protected speech subject to strict scrutiny, *see* Resp. Br. Opp. 23, and, alternatively, that, even if commercial speech is at issue, the statute remains subject to strict scrutiny because it is content-based, *see id.* at 29.

The government's position comes nearer the mark but does not carry the point to its conclusion: If the Court decides First Amendment scrutiny is required, the appropriate standard must be intermediate scrutiny under *Central Hudson*. To the extent that the law here has an impact on speech, that speech is commercial, and the application of the strict scrutiny that Mr. Tam advocates is unwarranted.

I. To the extent the statute restricts or burdens speech, the speech at issue is commercial speech.

A. Trademark law regulates commercial speech.

The essential characteristic of a trademark is that it is a word, set of words, or image that denotes goods or services offered in commerce. The legal protections afforded trademarks affect the owner's commercial

interests. Trademark protection exists to achieve the economic objective of giving "a limited property right in [a] word" that has "acquire[d] value 'as the result of organization and the expenditure of labor, skill, and money'" by the mark-holder. *S.F. Arts*, 483 U.S. at 532 (quoting *Int'l News Serv. v. Assoc. Press*, 248 U.S. 215, 239 (1918)).

The purpose of trademark protection is not to advance the mark-holder's expressive interests, but to maintain the integrity of the marketplace, protect businesses' investment in the goodwill attaching to their marks, and "protect the ability of consumers to distinguish among competing producers." *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985); *see also Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992). As Congressman Lanham stated, "The purpose of [the Act] is to protect legitimate business and the consumers of the country." 92 Cong. Rec. 7524 (1946). The Senate Report on the Lanham Act made the same points, *see* S. Rep. No. 79-1333, at 3–4 (1946), which are reiterated in the legislative history of the 1988 amendments to the Act, *see* S. Rep. No. 100-515, at 4 (1988).

Trademark laws achieve those market- and consumer-protective purposes by creating rights "to distinguish the good or property [of] the person whose mark it is, to the exclusion of use by all other persons" in the commercial arena. *S.F. Arts*, 483 U.S. at 534 (quoting *Trade-Mark Cases*, 100 U.S. 82, 92 (1879)). In regulating the extent of such rights in words used for commercial speech, trademark law's "application is to commercial speech." *Id.* at 535; *see also Friedman*, 440 U.S. at 11 (holding that use of

trade name to denote a business is commercial speech).

Moreover, trademark protection achieves its commercial ends by *suppressing* other commercial speech—namely, the use of the mark in commerce by the mark-holder's competitors or by other actors whose commercial uses of the mark cause consumer confusion or dilute the mark's commercial value.[2] As Judge Wilkinson has explained, trademark laws "restrict speech in order to promote the government's interest in protecting consumers from confusing misappropriations of product identifications." *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 321 (4th Cir. 2015).

Because "[t]rademark protection comes at a potential cost to free expression," *id.*, trademark infringement and dilution actions under the Lanham Act are, as a general matter, carefully confined to uses of a mark in commercial speech. *See id.* at 421–25; *Taubman*, 319 F.3d at 774; *see also Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509, 515–20 (7th Cir. 2014) (allowing Lanham Act claims based on uses of mark in commercial speech); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 904–07 (9th Cir. 2002) (denying Lanham Act claims based on uses of mark in noncommercial speech).

Trademark law, as so confined, represents little threat to First Amendment values because the com-

---

[2] *See* 15 U.S.C. §§ 1114 (right of action for trademark infringement); 1116 (injunctive relief for violations of trademark rights); 1117 (damages for violations of trademark rights); 1125(c) (injunctive relief and other remedies for trademark dilution).

mercial speech to which it applies receives less extensive constitutional protection than the fully protected speech that is generally outside trademark law's purview. *Radiance Found.*, 786 F.3d at 321–22. As one court has put it, the "Lanham Act is constitutional because it only regulates commercial speech, which is entitled to reduced protections under the First Amendment." *Taubman*, 319 F.3d at 774; *see also S.F. Arts & Athletics*, 483 U.S. at 536.[3] Insofar as the Act adjusts the commercial interests of those who use marks in the marketplace, the limitations it places on both mark-holders and other market participants are properly viewed as commercial-speech regulations.

B. The Lanham Act's limitations on commercial trademark rights do not burden pure speech.

Mr. Tam asserts that the Lanham Act's disparagement provision is subject to strict scrutiny because, in limiting to some degree the commercial-law protection afforded his use of the name "The Slants" to denote the name of his band, the provision has burdened his expressive interests in using that name to make points about racism. Resp. Br. Opp. 2–4, 21. Paradoxically, however, the trademark protection Mr. Tam seeks is the ability to prevent anyone else from engaging in precisely the same expression for which he claims full First Amendment protection. Trade-

---

[3] Although this Court held in *San Francisco Arts* that constitutional limits on the rights of mark-holders may be somewhat broader than the limits of the Lanham Act, it also emphasized that the constitutionality of laws governing use of marks for commercial and promotional purposes is determined by commercial-speech analysis. *See* 483 U.S. at 540.

mark law, after all, achieves its purposes by granting the mark-holder the right to exclude competitors from using the mark in commerce, *see S.F. Arts*, 483 U.S. at 534, and Mr. Tam acknowledges that acquiring "powerful tools" to prevent other bands from engaging in the same speech (that is, marketing themselves as "The Slants") is the point of registering his trademark. Resp. Br. Opp. 23. If Mr. Tam were correct that burdening the right to use that name in commerce is a restriction of pure speech calling for strict scrutiny, the argument would suggest that a decision to *grant* Mr. Tam a trademark—which would not merely burden similar speech by others, but prevent it outright—should be subject to strict First Amendment scrutiny as well.

To avoid such conundrums, the Court should reiterate that laws delineating the scope of trademark protection address commercial speech—both that of mark-holders and that of rival commercial speakers who may be accused of infringing or diluting mark-holders' rights. *S.F. Arts*, 483 U.S. at 535. To the extent such laws are properly limited to uses of trademarks in commerce, First Amendment challenges to their definitions of the scope of trademark rights or of the matter appropriate for trademark registration or protection thus should be considered under the standards applicable to commercial-speech regulations. *See id.*

This Court's decision in *San Francisco Arts* underscores the point. The Court there upheld the special statutory grant to the U.S. Olympic Committee (USOC) of exclusive rights to the word "Olympic" in the marketplace, even though some uses of the word to promote athletic or theatrical events might "go be-

yond the 'strictly business' context." 483 U.S. at 583. The Court held that because the Act primarily affected commercial speech and only "incidental[ly]" affected noncommercial expressive interests, any such incidental burden did not call for the scrutiny applicable to a direct restraint on fully protected speech, *id.* at 536–37 & nn. 15–16, and was justified by the substantial interest in securing to the USOC the "commercial value of [its] marks" and its "legitimate property right." *Id.* at 539, 541. *San Francisco Arts* directly contradicts Mr. Tam's argument that any incidental effect the regulation of his commercial and property rights in a mark may have on his expressive interests takes the law outside the bounds of commercial speech.

Adhering to the view that trademark laws regulate commercial speech would not suggest that the government could prohibit artists, journalists, musicians, writers, scholars, publishers, entities engaged in political or social advocacy, and others engaged in fully protected speech from calling themselves names of which the government disapproves. Any such laws would constitute restrictions of fully protected speech (even if those subject to them made money from their speech, *see Riley v. Nat'l Fed'n of the Blind*, 487 U.S. 781, 801 (1988)) and would be subject to strict scrutiny. The same would be true of laws that denied persons or groups trademark protection because of government disapproval of speech other than the mark itself. *Cf. Bd. of Cty. Comm'rs v. Umbehr*, 518 U.S. 668 (1996) (holding that the government may not deny access to government benefits because of disapproval of a person's speech).

The law at issue here, however, is very different from those examples. It does not prohibit Mr. Tam from calling his band "The Slants" or penalize him because of the content of his songs. The law affects only consequences of the use of the name in commerce as a trademark, and any burden the law imposes is only on Mr. Tam's ability to claim exclusive rights to profit from the name in the marketplace. Because it is so limited, the commercial-speech regulation is not "inextricably intertwined" with regulation of pure speech, *see Fox*, 492 U.S. at 474; *Jordan*, 743 F.3d at 520–22. Accordingly, to the extent such a law is considered a regulation of or burden on speech, it should be analyzed under the standards applicable to commercial speech.

II. Commercial-speech regulations are subject to intermediate First Amendment scrutiny.

A. This Court has long applied intermediate scrutiny to content-based commercial-speech regulations.

For nearly four decades, the First Amendment standard that applies to restrictions on commercial speech has been clear: The government may regulate such speech where it has "substantial" interests in the regulation, the regulation "advances these interests in a direct and material way," and "the extent of the restriction on protected speech is in reasonable proportion to the interests served." *Edenfield v. Fane*, 507 U.S. 761, 767 (1993) (citing *Cent. Hudson*, 447 U.S. at 564). This standard—termed intermediate scrutiny or *Central Hudson* review—affords less protection for commercial speech than the strict scrutiny ordinarily applicable to fully protected speech, such as

political, literary, artistic or religious expression. This "common-sense distinction" between commercial and noncommercial speech stems from commercial speech's "subordinate position in the scale of First Amendment values." *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 455–56 (1978) (internal quotation marks omitted).

Mr. Tam suggests, however, that because the disparagement provision is "content-based" in the sense that its application turns on the content of a mark, the Court should apply the strict scrutiny normally applicable to restrictions on fully protected speech even if it recognizes that the affected speech is commercial. He suggests that any content-based restriction on commercial speech should be treated the same as content-based restrictions on speech about religious or political views. That position fails to acknowledge this Court's decisions recognizing that "regulation of commercial speech based on content is less problematic" than regulation of content-based noncommercial speech. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 65 (1983). In *Central Hudson* itself, the Court explained that "regulation of [commercial speech's] content" is permissible in part because such "speech, the offspring of economic self-interest, is a hardy breed of expression that is not particularly susceptible to being crushed by overbroad regulation." *Cent. Hudson*, 447 U.S. at 564 n.6. By contrast, "[i]n most other contexts, the First Amendment prohibits regulation based on the content of the message." *Id.*

The argument for strict scrutiny of content-based commercial-speech regulations also runs counter to a line of cases in which this Court has applied intermediate scrutiny to content-based restrictions on lawful,

non-misleading commercial speech. *See, e.g., Greater New Orleans Broad. Ass'n, Inc. v. United States*, 527 U.S. 173, 176, 183–84 (1999) (striking down a statute that forbade broadcast advertising of casino gambling as applied to advertisements in jurisdictions where such gambling was legal); *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 478, 482, 488 (1995) (invalidating federal law that prohibited labels for beer, but not wine or distilled spirits, from displaying alcohol content); *Fla. Bar v. Went For It, Inc.*, 515 U.S. 618, 620, 635 (1995) (upholding rule prohibiting attorneys from sending certain written solicitations to prospective clients that "relate[d] to an accident or disaster involving the person to whom the communication [was] addressed or a relative of that person"); *Bolger*, 463 U.S. at 61, 68–69 (holding unconstitutional as applied a statute that prohibited unsolicited advertisements for contraceptives); *In re R.M.J.*, 455 U.S. 191, 194, 205–07 (1982) (holding unconstitutional a rule that barred attorney advertisements from identifying jurisdictions in which attorneys were licensed). In each case, the restrictions turned on the "subject matter" of the speech and the identity of the speaker. Yet in each case, the Court held that the restrictions were subject to intermediate scrutiny.

Indeed, *Central Hudson* itself struck down a regulation that banned all "advertising intended to stimulate the purchase of utility services," a content-based restriction that, under Mr. Tam's position, would be subject to strict scrutiny. *Cent. Hudson*, 447 U.S. at 559 (internal quotation marks omitted). Thus, Mr. Tam's argument for strict scrutiny suggests that the Court applied the wrong standard in the very case that gave First Amendment intermediate scrutiny its name.

B. *Sorrell* and *Reed* do not alter the intermediate scrutiny standard for restrictions on commercial speech.

Mr. Tam's argument for strict scrutiny hinges on this Court's recent decisions in *Reed v. Town of Gilbert*, 135 S. Ct. 2218 (2015), and *Sorrell v. IMS Health*, 564 U.S. 552. Those decisions, however, do not step back from the Court's well-established distinction between commercial and noncommercial speech, even for restrictions that are content-based.

In *Sorrell*, the Court struck down on First Amendment grounds a Vermont law that prohibited, with limited exceptions, "pharmacies, health insurers, and similar entities from disclosing or otherwise allowing prescriber-identifying information to be used for marketing" and "pharmaceutical manufacturers and detailers from using the information for marketing." 564 U.S. at 563. The Court held that the law imposed a "speaker- and content based burden on protected expression" by allowing the use of information by other entities, such as "private or academic researchers," and for non-marketing purposes, such as "educational communications." *Id.* at 564. The Court therefore concluded that "heightened judicial scrutiny [was] warranted." *Id.* at 565.

Importantly, however, the Court went on to note the two types of "heightened" scrutiny that could apply to the speech at issue: "a special commercial speech inquiry or a stricter form of judicial scrutiny" for noncommercial speech. *Id.* at 571. The Court concluded that it was unnecessary to decide whether the speech at issue was commercial or noncommercial because, even under the less stringent "commercial speech inquiry," the law was unconstitutional. *See id.*

at 571–72 (citing *Cent. Hudson*, 447 U.S. at 566). Far from announcing a new rule, *Sorrell*'s repeated distinction between the standard for commercial speech and the "stricter" standard for noncommercial speech supports the continued application of intermediate scrutiny to commercial speech.

As the *Sorrell* opinion makes clear, the phrase "heightened scrutiny" does not refer to strict scrutiny. *Sorrell*'s application of intermediate scrutiny contradicts any such reading, and many of the Court's other opinions demonstrate that "heightened scrutiny" is a *generic* term indicating a level of scrutiny higher than rational-basis scrutiny, including both intermediate scrutiny and strict scrutiny. For example, the Court's equal protection precedents frequently use the term "heightened scrutiny" to describe the intermediate scrutiny applicable to gender classifications. *See, e.g., United States v. Virginia*, 518 U.S. 515, 533, 555 (1996); *Clark v. Jeter*, 486 U.S. 456, 463, 465 (1988). In the First Amendment area, the Court has likewise referred to the intermediate scrutiny applied to limits on political contributions as a form of "heightened judicial scrutiny." *Nixon v. Shrink Mo. Gov't PAC*, 528 U.S. 377, 391 (2000). The Court's opinion in *Sorrell* uses the term "heightened scrutiny" in the same way—as a general description of scrutiny above a rational-basis test—not as another way of saying strict scrutiny.

Likewise, *Reed* offers no support for application of strict scrutiny to commercial-speech regulations. *Reed* struck down a local law that prohibited outdoor signs without a permit but exempted twenty-three categories of signs, including political and ideological signs and temporary directional signs of short duration. *See*

135 S. Ct. at 2224–25. The law did not, however, exempt signs that the plaintiffs—a church and its pastor—sought to display for extended periods to publicize the time and location of upcoming church services. *Id.* at 2225. The Court cited *noncommercial-speech* cases for the proposition that "[c]ontent-based laws—those that target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests." *Id.* at 2226. The Court cited *Sorrell*, a commercial-speech case, only in defining the "commonsense meaning of the phrase 'content based.'" *Id.* at 2227. The Court explained that "[g]overnment regulation of speech is content based if a law applies to particular speech because of the topic discussed or the idea or message expressed." *Id.* (citing *Sorrell*, 564 U.S. at 565). The Court thus found that the town ordinance in *Reed* was content-based because it "single[d] out specific subject matter for differential treatment." *Id.* at 2230. The Court then applied strict scrutiny to the ordinance as a content-based regulation of *noncommercial speech*. *Id.* at 2231.

Critically, *Reed* did not hold—or even discuss the possibility—that strict scrutiny would apply to content-based *commercial-speech* restrictions. Surely if the Court intended to overrule its many decisions distinguishing commercial speech from noncommercial speech, its opinion would acknowledge such a momentous aspect of the decision. *Reed* does not do so. Indeed, the Court's opinion does not use the term "commercial speech" even once.

C. Applying strict scrutiny to content-based commercial-speech regulations is neither necessary nor proper.

The view that content- or speaker-based commercial-speech restrictions are subject to strict scrutiny has exceptionally far-reaching implications because commercial-speech restrictions are always, or virtually always, content- or speaker-based in the broad sense in which the Court has used the term in *Reed* and *Sorrell*. Commercial-speech restrictions, by definition, apply to commercial messages and commercial speakers, and usually to particular types of speakers and messages (for example, the written solicitations from attorneys that were at issue in *Went for It*). More broadly, "the classification of speech between commercial and noncommercial is itself a content-based distinction." *CTIA—The Wireless Ass'n v. City of Berkeley*, 139 F. Supp. 3d 1048, 1061 n.9 (N.D. Cal. 2015), *app. filed*, No. 16-15141 (9th Cir. Feb. 1, 2016). As one scholar has observed, "this argument, that a statute which treats marketing differently than other speech, is constitutionally infirm *on that ground*, makes a hash of the commercial-speech doctrine because, by definition, the commercial-speech doctrine is applicable only to a specific type of content—commercial content." Tamara Piety, *The First Amendment and the Corporate Civil Rights Movement*, 11 J. Bus. & Tech. L. 1, 20 (2016).

1. Applying strict scrutiny to commercial speech would threaten a broad range of commonsense regulations.

Applying strict scrutiny to content-based commercial-speech restrictions—in addition to making a mess of the case law—would risk devastating consequences

for the government's ability to adopt commonsense marketplace regulations. Regulations of commercial speech typically apply to specific market participants, such as food manufacturers, debt collectors, and drug companies, and they deal with problems unique to industries in which those participants operate. For example, federal law limits the circumstances in which food manufacturers can make claims about health benefits of their products, 21 C.F.R. § 101.14, or advertise the addition of vitamins to infant formula, *id.* § 107.10(b). It forbids debt collectors from advertising the sale of a debt to coerce a debtor to pay it and from publishing lists of consumers who refuse to pay debts. 15 U.S.C. § 1692d(3)–(4). If content-based commercial-speech restrictions are subject to strict scrutiny, all these restrictions would have to satisfy such scrutiny because they apply "to particular speech because of the topic discussed or the idea or message expressed." *Reed*, 135 S. Ct. at 2227.

In the disclosure context, too, the government frequently mandates speech on a particular subject and requires that commercial actors use specific language. For example, vehicle manufacturers must label, in accordance with Environmental Protection Agency rules, each vehicle with its fuel economy. 49 U.S.C. § 32908(b). Drug manufacturers must include "black box" warnings on labels of certain drugs to emphasize particular hazards. 21 C.F.R. § 201.57. And food manufacturers must disclose nutritional information about their products. *Id.* § 101.9.

The government would have a much higher burden to justify rules like these if they were deemed content-based and subject to strict scrutiny. It "is the rare case" in which the government "demonstrates

that a speech restriction is narrowly tailored to serve a compelling interest," as required to satisfy strict scrutiny. *Williams-Yulee*, 135 S. Ct. at 1665–66. Indeed, in the noncommercial-speech context, the Court has described content-based restrictions as "presumptively invalid." *R.A.V. v. City of St. Paul*, 505 U.S. 377, 382 (1992). Applying such scrutiny to content-based commercial-speech restrictions could obliterate many laws and regulations that are longstanding and critical to the protection of consumers.

Indeed, one need look no further than the statute at issue here to see the potential consequences of applying strict scrutiny to content-based commercial-speech rules. In addition to forbidding registration of disparaging marks, the statute also prohibits registration of "deceptive" marks, 15 U.S.C. § 1052(a); marks containing certain "geographical indications" with respect to wine or spirits, *id.*; marks comprising flags and insignia of the United States and other domestic and foreign governmental entities, *id.* § 1052(b); marks using names or images of living individuals, or of United States Presidents, living and dead, *id.* § 1052(c); marks that are "confusing" in similarity to other marks, *id.* § 1052(d); marks that are "merely descriptive" or "functional," *id.* § 1052(e); and, subject to certain procedural requirements, marks that would "be likely to cause dilution by blurring or dilution by tarnishment" of other marks, *id.* § 1052(f).

All of these limitations are based on the *content* of a mark and, if Mr. Tam's broadest arguments were correct, would be subject to strict scrutiny. These longstanding and useful limits on registration might survive such scrutiny, but they might not. In the realm of fully protected speech, for example, limita-

tions on confusing or deceptive speech, or speech that appropriated a national symbol, would be unlikely to satisfy strict scrutiny. *See United States v. Alvarez*, 132 S. Ct. 2537 (2012). That such limitations are generally permissible in the realm of commercial speech, *see id.* at 2547 (plurality), is in large measure attributable to the less exacting, though still heightened, standard applicable to commercial-speech regulation. But even if these limits on registration might survive strict scrutiny, the fundamental question is whether there is reason to apply such strong medicine to laws affecting the commercial use of words. This Court's decisions have consistently indicated that the answer to that question is no.

2. Applying strict scrutiny to commercial speech would harm protection of pure speech and is unnecessary to protect commercial speech.

Applying strict scrutiny to content-based commercial-speech restrictions could also unnecessarily create unintended, harmful consequences for the protection of noncommercial speech. "To require a parity of constitutional protection for commercial and noncommercial speech alike could invite dilution, simply by a leveling process, of the force of the [First] Amendment's guarantee with respect to the latter kind of speech." *Ohralik*, 436 U.S. at 456. That is, if strict scrutiny were applied to the many valuable commercial-speech regulations on which the public has depended for decades, the inclination of courts to uphold sensible marketplace rules might lead them to relax strict scrutiny as we know it, to the detriment of speakers engaged in fully protected expression.

That result would be particularly troubling because application of strict scrutiny is not necessary to curb true government excesses in the realm of commercial speech. *Central Hudson* intermediate scrutiny is already quite protective, perhaps in some cases overly protective, of commercial-speech interests. For example, in this case, assuming that the government's arguments against treating the disparagement provision as restricting or burdening speech fail, the statute can be sustained under *Central Hudson* only if the interests identified by the government (*see* Pet. Br. 48–50) are not only legitimate, but also "substantial," and if the statute advances them "directly" and in a "reasonabl[y] proportion[ate]" way. *Edenfield*, 507 U.S. at 767.

The requirement of a substantial government interest gives very significant protection to the interests Mr. Tam seeks to assert. This Court held in *Bolger v. Youngs Drug Products Corp.* that the interest in suppressing offensive speech does not qualify as a substantial, or even legitimate, government interest with respect to commercial speech any more than it does with respect to fully protected speech. 463 U.S. at 71–72. Thus, if the disparagement provision is subject to First Amendment scrutiny, the determinative issues are whether the government's interests can meaningfully be distinguished from the one rejected in *Bolger*, whether they are substantial, and whether the disparagement provision advances them directly and proportionately enough to be sustained under the *Central Hudson* test.

On those questions we express no view, in part because, in light of the parties' focus on other issues, the government's brief does not present a fully formed

argument concerning the application of intermediate scrutiny to the statute in light of the interests the government asserts are served by the provision. That omission is understandable given the government's theory that the case involves no restriction or burden on speech of any kind necessitating review under any First Amendment standard.

If, however, the Court concludes that First Amendment scrutiny *is* required, application of the appropriate intermediate scrutiny will be critical to the outcome. Unlike strict scrutiny, which the government has never asserted this statutory provision could survive, intermediate scrutiny would not necessarily condemn the provision. Under such circumstances, it would be imprudent to sustain a decision striking down a federal statute as facially unconstitutional without receiving briefing fully addressing the application of the proper level of scrutiny. Thus, the Court may wish to request additional briefing if it concludes that the statute restricts or burdens commercial speech.

CONCLUSION

If the Court finds that the disparagement provision restricts or burdens Mr. Tam's speech, it should evaluate the constitutionality of that restriction or burden under the intermediate scrutiny standard applicable to regulation of commercial speech.

Respectfully submitted,

SCOTT L. NELSON
Counsel of Record
ALLISON M. ZIEVE
JULIE A. MURRAY
PUBLIC CITIZEN LITIGATION GROUP
1600 20th Street NW
Washington, DC 20009
(202) 588-1000
snelson@citizen.org
Attorneys for Amicus Curiae

November 2016

RECORD AND BRIEFS

No. 15-1293

SUPREME COURT, U.S. FILED
NOV 21 2016
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

BRIEF OF *AMICUS CURIAE* PUBLIC KNOWLEDGE IN SUPPORT OF NEITHER PARTY

Charles Duan
PUBLIC KNOWLEDGE
1818 N Street NW
Suite 410
Washington, DC 20036
(202) 861-0020
cduan@publicknowledge.org

Phillip R. Malone
Counsel of Record
Jef Pearlman
JUELSGAARD INTELLECTUAL PROPERTY AND INNOVATION CLINIC
STANFORD LAW SCHOOL
559 Nathan Abbott Way
Stanford, CA 94305
(650) 725-6369
pmalone@stanford.edu

Counsel for Amicus Curiae

TABLE OF CONTENTS

TABLE OF AUTHORITIES iii

INTEREST OF AMICUS CURIAE 1

SUMMARY OF THE ARGUMENT 2

ARGUMENT 5

I. Cautious Analysis Is Necessary Where, as Here, the Public Has a First Amendment Interest That Competes with Respondent's 5

A. The Court Has Historically Balanced Competing Speech Interests 5

B. The Court Should Continue Its Tradition and Balance the Speech Interests of the Applicant and of the Public 8

II. The Long History of Trademark Law and the First Amendment Shows the Special Need to Consider the Public's Competing Speech Interests 10

A. Courts Apply the First Amendment as a Limitation on Trademarks 11

B. Congress Has Expanded Trademark Rights Carefully to Avoid Conflict with the First Amendment 14

III. Concern for the Public's First Amendment Interests Has Concrete Implications for Any Decision in This Case 16

A. The Federal Circuit's Analysis of Trademark Applicants' Expressive Interests Was Incorrectly One-Sided, Ignoring the Opposed Public Interest 17

B. Special Attention Must Be Given to the Unique Fact that, from a First Amendment Perspective, Disparaging Speech Is Unusually Important 20

C. Considering the Public's First Amendment Interests Maintains the Proper Balance Between the First Amendment and the Lanham Act 22

CONCLUSION 25

TABLE OF AUTHORITIES

Page(s)

Cases

Bartnicki v. Vopper,
532 U.S. 514 (2001) 7

CBS v. Democratic National Committee,
412 U.S. 94 (1973) 6, 7

Cohen v. California,
403 U.S. 15 (1971) 20, 21

Decorations for Generations, Inc. v. Home Depot USA, Inc.,
128 F. App'x 133 (Fed. Cir. 2005) 12

Eldred v. Ashcroft,
537 U.S. 186 (2003) 14

Entrepreneur Media, Inc. v. Smith,
279 F.3d 1135 (9th Cir. 2002) 8

J. Kohnstam, Ltd. v. Louis Marx & Co.,
280 F.2d 437 (C.C.P.A. 1960) 8

KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.,
543 U.S. 111 (2004) 12, 15

Mattel, Inc. v. MCA Records, Inc.,
296 F.3d 894 (9th Cir. 2002) 12, 13, 16

Moseley v. V Secret Catalogue, Inc.,
537 U.S. 418 (2003) 16

Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.,
469 U.S. 189 (1985)
..... 12, 14, 23

Radiance Found., Inc. v. NAACP,
786 F.3d 316 (4th Cir. 2015) 12, 13

Red Lion Broadcasting Co. v. FCC,
395 U.S. 367 (1969) 6

Rogers v. Grimaldi,
875 F.2d 994 (2d Cir. 1989)..... 12, 13

San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.,
483 U.S. 522 (1987)
..... 10, 21, 24

Smith v. Wal-Mart Stores, Inc.,
537 F. Supp. 2d 1302 (N.D. Ga. 2008) 13

Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.,
212 F.3d 157 (3d Cir. 2000)..... 16

Toyota Motor Sales, U.S.A., Inc. v. Tabari,
610 F.3d 1171 (9th Cir. 2010) 15

Statutes

15 U.S.C. § 1064(c) (2012) 14

15 U.S.C. § 1115(b)(4) (2012)..... 15

15 U.S.C. § 1125(c)(3)(A) (2012)..... 15

15 U.S.C. § 1125(c)(3)(A)(i) (2012)..... 15

15 U.S.C. § 1125(c)(3)(B) (2012) 15

15 U.S.C. § 1125(c)(3)(C) (2012) 15

Other Authorities

Gregory P. Magarian, *The Jurisprudence of Colliding First Amendment Interests*, 83 Notre Dame L. Rev. 185 (2007) 5, 9

H.R. Rep. No. 104-374, 1996 U.S.C.C.A.N. 1029 16

Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 Trademark Rep. 797 (2016) 19

Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 Yale L.J. 1687 (1999) 11, 19, 24

McCarthy on Trademarks and Unfair Competition (4th ed. 2004) 14

Scott Wells, *Sunlight Challenges a Trademark Takedown*, Sunlight Foundation (Sept. 30, 2014), http://sunlightfoundation.com/blog/2014/09/30/sunlight-challenges-a-trademark-takedown/ [http://perma.cc/MZB5-A924] 19

INTEREST OF AMICUS CURIAE

Amicus curiae Public Knowledge is a nonprofit organization that is dedicated to preserving the public's access to knowledge and promoting creativity through balanced intellectual property rights. As part of this mission, Public Knowledge advocates on behalf of the public interest for balanced approaches to extending intellectual property rights. *Amicus* has no direct interest in the outcome of this case and submits this brief in support of neither party.

Though its recent briefs before this Court have primarily been in the fields of patent and copyright law, Public Knowledge's consumer- and public-based approach to intellectual property has important applicability to this trademark case, in which the interests of the trademark applicant and the government are well explicated by the parties but the interests of the public in being able to use trademarked language for a variety of speech purposes are presented by neither. This brief is accordingly submitted to fill that void by identifying the relevance and importance of the public's interest in this case.[1]

---

[1] The parties have given blanket consent to the filing of *amicus* briefs; their written consents are on file with the Clerk. No counsel for a party authored this brief in whole or in part, and no party or counsel for a party made a monetary contribution intended to fund its preparation or submission. No person other than amicus or its counsel made a monetary contribution to the preparation or submission of this brief.

SUMMARY OF THE ARGUMENT

It is a strange situation where application of the First Amendment may lead to suppression of speech, yet that is the situation of this case. Respondent Tam contends that his right to freedom of speech requires the government to register a trademark for his band. If successful, Tam will receive a right, enforceable by courts and federal agencies, to stop others in certain situations from using the words he has registered as a mark. Those others, likely far larger in number than Tam's one band, will thus be less able to express themselves in the ways of their choosing. The net effect of freedom of speech, here, may be less speech.

That this result is strange does not mean it is wrong—*amicus* explicitly takes no position on the disposition of this case—but it does commend to this Court an extra degree of caution in deciding the case and crafting its opinion. The oddity of the situation arises because it is not only Respondent's First Amendment interest at stake; it is also the First Amendment interest of the people at large, a longstanding interest in freedom to choose the words of their messages.

1. Trademark law generally, and Respondent's theory specifically, collide head-on with this public First Amendment interest. Granting or enforcing a trademark by definition reduces the volume of ideas and number of speakers by restricting the abilities of everyone other than the registrant to speak in certain ways using the trademarked words.

Where two First Amendment interests conflict with each other, this Court has taken a cautious approach of balancing the competing interests. Its

decisions are narrowly tailored to the relevant contexts, so as to avoid making sweeping pronouncements that might strike the First Amendment balance wrongly in future cases. The Court should continue to follow that approach here.

2. Cautious balance is especially warranted in this case because the public's First Amendment interest in word choice has historically been viewed as especially strong in trademark law. Congress, this Court, and lower courts have consistently cabined the grant and enforcement of trademark rights within boundaries imposed by the First Amendment in three important ways. First, courts have recognized that the First Amendment demands a justification for granting exclusive rights in words or phrases. Second, courts have construed the Lanham Act to permit the public to use existing trademarks expressively. Finally, the Lanham Act was carefully designed with safeguards for free expression.

This longstanding recognition of the public's First Amendment right to use words renders it especially important to take the public's right into account here.

3. Accounting for the public's First Amendment interest in choosing words offers at least three guideposts to be followed in deciding this case.

First, that public interest reveals the Federal Circuit's one-sided analysis of expressive interests to be incomplete. The Federal Circuit wrote that Respondent and other trademark applicants have a First Amendment interest in expressing themselves through choice of trademark, and restrictions of § 2(a) on that choice have the effect of chilling speech.

Yet accounting for the public interest reveals that the converse option, lifting those § 2(a) restrictions, could potentially chill speech even more, unless the existing First Amendment limits on the grant and enforcement of trademark rights are carefully maintained. Any analysis of Respondent's expressive use of trademarks must also analyze the counterbalancing expressive interests of the public.

Second, the unique First Amendment value of disparaging speech should be considered in assessing that public interest. Disparaging words carry certain emotional weights to them, and as this Court has recognized, those emotional components of words are just as important to free speech as their cognitive meanings. That this case revolves around disparaging words, then, actually heightens the concerns about limiting the public's choice of words through increased trademark protection.

Third, a narrow approach is necessary to ensure that important aspects of trademark law are not left open to question in future cases. In particular, too sweeping a ruling on trademark applicants' First Amendment interests could open the door to challenges to trademark law's prohibition on registration of generic and descriptive marks, a prohibition that has long safeguarded the public's right to choose the words of speech. Similarly, an overbroad ruling or incomplete reasoning or language in this case could result in future cases that curtail existing trademark protections on the public's vital right to use words for comment, criticism, parody, comparison, and other recognized exceptions.

Trademark law presents an inherent tension between granting exclusive rights in certain language

to trademark registrants and preserving the rights of the public at large to continue to use that language for a variety of expressive, political, critical, comparative, or other important speech purposes. Regardless of how this particular case is disposed, it is essential that the Court ensure that intellectual property interests do not unduly restrict the public's right to speak with the full power of language.

ARGUMENT

I. Cautious Analysis Is Necessary Where, as Here, the Public Has a First Amendment Interest That Competes with Respondent's

Though the arguments of the parties largely revolve around the First Amendment interests of trademark registration applicants, there is another crucial First Amendment interest involved: the interest of the public in using words in discourse—an interest that trademark protection by definition diminishes. This Court has long taken a cautious approach in situations of two colliding constitutional interests, and that cautious approach is warranted strongly here.

A. The Court Has Historically Balanced Competing Speech Interests

When faced with opposed speech interests of two competing entities the consistent approach has been to consider those competing speech interests carefully on balance to reach a result narrowly tailored to the case. Such situations of colliding First Amendment interests occur frequently in the case law. *See generally* Gregory P. Magarian, *The Jurisprudence of*

Colliding First Amendment Interests, 83 Notre Dame L. Rev. 185, 187-88 (2007).

An early case to address this situation of competing First Amendment interests, *Red Lion Broadcasting Co. v. FCC*, demonstrates a process of careful balancing. 395 U.S. 367 (1969). There, the Court considered whether regulations requiring broadcasters to give equal airtime to opposing viewpoints violated the broadcasters' speech interest in expressing their desired perspectives. *See id.* at 386. Though this interest was cognizable under the First Amendment, the Court countered that the listening public also had a First Amendment interest in having "an uninhibited market-place of ideas." *Id.* at 389. In view of the unusual technical nature of radio broadcasting, the Court balanced the interests to hold that "[i]t is the right of the viewers and listeners, not the right of the broadcasters, which is paramount," thus upholding the equal-time regulations. *Id.*

Just four years later, *CBS v. Democratic National Committee*, would again apply a cautiously context-specific approach to balancing opposed First Amendment interests. 412 U.S. 94 (1973). In that case, political organizations sought to compel a broadcast radio station to carry the organizations' advertisements. *See id.* at 98. As in *Red Lion*, the organizations advanced a First Amendment interest in balanced coverage of viewpoints, while the radio station asserted its interest in choosing what to broadcast. *See id.* at 101. Yet while application of *Red Lion* could have resolved the matter, the Court chose instead to reconsider "[b]alancing the various First Amendment interests," an act that it described as "a

task of great delicacy and difficulty." *Id.* at 102. The Court ultimately concluded that the station was not required to carry the organizations' advertisements, *id.* at 121, a result in a direction opposite to *Red Lion* and thus indicative of how context-specific the balancing of First Amendment interests can be.

Another example of this cautious balancing appears in *Bartnicki v. Vopper*, which concerned a statute prohibiting publication of illegally-obtained recordings of eavesdropping even where the publisher was innocent of the illegal act. *See* 532 U.S. 514, 517-18 (2001). The Court recognized that the speaker whose conversation was covertly recorded had a First Amendment interest in the privacy of his communications, *see id.* at 532 & n.22, and the publisher had a First Amendment interest in publishing the truthful, important information in the recording, *see id.* at 525. "Accordingly," wrote the Court, "it seems to us that there are important interests to be considered on *both* sides of the constitutional calculus." *Id.* at 533. Balancing those interests led to the conclusion that the publisher's interests took precedence over the speaker's. *See id.* at 534.

These precedents and others reveal a consistent pattern: Where a case presents two competing First Amendment interests, this Court carefully balances those interests in view of the specific context and situation at issue.

B. The Court Should Continue Its Tradition and Balance the Speech Interests of the Applicant and of the Public

The instant case presents a situation of competing First Amendment interests, and thus requires the sort of cautious balancing that this Court has previously performed. Respondent's speech interest is certain: he claims a right to obtain a trademark registration.

The competing First Amendment claim is that of the public, in its ability to choose words unimpeded by trademark regulation. Courts have consistently recognized a "broad societal interest in preserving common, useful words for the public domain." *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1148 (9th Cir. 2002); *see also J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 438 (C.C.P.A. 1960) ("[L]anguage . . . was always deemed to be in the public domain.").

This competing claim is highly important. As explained in detail in Section II, the public's interest in using words free of undue restrictions from trademarks is long recognized and regularly accommodated by both courts and Congress. That interest cannot be discarded in this case.

Just as in *Red Lion*, *CBS*, and *Bartnicki*, the two First Amendment interests here are opposed: if Respondent does indeed have a First Amendment right to his registration, then the public loses its right to use the registered words as freely as before. Thus, that line of cases calls for cautious balancing of these two competing interests.

Notably, those cases emphatically do not dictate what the result of that balancing should be, other than to say that the result must be carefully tailored to the situation. Even attempts to structure a framework around the case law of colliding First Amendment interests fail to illuminate a result here. One commentator characterizes that case law as pitting *autonomy* interests, property owners' right to choose what message their property is used to express, against *access* interests of those who wish to commandeer the property for spreading a different message. *See* Magarian, *supra*, at 191-210. The commentator suggests that the autonomy interest generally is considered to be stronger.[2] *See id.* at 209. But it is unclear which party in this case has each interest. What is probably the correct view is that the public is the property owner with the autonomy interest, since all words *ab initio* are in the public domain; Respondent would have an access interest in appropriating words from that public domain to serve his personal ends. That reading is of course in direct tension with the Federal Circuit's opinion, which gave primacy to Respondent's First Amendment interest but ignored the public's interest entirely, suggesting the complexity of the balancing analysis to be done.

---

[2] *Amicus* notes that it is not in full agreement with the correctness of this proposition—indeed, the commentator also disagrees as a normative matter—but posits the proposition solely to show its ineffectiveness in deriving a result in this case.

Consequently, it is incumbent upon this Court to balance Respondent's First Amendment interests against those of the public, in a manner carefully drawn to the particular context in which this collision of interests is occurring. Section III explains certain effects of that balancing, and cautions against any result that might imprudently affect future cases that would require their own independent analysis and balancing.

II. The Long History of Trademark Law and the First Amendment Shows the Special Need to Consider the Public's Competing Speech Interests

Balancing the public's First Amendment interest against that of trademark applicants takes on heightened importance in this case because the public interest in question, namely the interest in choosing the words of speech, has long been recognized as a key limitation on trademark law. "The Lanham Act is carefully crafted to prevent commercial monopolization of language that otherwise belongs in the public domain." *See San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 573 (1987). That longstanding recognition may be seen both in trademark case law and in the trademark statutes, as explained below.

A long history of jurisprudence from this Court and lower courts informs the application of the First Amendment to the present case. This jurisprudence recognizes that when a trademark monopoly is granted, the interests of a single speaker collide with the First Amendment rights the rest of the public whose expression will be constrained. It also

recognizes that if a trademark monopoly were unlimited, then trademark owners would be able to prevent anyone from engaging not only in confusing commercial speech but also in speech that is critical, parodic, comparative or otherwise expressive.

To resolve these tensions, Congress and courts have carefully circumscribed (1) the registration and grant of trademark rights, requiring that each mark justify its associated cost of removing a word or words from the public domain; and (2) the enforcement of trademark rights, such that a mark does not limit the public's right to engage in critical, expressive, creative, or otherwise non-commercial speech.

A. Courts Apply the First Amendment as a Limitation on Trademarks

The public has a strong interest in the availability of words for the many possible uses that do not coincide with signaling the origin of goods. Thus, the First Amendment limits the extent to which trademark owners can enforce their marks. Just as the government may not restrain free speech, trademark holders cannot use a government-provided, judicially-enforced monopoly to censor criticism, creative expression, competitive comparisons, or other speech protected by the First Amendment. These necessary limits reflect how the contours of trademark rights are shaped by the necessity to protect the public's interest in free expression.

Trademarks have a natural tendency to diminish the public's ability "to discuss, portray, comment, criticize, and make fun of companies and their products." Mark A. Lemley, *The Modern Lanham Act*

and the Death of Common Sense, 108 Yale L.J. 1687, 1710-11 (1999). This court has noted the "undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first." *See KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004). In recognition of this potential for trademarks to suppress public speech, "[c]ourts have uniformly understood that imposing liability under the Lanham Act for such speech is rife with First Amendment problems." *Radiance Found., Inc. v. NAACP*, 786 F.3d 316, 323 (4th Cir. 2015). Thus, courts "construe the [Lanham] Act narrowly to avoid . . . conflict" with the First Amendment. *Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989).

One of the most basic concepts of trademark law, the categories of marks that cannot be registered, reflects a concern for the public interest in word choice. Where a mark is the generic term for referring to a product, the mark is "not registerable." *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985). If a mark is merely descriptive, the applicant must overcome a barrier to protection by proving that some secondary meaning, an association with *its* particular brand, justifies obtaining exclusive rights in the word or phrase. *Decorations for Generations, Inc. v. Home Depot USA, Inc.*, 128 F. App'x 133, 136 (Fed. Cir. 2005).

Marks once registered—even the most fanciful or well-known brand names—are still subject to First Amendment scrutiny to ensure that assertion of them does not suppress public criticism or commentary. For example, in *Mattel, Inc. v. MCA Records, Inc.*, the Ninth Circuit held that a song parodying the famous

Barbie doll was allowed to use the trademark BARBIE because to hold otherwise would deprive the public of an important word of discourse. *See* 296 F.3d 894, 902 (9th Cir. 2002). "Trademarks often fill in gaps in our vocabulary and add a contemporary flavor to our expressions," the court explained, recognizing that public interest in word choice. *Id.* at 898-900.

Similarly, the Second Circuit's decision in *Rogers v. Grimaldi* held that the Lanham Act did not permit trademark owners to restrain titles of artistic expression, again placing the word choice interest of the public before that of the trademark owner. *See* 875 F.2d at 998-99. The Fourth Circuit similarly protected a satirist's choice of title from trademark liability, concluding that "any other holding would severely restrict all kinds of speakers from criticizing all manner of corporate positions and activities and propel the Lanham Act into treacherous constitutional terrain." *Radiance*, 786 F.3d at 329. *See also Smith v. Wal-Mart Stores, Inc.*, 537 F. Supp. 2d 1302 (N.D. Ga. 2008) ("editorial or artistic parody" held not actionable under trademark "because of the free speech protections of the First Amendment").

The common thread among these and numerous other cases is that courts are careful in trademark cases "to account for the full weight of the public's interest in free expression." *Mattel*, 296 F.3d at 900. In the present trademark case, that public interest must be taken into account as well.

B. Congress Has Expanded Trademark Rights Carefully to Avoid Conflict with the First Amendment

A clear understanding of the public interest limits on trademark law may further be found in trademark legislation itself. The text of the Lanham Act and the legislative history of subsequent amendments reveal a sensitivity among members of Congress to the tension between the First Amendment and trademark law. Congress therefore took steps to minimize this tension, as *Rogers* and its progeny have done. *Cf. Park 'N Fly,* 469 U.S. 189 at 201 (noting safeguards in Lanham Act to prevent commercial monopolization of language); *see also Eldred v. Ashcroft*, 537 U.S. 186, 221-22 (2003) (in the analogous context of copyright, discussing "free speech safeguards" included in the Copyright Act to address First Amendment concerns).

The classic fair use defense enshrined in the Lanham Act is one example of how Congress narrowed the scope of trademark rights to avoid friction with the First Amendment.[3] The use of a

---

[3] The Lanham Act includes other mechanisms as well. For example, third parties are empowered to petition for a trademark to be cancelled when the mark has become the generic way to refer to a particular type of product. 15 U.S.C. § 1064(c) (2012). This process reflected a compromise to appease critics who worried that federal trademark registration would create monopolies. *McCarthy on Trademarks and Unfair Competition* § 5:4 (4th ed. 2004). Cancelling existing marks once they become descriptive sets aside the interests of a trademark owner where a word's primary significance is expressive rather than source identifying.

mark "which is descriptive of and used fairly and in good faith only to describe . . . goods or services" is not trademark infringement. 15 U.S.C. § 1115(b)(4) (2012).[4] This defense prevents entities from "depriv[ing] commercial speakers of the ordinary utility of descriptive words." *See KP Permanent Make-Up, Inc.*, 543 U.S. at 122. Even where the use of a mark results in some consumer confusion, courts have declined to read fair use out of the Lanham Act. *Id.* at 112.

In 1995, Congress expanded the reach of the Lanham Act by adding a cause of action for trademark dilution through the Federal Trademark Dilution Act ("FTDA"), but not without attempting to address concerns that overextending trademark rights might harm free expression. Congress explicitly provided that "parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner," "[a]ll forms of news reporting," and any "noncommercial use" would not be actionable under the FTDA. 15 U.S.C. § 1125(c)(3)(A)(i), (3)(B), (3)(C) (2012).

---

[4] Courts have also recognized a *nominative* fair use defense, but "unlike classic fair use, nominative fair use is not specifically provided for by statute." *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1183, n.11 (9th Cir. 2010). Nominative fair use is yet another example of a judicially created release valve for the First Amendment. In passing the Federal Trademark Dilution Act ("FTDA"), Congress provided that "nominative or descriptive fair use" "shall not be actionable as dilution by blurring or dilution by tarnishment." 15 U.S.C. § 1125(c)(3)(A) (2012).

The legislative history of the FTDA also reflects a recognition among members of Congress that at least these safeguards in the FTDA were necessary to preserve free expression. "[T]he FTDA's sponsors in both the House and the Senate were aware of the potential collision with the First Amendment." *Mattel*, 296 F.3d at 905, *see also* H.R. Rep. No. 104-374 at 4, 1996 U.S.C.C.A.N. 1029, 1031 (discussing various "legitimate" First Amendment problems with the FTDA). The first attempt at adding antidilution provisions to the Lanham Act in 1988 failed "based on a concern that it might have applied to expression protected by the First Amendment." *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 431 (2003) (citation omitted). To address these concerns, Congress added the parody, commentary, and noncommercial use exemptions noted above. *See Mattel*, 296 F.3d at 905. Congress also set a high threshold for a mark to qualify as famous, reserving dilution for "extraordinary" cases. *Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.*, 212 F.3d 157, 173 (3d Cir. 2000).

The Lanham Act and the FTDA were carefully crafted to avoid restricting criticism or diminishing the public's free speech interest in word choice. The statutes thus further highlight the need in this case to balance trademark applicants' interests against those of the public.

III. Concern for the Public's First Amendment Interests Has Concrete Implications for Any Decision in This Case

It is no mere abstract platitude that the public maintains First Amendment interests in choice of

words for speech, for the presence of those interests has at least three direct implications here. Without opining on the proper disposition of this case, *amicus* submits that any decision, and especially any decision favoring Respondent, must account for the three concerns laid out below in order to give due weight to the public's First Amendment interests in this and future cases.

A. The Federal Circuit's Analysis of Trademark Applicants' Expressive Interests Was Incorrectly One-Sided, Ignoring the Opposed Public Interest

Though the analysis was not necessarily dispositive, the Federal Circuit below extensively discussed how an applicant for a trademark registration has an expressive interest in the mark, an interest that might be chilled by the restriction on registration of disparaging marks. While choice of mark undoubtedly serves the applicant's expressive desires to some degree, the implications that the Federal Circuit draws from that premise improperly ignore the public's competing First Amendment interest in word choice. This Court should not repeat that overly narrow reasoning.

The Federal Circuit began with the premise that Respondent Tam, an Asian-American, chose the name THE SLANTS for his band, a name that is traditionally considered disparaging to those of his own ethnicity, in an effort to "take back" the term for his own culture. *See* Pet. App. 24a-25a. Thus, reasoned the Court of Appeals, "Mr. Tam's band name is expressive speech." *Id.* at 32a. Denial of trademark registration under § 2(a) thus "creates a

strong disincentive to choose a 'disparaging' mark," in the court's view, thereby having a "chilling effect" on expressive communication. *Id.* at 34a.

The government disputes whether denial of registration has such an effect given that Respondent's use is not prevented, and that is a dispute this Court must resolve. But the Federal Circuit's analysis suffers another defect: In the course of supposedly protecting expressive interests of one, the court simultaneously and silently undermines the interests of others.

Respondent has an interest in expressing his views through choice of band name, but he is not the only one with that interest. Others may similarly wish to "take back" the racial slur. Others may wish to use the term for its intended purpose of disparaging Asians, a despicable but nevertheless protected expressive interest. Still others may wish to use the term for reasons wholly unrelated to its disparaging nature.

By invalidating § 2(a), the Federal Circuit vindicates Respondent's expressive interest but undermines the parallel interests of those others who may now no longer able to use the term THE SLANTS to express their own messages in all the ways they wish. Indeed, the court's lengthy exposition on the benefits of registration only emphasizes the analytical lapse, since a strong exclusive right in a registered trademark means a strong ability to stop others' expression.

A holding that registration of certain marks is constitutionally protected could create strangely perverse incentives for manipulating the registration

system to suppress speech. While Respondent's motives are taken to be honorable, another trademark applicant might see "taking back" a racial slur to mean blocking undesirable expression using the slur. Even worse, an applicant who supports racial disparagement might register a mark to prevent honorable "taking-back" causes from taking shape—if an anti-Asian band registered the mark first, then Tam would have been actually precluded from his campaign against racism. Registration of marks is well known to be an avenue to suppressing speech,[5] and it could easily be used to that effect here.

As one commentator put it, "it seems strange to interpret the Free Speech Clause in the First Amendment to give one entity a trademark right that can be used to suppress and punish other people's expression." Lisa P. Ramsey, *A Free Speech Right to Trademark Protection?*, 106 Trademark Rep. 797, 843 (2016). Certainly there are ways of reconciling the competing interests—including reconciling them in

---

[5] Trademark rights provide a mechanism for private entities to restrain speech by others, including—if not properly restrained—potential critics and parodists. *See* Lemley, *The Modern Lanham Act*, *supra*, at 1710-12 (1999) (discussing dozens of trademark disputes that raise free speech concerns); *see also* Scott Wells, *Sunlight Challenges a Trademark Takedown*, Sunlight Foundation (Sept. 30, 2014), http://sunlightfoundation.com/blog/2014/09/30/sunlight-challenges-a-trademark-takedown/ [http://perma.cc/MZB5-A924] (discussing a trademark takedown notice sent to a transparency-oriented nonprofit for providing information about a company's financial contributions to political candidates on a website).

Respondent's favor while preserving the public's interest—but the Federal Circuit's failure to even address this tension reflects a serious gap in its analysis that should not be repeated here.

B. Special Attention Must Be Given to the Unique Fact that, from a First Amendment Perspective, Disparaging Speech Is Unusually Important

The problem with ignoring the public's expression interests is compounded by the fact that the words at issue here and under § 2(a) generally are not ordinary commercial marks, but disparaging terms. Strong words of disparagement are especially important to public discourse and receive special protection under the First Amendment. Special care must be taken to ensure that the public may continue to make non-trademark uses of that language and language like it in future situations.

Disparaging words serve a uniquely important role in public discourse. In *Cohen v. California*, the Court found a First Amendment right in a Vietnam War protester's wearing of a jacket emblazoned with the obscenity "Fuck the Draft." *See* 403 U.S. 15, 16 (1971). The government argued that the protester could still practice his free speech rights with less offensive language, but this Court held that the emotive power of the obscenity was irreplaceable: "[M]uch linguistic expression serves a dual communicative function: it conveys not only ideas capable of relatively precise, detached explication, but otherwise inexpressible emotions as well. In fact, words are often chosen as much for their emotive as their cognitive force." *Id.* at 26. The odiousness of the

word choice was not ancillary to the expressive message, but rather was central to that message: "while the particular four-letter word being litigated here is perhaps more distasteful than most others of its genre, it is nevertheless often true that one man's vulgarity is another's lyric." *Id.* at 25. Thus, the Court held that the First Amendment must give "regard for that emotive function which practically speaking, may often be the more important element of the overall message sought to be communicated."[6] *Id.* at 26.

A disparaging term like THE SLANTS carries the same kind of emotional charge as a vulgarity like "Fuck the Draft." When such a charged word is removed from the public domain by trademark, there may be no substitutes that evoke the same important emotions or connotations even if there are semantic alternatives to the platonic meaning of that word. Each word is unique, particularly the types of words typically regulated by § 2(a).

The importance of emotional expression to the First Amendment certainly heightens Respondent's interest in using the mark and militates against

---

[6] *Cohen*'s principles are applicable outside that case's context of an offensive conduct charge. As Justice Brennan observed in his dissent in *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, a case arising under a federal statute analogous to the trademark laws, the term "The Best and Most Accomplished Amateur Gay Athletes Competition," is not an adequate alternative to "Gay Olympics," a phrase which should have been available for public use despite the Olympic Committee's exclusive right over the term "Olympics." 483 U.S. 532, 569-70 (1987) (Brennan, J., dissenting).

chilling of that interest through unregistrability. Yet it also raises a concern that registrability of disparaging marks will in turn chill important speech of other members of the public. Judge Dyk, in concurring in the decision below, appeared to recognize the former concern, suggesting that marks that constitute "core political speech" ought to receive special First Amendment protection over "purely commercial trademarks." Pet. App. 82a (Dyk, J., concurring in part and dissenting in part). But he did not consider or recognize the latter interest of the public, and following his views incautiously could lead to a net effect of greater suppression of "core political speech," the opposite of the result he intended.

The disparaging nature of the speech at issue emphasizes the need for caution in First Amendment analysis. Overextension of trademark protection for particularly expressive, political or critical speech, could curtail the public's ability to make similar uses of that speech and harm the public interest.

C. Considering the Public's First Amendment Interests Maintains the Proper Balance Between the First Amendment and the Lanham Act

Regardless of the determination of the constitutionality of § 2(a), this Court should steer well clear of broad grants of First Amendment protections to trademark applicants. In particular, wielding the First Amendment too powerfully to protect only applicants could undermine the existing prohibitions on registration of descriptive or generic marks, as well as on enforcement of marks against

non-trademark expression, prohibitions that have long safeguarded the public's right to choose words of speech.

Because this case may serve as precedent in future challenges to denials of marks, *amicus* urges the court to craft a rule that gives proper consideration to *all* of the First Amendment rights at stake. Explicitly noting that the public's First Amendment interests are an important part of the analysis in evaluating the grant of a trademark, as recognized by Congress in designing the Lanham Act and courts in interpreting the Act, will maintain the basis for future courts and the PTO to continue to deny overly descriptive or generic marks and to protect free expression.

Future cases may present a circumstance where denial is justified by a different, and likely substantial, government interest, such as denying descriptive or generic marks. In these cases, the PTO must make content-based distinctions in deciding whether to grant a trademark.[7] Such denials can be distinguished from the PTO's decision in this case when a different First Amendment interest of the public—the interest in using the marks *in commerce* —is taken into account. If the public interest is not included as a necessary ingredient, in this case and future cases, then the PTO's power to deny

---

[7] A descriptive mark "describes the qualities or characteristics of a good or service." *Park 'N Fly*, 469 U.S. at 194. Denying a mark because of what it describes could be considered a content-based restriction on speech.

descriptive or misleading trademarks may inadvertently be eroded.

Likewise, sensitivity to the public's other First Amendment interest—in using marks for free expression—in the grant or enforcement of a trademark will solidify the trend, from *Rogers* to *Radiance*, of guarding such expression from overbroad trademark enforcement. "Trademark theory offers no justification for . . . suppression of speech. It is an unintended consequence of the tendency to give unfettered property rights to trademark owners." Lemley, *The Modern Lanham Act*, *supra*, at 1713.

The First Amendment has always played a role in the development of trademark law. The First Amendment permits neither unfettered trademark rights nor plenary power to deny trademark rights. *See San Francisco Arts & Athletics*, 483 U.S. at 532. Instead, it acts as a moderating force on behalf of trademark owners and the public. The balancing of these interests is necessary for a healthy relationship between trademark rights and free speech to continue.

However the Court resolves the question of the facial validity of § 2(a) under the First Amendment, it should ensure that its reasoning and language recognize and protect the First Amendment speech interests of the public now and in future cases to use trademarked languages for expressive, political, critical, parodic, comparison and other legitimate purposes.

CONCLUSION

For the aforementioned reasons, the Court should ensure that its decision explicitly considers the First Amendment interests of *both* trademark applicants and the public and preserves the important balance between those interests.

Respectfully submitted,

Charles Duan
PUBLIC KNOWLEDGE
1818 N Street NW
Suite 410
Washington, DC 20036
(202) 861-0020
cduan@publicknowledge.org

Phillip R. Malone
Counsel of Record
Jef Pearlman
JUELSGAARD
INTELLECTUAL
PROPERTY AND
INNOVATION CLINIC
MILLS LEGAL CLINIC AT
STANFORD LAW SCHOOL
559 Nathan Abbott Way
Stanford, CA 94305
(650) 725-6369
pmalone@stanford.edu

November 21, 2016

RECORD AND BRIEF

No. 15-1293

Supreme Court, U.S.
FILED
DEC 16 2016
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF THE RUTHERFORD INSTITUTE AND CONSUMERS' RESEARCH AS *AMICI CURIAE* IN SUPPORT OF RESPONDENT

JOHN W. WHITEHEAD
DOUGLAS R. MCKUSICK
THE RUTHERFORD INSTITUTE
1440 Sachem Place
Charlottesville, VA 22901
(434) 987-3888

JOSEPH COLANGELO
CONSUMERS' RESEARCH
1801 F Street NW
Washington, DC 20006
(202) 898-0459

MEGAN L. BROWN
Counsel of Record
JOSHUA S. TURNER
CHRISTOPHER J. KELLY
DWAYNE D. SAM
JOHN T. LIN
WILEY REIN LLP
1776 K Street NW
Washington, DC 20006
(202) 719-7000
mbrown@wileyrein.com

Counsel for Amici Curiae

TABLE OF CONTENTS

Page

TABLE OF CONTENTS i

TABLE OF CITED AUTHORITIES iii

INTEREST OF *AMICI CURIAE* 1

SUMMARY OF THE ARGUMENT 3

ARGUMENT 6

I. THE FIRST AMENDMENT APPLIES TO THE FEDERAL TRADEMARK REGISTRATION REGIME 6

A. Trademarks, Like NAACP, Catholics For Choice, And Black Lives Matter, Express Identity And Ideas 6

B. Trademark Registration Is Not A Subsidy Program, A Funding Limit, Or "Government Speech" Exempt From The First Amendment 9

II. THE DISPARAGEMENT BAR IS A DISCRETIONARY AND FICKLE HECKLER'S VETO, ANATHEMA TO THE FIRST AMENDMENT 14

Table of Contents

Page

A. The Constitution Requires The Government To Reject The Heckler's Veto 14

B. Section 2(A) Provides Government Officials Unlimited Discretion To Burden Speech They Dislike, Yielding Incoherent Decisions 17

III. THE DISPARAGEMENT BAR FAILS ANY LEVEL OF REVIEW. 21

A. Strict Scrutiny Dooms Section 2(A)'s Content And Viewpoint Discrimination 21

B. The Disparagement Bar Fails Intermediate Scrutiny Because An Interest In Preventing Offense Is Not Substantial, And The Bar Does Nothing Other Than Chill Expression 24

CONCLUSION 27

TABLE OF CITED AUTHORITIES

Page

FEDERAL CASES

44 Liquormart, Inc. v. Rhode Island,
517 U.S. 484 (1996) 6, 23

Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.,
133 S. Ct. 2321 (2013) 1, 5, 9

Ashcroft v. ACLU,
542 U.S. 656 (2004) 22

Bartnicki v. Vopper,
532 U.S. 514 (2001) 22

Bd. of Educ. v. Mergens,
496 U.S. 226 (1990) 13

Bishop v. Tyson Foods, Inc.,
660 F. Supp. 2d 1004 (W.D. Ark. 2009), *aff'd*,
373 F. App'x 649 (8th Cir. 2010) 7

Boos v. Barry,
485 U.S. 312 (1988) 16

Brandenburg v. Ohio,
395 U.S. 444 (1969) 16

Central Hudson Gas & Elec. Corp. v. Public Service Commission,
447 U.S. 557 (1980) ..... *passim*

City of Cincinnati v. Discovery Network, Inc.,
507 U.S. 410 (1993) 6

Cited Authorities

Page

City of Lakewood v. Plain Dealer Publ'g Co.,
486 U.S. 750 (1988) 18

Dun & Bradstreet, Inc. v.
Greenmoss Builders, Inc.,
472 U.S. 749 (1985) 16

Edenfield v. Fane,
507 U.S. 761 (1993) 25

Edwards v. District of Columbia,
755 F.3d 996 (D.C. Cir. 2014) 26

Forsyth Cty., Ga. v. Nationalist Movement,
505 U.S. 123 (1992) 15

In re Geller,
751 F.3d 1355 (Fed. Cir. 2014) 14

Grayned v. City of Rockford,
408 U.S. 104 (1972) 26

Greater New Orleans Broad. Ass'n, Inc. v.
United States,
527 U.S. 173 (1999) 6

In re Gyulay,
820 F.2d 1216 (Fed. Cir. 1987) 18

In re Heeb Media, LLC,
89 U.S.P.Q.2d 1071 (T.T.A.B. 2008) 17

Heffron v.
Int'l Soc'y for Krishna Consciousness, Inc.,
452 U.S. 640 (1981) 20

Cited Authorities

Page

Int'l Soc'y for Krishna Consciousness, Inc. v. Lee,
505 U.S. 672 (1992) 4

Leathers v. Medlock,
499 U.S. 439 (1991) 11

In re Lebanese Arak Corp.,
94 U.S.P.Q.2d 1215 (T.T.A.B. 2010) 17

Legal Servs. Corp. v. Velazquez,
531 U.S. 533 (2001) 9

In re McGinley,
660 F.2d 481 (C.C.P.A. 1981) (Rich, J., dissenting). 25

In re Old Glory Condom Corp.,
26 U.S.P.Q.2d 1216, 1993 WL 114384
(T.T.A.B. 1993) 14

Members of City Council of L.A. v. Taxpayers for Vincent,
466 U.S. 789 (1984) 22

Miller v. California,
413 U.S. 15 (1973) 16

Nat'l Endowment for the Arts v. Finley,
524 U.S. 569 (1998) 11

Near v. Minnesota ex rel. Olson,
283 U.S. 697 (1931) 16

Cited Authorities

Page

New Hampshire v. Maine,
532 U.S. 742 (2001) 14

Pac. Gas & Elec. Co. v. Pub. Utils. Comm'n,
475 U.S. 1 (1986) 6

Pleasant Grove City, Utah v. Summum,
555 U.S. 460 (2009) 12

Police Dep't of Chi. v. Mosley,
408 U.S. 92 (1972) 2

Pro-Football, Inc. v. Blackhorse,
112 F. Supp. 3d 439 (E.D. Va. 2015) 3-4

Pro-Football, Inc. v. Blackhorse,
No. 15-1874, 2015 WL 6854402
(4th Cir. Nov. 6, 2015) 1-2, 20

R.A.V. v. City of St. Paul,
505 U.S. 377 (1992) 23

Reed v. Town of Gilbert,
135 S. Ct. 2218 (2015) 5, 21

Regan v. Taxation With Representation of Washington,
461 U.S. 540 (1983) 11

Reno v. ACLU,
521 U.S. 844 (1997) 14

Riley v. Nat'l Fed'n of Blind of N.C., Inc.,
487 U.S. 781 (1988) 6

Cited Authorities

Page

Rosenberger v.
Rector and Visitors of University of Virginia,
515 U.S. 819 (1995) 9

Rumsfeld v.
Forum for Acad. & Inst. Rights, Inc.,
547 U.S. 47 (2006) 9

Rust v. Sullivan,
500 U.S. 173 (1991) 1, 9, 11

Saia v. New York,
334 U.S. 558 (1948) 18

Shuttlesworth v. City of Birmingham, Ala.,
394 U.S. 147 (1969) 18

Simon & Schuster, Inc. v.
Members of N.Y. State Crime Victims Bd.,
502 U.S. 105 (1991) 11, 21-22, 23, 25

Snyder v. Phelps,
562 U.S. 443 (2011) 1, 15, 21

Sorrell v. IMS Health Inc.,
564 U.S. 552 (2011) . . . . . *passim*

In re Squaw Valley Dev. Co.,
80 U.S.P.Q.2d 1264 (T.T.A.B. 2006) 17, 18

Street v. New York,
394 U.S. 576 (1969) 15

Cited Authorities

Page

In re Tam,
785 F.3d 567 (Fed. Cir. 2015) 24

In re Tam,
808 F.3d 1321 (Fed. Cir. 2015) 4, 5

Texas v. Johnson,
491 U.S. 397 (1989) 15

Thomas v. Collins,
323 U.S. 516 (1945) (Jackson, J., concurring) 22

Tinker v. Des Moines Indep. Cmty. Sch. Dist.,
393 U.S. 503 (1969) 4

Turner Broad. Sys., Inc. v. FCC,
512 U.S. 622 (1994) 22

United States v. Stevens,
559 U.S. 460 (2010) 16

Virginia v. Hicks,
539 U.S. 113 (2003) 26

Walker v. Texas Div., Sons of Confederate Veterans, Inc.,
135 S. Ct. 2239 (2015) 12, 13

Zauderer v. Office of Disciplinary Counsel of the Supreme Court of Ohio,
471 U.S. 626 (1985) 6

Page

CONSTITUTIONS

U.S. Const. Amend. I ..... *passim*

FEDERAL STATUTES

15 U.S.C. § 1052 (Lanham Act) ..... *passim*

15 U.S.C. § 1127 6

39 U.S.C. § 403 10

TRADEMARK REGISTRATIONS AND APPLICATIONS

ACLU, Registration No. 1,876,597 7

AMERICAN CIVIL LIBERTIES UNION, Registration No. 1,902,649 7

BLACK LIVES MATTER, U.S. Trademark Application Serial No. 87,098,620 8

CATHOLICS FOR CHOICE, Registration No. 2,796,790 ..... 3, 7

COCA-COLA, Registration No. 4,019,547 13

COCAINE, Registration No. 1,340,874 13

DYKEDOLLS, Registration No. 3,254,737 19

DYKE NIGHT, Registration No. 4,146,588. 19

Page

DYKES ON BIKES, Registration No. 3,323,803.....19

FAGDOG, Registration No. 2,828,396 19

FAGDOG, Registration No. 2,926,775 19

FAGDOG, Registration No. 3,174,475.....19

FAGDOG, U.S. Trade Application Serial 19
No. 75/950,535 (filed Mar. 1, 2000).....19

FAGDOG, U.S. Trade Application Serial
No. 76/454,927 (filed Sept. 25, 2002) 19

FAG FOREVER A GENIUS!, U.S. Trademark
Application Serial No. 86/089,512
(filed Oct. 11, 2013).....19

FAGOUT!,U.S. Trademark Application Serial
No. 86/107,041 (filed Oct. 31, 2013).....19

GANJA UNIVERSITY, U.S. Registration
No. 4,070,160.....13

HONKEY KONG, Registration No. 4,388,702 3

LEGALIZE ACID, Registration No. 4,395,633 3

MAKE AMERICA GREAT AGAIN, Registration
No. 5,020,556.....3

NAACP, Registration No. 1,188,182 7

Page

NATIONAL ASSOCIATION FOR THE ADVANCEMENT OF HISPANIC PEOPLE, Registration No. 2,523,711 7

PHAG, Reginstration No. 4,135,694 19

QUEER PAL FOR THE STRAIGHT GAL, Registration. No. 4,699,581 19

QUEER FOLK, Registration No. 4,742,269 19

TEA PARTY PATRIOTS, Registration No. 4,296,739 3

THAT'S SO GAY, Registration No. 4,555,924 3

THINK ISLAM, Registration No. 4,719,002 13

WAL-MART, Registration No. 1,783,039 13

WHITE LIVES MATTER, U.S. Trademark Application Serial No. 87,121,838 8

THE YIDZ, U.S. Trademark Application Serial No. 77/784,282 (filed July 18, 2009) 19-20

OTHER AUTHORITIES

About Us, CATHOLICS FOR CHOICE, http://www.catholicsforchoice.org/about/default.asp (last visted Dec. 13, 2016) 7

Page

K. Mettler, *Why SPLC says White Lives Matter is a hate group but Black Lives Matter is not*, Washington Post Online (Aug. 31, 2016) https://www.washingtonpost.com/news/morning-mix/wp/2016/08/31/splc-the-much-cited-designator-of-hate-groups-explains-why-white-lives-matter-is-one/?utm_term=.262ed7c2408b 8

NCCB/USCC President Issues Statement on Catholics for a Free Choice (May, 10, 2000) available at http://www.usccb.org/news/2000/00-123.cfm (last visited Dec. 13, 2016) 8

INTEREST OF *AMICI CURIAE*[1]

The Rutherford Institute is an international civil liberties organization headquartered in Charlottesville, Virginia. Founded in 1982 by its President, John W. Whitehead, the Institute specializes in providing legal representation without charge to individuals whose civil liberties are threatened and in educating the public about constitutional and human rights issues. Attorneys affiliated with the Institute have represented parties and filed numerous amicus curiae briefs in the federal Courts of Appeals and Supreme Court. The Rutherford Institute works to preserve the most basic freedoms of our Republic, including the limits placed on government by the First Amendment. The Rutherford Institute opposes governmental action to burden or censor speech for the purpose of protecting the subjective sensibilities of part of the audience.

The Rutherford Institute has helped develop key First Amendment principles informing the reach of government power. *See, e.g.*, *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321 (2013); *Sorrell v. IMS Health Inc.*, 564 U.S. 552 (2011); *Snyder v. Phelps*, 562 U.S. 443 (2011); *Rust v. Sullivan*, 500 U.S. 173 (1991). The Rutherford Institute participated in the case below, and in a case raising similar issues in the Fourth Circuit, *Pro-Football, Inc. v. Blackhorse*, No. 15-

1. Both Petitioner and Respondent have consented to the filing of this brief, as evidenced by the letters on file with this Court. Pursuant to Rule 37.6, the undersigned hereby affirm that no counsel for a party authored this brief in whole or in part and no person other than *amici* or their counsel made a monetary contribution to the preparation or submission of this brief.

1874, 2015 WL 6854402 (4th Cir. Nov. 6, 2015), because this dispute involves the government's claim to power to judge speech based on viewpoint and content, free from First Amendment scrutiny.

Consumers' Research is an independent educational organization whose mission is to increase the knowledge and understanding of issues, policies, products, and services of concern to consumers and to promote the freedom to act on that knowledge without unnecessary government interference. Consumers' Research believes that the cost, quality, availability, and variety of goods and services available to American consumers are improved by greater knowledge and freedom. Consumers have a strong interest in receiving non-deceptive commercial and other economically motivated speech, which regularly is mixed with political and policy ideas. Promoting a robust marketplace—of goods and ideas—free from unnecessary government control is paramount. Consumers' Research is concerned about the government's theory of its discretion to use the trademark regime to discriminate against viewpoints and content, potentially stifling a robust marketplace of ideas.

Amici believe that "above all else, the First Amendment means that the government has no power to restrict expression because of its message, its ideas, its subject matter, or its content." *Police Dep't of Chi. v. Mosley*, 408 U.S. 92, 95 (1972). The government cannot arrogate to itself the freedom to disfavor certain messages by turning the federal trademark registration into a Heckler's Veto.

SUMMARY OF THE ARGUMENT

The Lanham Act's "disparagement" bar has been turned into a weapon against disfavored views, to protect groups from perceived offense. The government does not deny that it is deciding whether to confer the benefit of trademark registration based on whether it believes a trademark would cause offense. Instead, the government claims that its subjective and inconsistent treatment of words and phrases does not affect speech at all.

This is nonsense. Trademarks are protected speech. A trademarked name, word, phrase, logo, or design can do far more than inform customers or denote origin. As described below, registered trademarks cover the waterfront of expression: TEA PARTY PATRIOTS[2] political organization, MAKE AMERICA GREAT AGAIN[3] slogan, CATHOLICS FOR CHOICE[4] advocacy group, THAT'S SO GAY[5] news sites, LEGALIZE ACID[6] accessories, and HONKEY KONG[7] band shirts. These examples belie the government's position that trademarks "are not inherently expressive." Pet. Br. at 47. Indeed, the United States has argued that trademarks are not intended to "editorialize" on culture, politics or philosophy. United States' Mot. for Summ. J. at 1, 24, *Pro-Football, Inc. v. Blackhorse*,

2. Registration No. 4,296,739.

3. Registration No. 5,020,556.

4. Registration No. 2,796,790; *see infra* at 10.

5. Registration No. 4,555,924.

6. Registration No. 4,395,633.

7. Registration No. 4,388,702.

112 F. Supp. 3d 439 (E.D. Va. 2015) (No. 14-cv-1043) (Dkt. No. 109) ("USMSJ"). Indeed, the government's position that certain trademarks are "disparaging" or "offensive" confirms that trademarks do convey messages.

"The First Amendment is a limitation on government . . . . Its design is to prevent the government from controlling speech." *Int'l Soc'y for Krishna Consciousness, Inc. v. Lee*, 505 U.S. 672, 695 (1992) (Kennedy, J., concurring in judgment). The First Amendment requires the government to "show that its action was caused by something more than a mere desire to avoid the discomfort and unpleasantness that always accompany an unpopular viewpoint." *Tinker v. Des Moines Indep. Cmty. Sch. Dist.*, 393 U.S. 503, 509 (1969).

Tam's proposed trademark was denied by the PTO. Why? Not because the mark was inaccurate or misleading or violated someone's intellectual property interests. The government denied Tam the beneficial trademark status routinely afforded others solely because some government employees considered "the Slants" to be "offensive" or "disparaging" to a subset of Asians.

Tam challenged the decision, and after a panel of the Federal Circuit found itself constrained to uphold the denial, the *en banc* Federal Circuit *sua sponte* granted rehearing. The Federal Circuit held that the disparagement clause of section § 2(a) of the Lanham Act is unconstitutional. The court properly determined that § 2(a) should be subject to strict scrutiny because it abridges speech based on content and viewpoint. *In re Tam*, 808 F.3d 1321, 1334 (Fed. Cir. 2015). Under strict scrutiny, "'[c]ontent-based laws—those that

target speech based of its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests.'" *Id.* (quoting *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015)). The Federal Circuit found that § 2(a) is content-based because its application depends on the topic discussed and message conveyed. *Id.* at 1335. The court noted that the USPTO "reject[ed] marks under § 2(a) when it [found] the marks refer[red] to a group in a negative way, but it permit[ted] the registration of marks that refer[red] to a group in a positive, non-disparaging manner." *Id.* at 1336.

The United States has chosen to defend the Lanham Act by embracing its new role as the arbiter of taste, making the high-minded claim that the government should not be required to associate with crude or demeaning messages—commercial or otherwise. The United States' position undermines the core role of the First Amendment as a check on government power, which this Court has applied vigorously. *See Reed*, 135 S. Ct. at 2227 (burdening "speech because of the topic discussed or the idea or message expressed" is subject to "strict scrutiny"); *Agency for Int'l Dev.*, 133 S. Ct. at 2332 (viewpoint-based spending condition received First Amendment scrutiny).

Trademark registration is being transformed into a Heckler's Veto to burden messages in an effort to shield third parties' claimed sensibilities. This is anathema to the First Amendment. This Court should get the PTO out of the business of policing offense and confirm that the power of government is not properly deployed to pick winners and losers on the playing field of expression or commerce. The market, and consumers, benefit from robust and vibrant expression.

ARGUMENT

I. THE FIRST AMENDMENT APPLIES TO THE FEDERAL TRADEMARK REGISTRATION REGIME

A. Trademarks, Like NAACP, Catholics For Choice, And Black Lives Matter, Express Identity And Ideas.

Trademarks are any combination of expression—words, symbols, colors or package designs—used to identify and distinguish a good or service produced by one source from those of other sources. *See* 15 U.S.C. § 1127. While there can be debate over what level of protection applies, trademarks are "speech" protected by the First Amendment.[8]

---

8. The line between commercial and political speech is difficult to draw, *see, e.g., Pac. Gas & Elec. Co. v. Pub. Utils. Comm'n*, 475 U.S. 1, 10–11 (1986), but "core" commercial speech is characterized by a "proposal of a commercial transaction." *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 422–23 (1993); *see also Greater New Orleans Broad. Ass'n, Inc. v. United States*, 527 U.S. 173, 184 (1999); *Zauderer v. Office of Disciplinary Counsel of the Supreme Court of Ohio*, 471 U.S. 626, 637 (1985). Where fully protected speech mixes with commercial speech, higher scrutiny should apply, *see 44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 501 (1996), and where "the component parts of a single speech are inextricably intertwined . . . we apply our test for fully protected expression." *Riley v. Nat'l Fed'n of Blind of N.C., Inc.*, 487 U.S. 781, 796 (1988). Thus, if a trademark simply identifies goods or services for a commercial transaction, it might be appropriate to follow the standard of review established in *Central Hudson Gas & Elec. Corp. v. Public Service Commission*, 447 U.S. 557 (1980). In this case, however, the expressive use of trademarks makes them subject to strict scrutiny.

Trademarks are used for more than mere commercial transactions. Marks routinely serve to convey group identity, including racial, religious, national, political and gender affiliations. AMERICAN CIVIL LIBERTIES UNION,[9] ACLU,[10] NATIONAL ASSOCIATION FOR THE ADVANCEMENT OF HISPANIC PEOPLE,[11] and NAACP[12] convey to consumers and the public messages about group values and identity. Some might take offense, *see, e.g.*, *Bishop v. Tyson Foods, Inc.*, 660 F. Supp. 2d 1004, 1010 (W.D. Ark. 2009) (person considered t-shirt emblazoned with the NAACP as "offensive clothing"), *aff'd*, 373 F. App'x 649 (8th Cir. 2010), but such offense confirms that the trademarks convey meaning.

Religious groups—devout and dissenting—register trademarks. Consider Catholics for Choice, a dissenting group whose mission is "to serve as a voice for Catholics who believe that the Catholic tradition supports a woman's moral and legal right to follow her conscience in matters of sexuality and reproductive health."[13] Many Catholics, including church leadership, take grave "offense" at

---

9. Registration No. 1,902,649.

10. Registration No. 1,876,597.

11. Registration No. 2,523,711 (cancelled Sept. 26, 2008 for failure to file a Declaration of Continued Use).

12. Registration No. 1,188,182.

13. *About Us*, CATHOLICS FOR CHOICE, http://www.catholicsforchoice.org/about/default.asp (last visited Dec. 13, 2016). *See* CATHOLICS FOR CHOICE, Registration No. 2,796,790, for "[p]romoting public awareness of political and ethical issues in the fields of reproductive rights, women's rights, family planning, and sexually transmitted diseases."

the claimed affiliation and characterization of church beliefs.[14] Could the PTO—free from any First Amendment scrutiny—deny registration to Catholics for Choice on the basis that it might "disparage or falsely suggest a connection with" Catholicism or bring Catholic belief "into contempt, or disrepute?" The answer, most assuredly, is "no."

Likewise, social justice and political movements register trademarks. It would be difficult to justify government discretion to deny registration for BLACK LIVES MATTER[15] or WHITE LIVES MATTER[16] on the ground that they are offensive, though both have been criticized.[17] But as explained below, the United States argues that the Lanham Act empowers the PTO to evaluate speech and burden it based on the subjective, potential reaction of third parties.

---

14. *NCCB/USCC President Issues Statement on Catholics for a Free Choice* (May, 10, 2000) ("the use of the name Catholic as a platform for promoting the taking of innocent human life and ridiculing the Church is offensive not only to Catholics, but to all who expect honesty and forthrightness in public discourse.") available at http://www.usccb.org/news/2000/00-123.cfm (last visited Dec. 13, 2016).

15. Serial No. 87,098,620.

16. Serial No. 87,121,838.

17. *See, e.g.*, K. Mettler, *Why SPLC says White Lives Matter is a hate group but Black Lives Matter is not*, Washington Post Online (Aug. 31, 2016) https://www.washingtonpost.com/news/morning-mix/wp/2016/08/31/splc-the-much-cited-designator-of-hate-groups-explains-why-white-lives-matter-is-one/?utm_term=.262ed7c2408b

B. Trademark Registration Is Not A Subsidy Program, A Funding Limit, Or "Government Speech" Exempt From The First Amendment.

Trademark registration offers substantial benefits, the denial of which places applicants at a legal and financial disadvantage. As a result, the government finds itself squarely in the heartland of cases that confirm that the First Amendment imposes limits on government action, even where the issue is a benefit to which the recipient otherwise "has no entitlement." *Agency for Int'l Dev.*, 133 S. Ct. at 2328 (citation omitted); *accord Rumsfeld v. Forum for Acad. & Inst. Rights, Inc.*, 547 U.S. 47, 59 (2006) ("'[T]he government may not deny a benefit to a person on a basis that infringes his constitutionally protected . . . freedom of speech even if he has no entitlement to that benefit.'") (citations omitted).

To avoid this, Petitioner argues that its discretionary review for offense is simply a "criterion for participation in a federal program, not a restriction on speech" at all. Pet. Br. at 25. It analogizes § 2(a) to cases that afford government leeway to limit support for speech with which it does not want to be associated. This attempt fails. The government's theory would free vast and varied government activity from First Amendment scrutiny.

Government programs *conveying a message* may make viewpoint-based funding decisions to ensure that the government's message is neither garbled nor distorted by the grantee. *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 541 (2001) (*citing Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 833 (1995)); *see also Rust*, 500 U.S. at 194 ("[A] program dedicated to advance certain

permissible goals . . . necessarily discourages alternative goals"). The trademark registration process is designed to permit private parties to conduct commerce; it is not a program *designed* to convey the government's message.

The government tries to transform this regime into "government speech" by asserting that "owners of registered marks are issued certificates in the name of the United States, and the government publishes the marks and transmits registration information to foreign countries." Pet. Br. 12. This borders on silly. Ministerial registration-related activities, like publication in the register and the delivery of a certificate, are unlike cases in which Congress seeks to control how *federal dollars* are used by private recipients.

Any other conclusion would turn a variety of personal and commercial expression into government speech simply because they involve registration or interaction with the government, such as the use of a government seal. *See* Pet. Br. at 48. Consider a couple untenable implications: Could a state deny birth certificates to parents if it finds a newborn's name to be offensive, say by virtue of "cultural appropriation"? No. Would the Postal Service, authorized to carry first-class mail, 39 U.S.C. § 403, be justified in refusing to transmit a letter bearing the government's stamp and insignia if it found the name of the addressee disparaging or because the sender was a designated "hate group"? No. These hypotheticals underscore the absurdity of the government's casual reclassification of speech as the government's, simply because the government performs administrative or ministerial tasks that assist the speech in some way.

Trademark registration bears scant resemblance to the funding schemes cited by the Petitioner. First, although trademark registration confers benefits, federal funds are not one. Second, unlike the government programs that promote a specific message, Congress did not establish trademark registration to further a message that requires favoring a viewpoint. *C.f. Rust*, 500 U.S. at 192 (permitting a government family-planning program to limit abortion-related speech); *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569 (1998) (permitting the National Endowment for the Arts to subsidize certain artistic expression over others).

Even if Section 2(a) were a subsidy program, the First Amendment limits its power to discriminate between viewpoints. *See Regan v. Taxation With Representation of Washington*, 461 U.S. 540, 550 (1983) (stating that the government may not aim subsidies "at the suppression of dangerous ideas"); *Leathers v. Medlock*, 499 U.S. 439, 447 (1991) ("[D]ifferential taxation of First Amendment speakers is constitutionally suspect when it threatens to suppress the expression of particular ideas or viewpoints"). Imposing burdens on speakers based on the content of their speech "may effectively drive certain ideas or viewpoints from the marketplace." *Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 116 (1991). That is what the government tries to accomplish with the disparagement bar; to use its power to register trademarks to burden speech it finds offensive. The government cannot have it both ways. If it wants to treat the disparagement bar as a subsidy, Pet. Br at 29, it must abide the limitations on that power.

The government seeks final refuge in *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015) to claim that discrimination attendant to a "government program" is "government speech" immune from First Amendment review. The *Walker* majority explained that, "[w]hen government speaks, it is not barred by the Free Speech Clause from determining the content of what it says." *Id.* at 2245 (protecting Texas' right to exclude the Confederate flag from its specialty-license-plate program).[18]

Whatever its merits, the "government speech" doctrine does not save the Lanham Act. Unlike license plates or public parks, trademarks have never served to communicate *the government's* message. In *Walker*, the "history" of state license plates included decisions to add graphics, slogans, and promote interest groups. *Id.* The Principal Register does not serve a similar expressive purpose. Registration identifies the registrant and an intellectual property right—a legal protection, not an endorsement of the speech by the State. Unlike license

18. *Walker* extended *Pleasant Grove v. Summum*, which sustained a city's rejection of a monument for a public park, because the placement of permanent monuments in a public park is a form of government speech. 555 U.S. 460, 481 (2009). Though the "government speech" doctrine recognized in *Pleasant Grove* offered an expedient solution to vexing disputes over monuments and Ten Commandment displays, Justices Stevens and Ginsburg's concurrence expressed trepidation, noting that "our decisions relying on the recently minted government speech doctrine to uphold government action have been few and, in my view, of doubtful merit." *Id.* at 481. Justice Breyer's concurrence preferred to "ask whether a reasonable and fully informed observer would understand the expression to be government speech." *Id.* at 487.

plates, a trademark is not "essentially, government ID[]." *Id.* at 2249. Petitioner claims a desire to avoid "association of the marks with the government," Pet. Br. at 11, but the trademark office no more endorses speech it registers than do local police guarding a demonstration from those who might try to silence them.

The Principal Register is full of trademarks advancing unsound policy and politically incorrect messages. COCAINE[19] and GANJA UNIVERSITY, U.S.[20] convey federal drug policy? Does THINK ISLAM[21] express the government's endorsement of religion? Likewise, do consumers believe that the ® denotes federal endorsement of COCA-COLA[22] or WAL-MART?[23] Of course not. Even "secondary school students are mature enough and are likely to understand" that the government does not endorse all of the speech that it protects. *Bd. of Educ. v. Mergens*, 496 U.S. 226, 250 (1990).

The United States' "government speech" claim is a litigation strategy; in practice, the government has no desire to be seen as adopting the view of every trademark that it registers. The government made this clear: "'[I]ssuance of a trademark registration' does not 'amount to the awarding of the U.S. Government's imprimatur.'"

---

19. Registration No. 1,340,874 (cancelled Dec. 3, 1991 for failure to file a Declaration of Continued Use).

20. Registration No. 4,070,160.

21. Registration No. 4,719,002.

22. Registration No. 4,019,547.

23. Registration No. 1,783,039.

See USMSJ at 21 (quoting *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1993 WL 114384, at *5 n.3 (T.T.A.B. 1993)).[24] The government should be estopped from arguing that a trademark amounts to a government endorsement,[25] but at a minimum, the inconsistency undercuts any "government speech" argument.

II. THE DISPARAGEMENT BAR IS A DISCRETIONARY AND FICKLE HECKLER'S VETO, ANATHEMA TO THE FIRST AMENDMENT

A. The Constitution Requires The Government To Reject The Heckler's Veto.

The Supreme Court emphatically rejects laws that "confer broad powers of censorship, in the form of a 'heckler's veto.'" *Reno v. ACLU*, 521 U.S. 844, 880 (1997). But the government insists it is free to reject trademarks based on whether it believes that "a substantial composite" of a group might be offended, *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 944 (2015).

---

24. The government frets over "creating incentives" for the use of odious marks, the possible "association of the marks with the government itself," and fears about conveying to "foreign countries" unpleasant speech in trademark. USMSJ at 21. These concerns are quite a stretch, but nonetheless confirm that trademarks convey messages—however odious the government may find them.

25. *See New Hampshire v. Maine*, 532 U.S. 742, 749 (2001) ("Where a party assumes a certain position in a legal proceeding, and succeeds in maintaining that position, he may not thereafter, simply because his interests have changed, assume a contrary position.").

It claims to be protecting "underrepresented groups" from "bombard[ment] with demeaning messages." Pet. Br. 48 (quoting Dyk, J.) The government embraces its role in subordinating free speech to the possible reactions of third parties.

"If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." *Texas v. Johnson*, 491 U.S. 397, 414 (1989). In its most critical applications, the First Amendment protects speech that others find offensive. *See Street v. New York*, 394 U.S. 576, 592 (1969) ("It is firmly settled that . . . the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers."). It is *precisely* when speech might offend that the First Amendment is most critical, because this is the type of speech invites regulation in the first instance.

That is why the Heckler's Veto is disdained. "Speech remains protected even when it may 'stir people to action,' 'move them to tears,' or 'inflict great pain.'" *Sorrell*, 564 U.S. at 576 (citation omitted). The First Amendment forbids the government from "react[ing] to that pain by punishing the speaker." *Snyder*, 562 U.S. at 461. It is settled that "[l]isteners' reaction to speech is not a content-neutral basis for regulation. . . . Speech cannot be financially burdened, any more than it can be punished or banned, simply because it might offend . . . ." *Forsyth Cty., Ga. v. Nationalist Movement*, 505 U.S. 123, 134–35 (1992).

As a result, "[we] must tolerate insulting, and even outrageous, speech in order to provide adequate

'breathing space' to the freedoms protected by the First Amendment." *Boos v. Barry*, 485 U.S. 312, 322 (1988). (internal quotation marks and citations omitted). Even in economic regulation, "[t]he State may not burden the speech of others in order to tilt the public debate in a preferred direction." *Sorrell*, 564 U.S. at 578-79. Indeed, consumers are resilient and can understand whose speech they might be offended by. They can vote with their pocketbooks and refuse to patronize the users of disparaging marks. If a music fan is offended by the use of "slant" by Mr. Tam, they can refuse to buy his music. They do not need the government's protection from offense.

Finally, the Court should reject the United States' attempt to create a new category of unprotected speech. Categories of speech that fall outside the First Amendment are few and narrow: obscenity, *see Miller v. California*, 413 U.S. 15 (1973), defamation, *see Dun & Bradstreet, Inc. v. Greenmoss Builders, Inc.*, 472 U.S. 749 (1985), incitement, *see Brandenburg v. Ohio*, 395 U.S. 444 (1969), and situations of imminent danger the government has the power to prevent, *see Near v. Minnesota ex rel. Olson*, 283 U.S. 697, 716 (1931). Other forms of speech—including disparagement—are protected.

The Supreme Court has rejected attempts to create new categories of unprotected speech. *See United States v. Stevens*, 559 U.S. 460, 472 (2010). Courts lack "freewheeling authority to declare new categories of speech outside the scope of the First Amendment" based on "an ad hoc balancing of relative social costs and benefits." *Id.* at 470, 472. The First Amendment protects even offensive speech from officious government meddling.

B. Section 2(A) Provides Government Officials Unlimited Discretion To Burden Speech They Dislike, Yielding Incoherent Decisions.

Under § 2(a), a government employee must police applications for potential offense and evaluate them in light of the applicant's characteristics, the message sent, overall context, and the likely subjective reaction of a subsection of the group to be protected from offense. The evaluator must dabble in anthropology, sociology, and psychology, among other fields. Not surprisingly, with flexible and shifting considerations, review yields unpredictable results, linked by a common denominator: subjective and paternalistic review of the potential for offense. Such review is hard to square with our system of content-neutral government.

The Board applies a two-part test: (1) What is the likely meaning of the matter in question, taking into account dictionary definitions, and the relationship of the matter to other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services?; and (2) Is the meaning disparaging to a substantial composite of the referenced group?[26] During examination, the examining attorney sets forth a prima

---

26. *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264 (T.T.A.B. 2006) (holding SQUAW for clothing barred from registration as disparaging of Native American women, but not barred as a mark for ski-related goods as it would be understood to refer to a famous ski resort at Squaw Valley, California); *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008). *See In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215 (T.T.A.B. 2010) (dissent argued that focus should be on the term's meaning to the U.S. population and not members of the disparaged group).

facie case, then the burden shifts to the applicant to rebut the prima facie case with "competent evidence." *See, e.g., In re Gyulay*, 820 F.2d 1216, 1217 (Fed. Cir. 1987); *see also Squaw Valley, supra*.

PTO examiners have virtually no standards to guide their review, but this Court has repeatedly held that unbridled discretion in administrative officials is anathema to the First Amendment. *See, e.g., Saia v. New York*, 334 U.S. 558, 559-60 (1948) (striking down a New York loud-speaker permitting scheme where the police chief had unbounded discretion to grant or deny permits); *City of Lakewood v. Plain Dealer Publ'g Co.*, 486 U.S. 750, 764 (1988) ("[The government] may not condition that speech on obtaining a license or permit from a government official in that official's boundless discretion."). Allowing Constitutional freedoms to be "contingent upon the uncontrolled will of an official—as by requiring a permit or license which may be granted or withheld in the discretion of such official—is an unconstitutional censorship." *Shuttlesworth v. City of Birmingham, Ala.*, 394 U.S. 147, 151 (1969). It is particularly troubling to permit a "government official" to make discretionary decisions "based upon the content of the speech or viewpoint of the speaker." *City of Lakewood*, 486 U.S. at 764.

The PTO's record reveals a bevy of content and viewpoint-based judgments that border on incoherence and change over time. PTO records abound with marks once deemed disparaging that now are registered; marks containing words deemed unregistrable despite being legally equivalent to registrable terms; terms defined in dictionaries as disparaging that are not found disparaging by the PTO; and terms that the PTO now finds disparaging despite past findings to the contrary.

For example, Merriam Webster Dictionary notes that DYKE, QUEER and FAG are "often" or "usually" used as disparaging terms. However, the PTO has registered marks such as DYKE NIGHT,[27] DYKES ON BIKES,[28] DYKEDOLLS,[29] QUEER FOLK,[30] and QUEER PAL FOR THE STRAIGHT GAL.[31] The PTO seems conflicted on FAG—it recently refused registration of FAGOUT! and FAG FOREVER A GENIUS![32] as disparaging, but approved PHAG[33] for registration. Similarly, the Office has registered FAGDOG three times, and has refused it twice—at least once under § 2(a).[34]

A particular example stands out: an application for THE YIDZ for: "Entertainment, namely, live

---

27. Registration No. 4,146,588.

28. Registration No. 3,323,803.

29. Registration No. 3,254,737 (cancelled Jan. 31, 2014 for failure to file a Declaration of Continued Use).

30. Registration No. 4,742,269.

31. Registration. No. 4,699,581.

32. U.S. Trademark Application Serial Nos. 86/107,041 (filed Oct. 31, 2013), and 86/089,512 (filed Oct. 11, 2013).

33. Registration No. 4,135,694.

34. *Compare* Registration Nos. 2,926,775 (cancelled Sept. 16, 2011 for failure to file a Declaration of Continued Use) and 2,828,396 (cancelled Nov. 5, 2010 for failure to file a Declaration of Continued Use); Registration No. 3,174,475 (cancelled June 28, 2013 for failure to file a Declaration of Continued Use) *with* US. Trademark Application Serial Nos. 76/454,927 (filed Sept. 25, 2002) (abandoned after section 2(a) refusal) and 75/950,535 (filed Mar. 1, 2000) (abandoned).

performances by a musical band."[35] The PTO refused it, finding it "merely descriptive" because it describes an ingredient, quality, characteristic, function, feature, purpose or use of the goods and/or services and "[t]he applicant's musical band comprises Jewish people."[36] In support, the PTO attached a definition from the online Compact Oxford English Dictionary defining the term YID as "*informal offensive* A Jew." And yet, the PTO raised no objection under § 2(a). Both THE YIDZ and the SLANTS marks could be seen as pejorative—yet the marks are treated differently. Such fickleness should be fatal.

The government attempts to downplay the incoherence, framing it innocuously as "inconsistent enforcement." Pet Br. at 50. The issue is not simply a few "allegedly erroneous registration[s]" *id.* at 51, but rather the conscious use of trademark registration (and cancellation in the case of *Pro-Football*) to censor viewpoints under the guise of protecting people from offensive speech. The disparagement bar's "inconsistent enforcement" highlights the lack of a limiting principle, making the process ripe for arbitrary application. *Heffron v. Int'l Soc'y for Krishna Consciousness, Inc.*, 452 U.S. 640, 649 (1981) (stating the Court condemns arbitrary discretion because "such discretion has the potential for becoming a means of suppressing a particular point of view"). Such discriminatory treatment of viewpoints is a "more blatant

35. U.S. Trademark Application Serial No. 77/784,282 (filed July 18, 2009) (refused on different grounds). The applicant chose not to respond to the refusal and the application was abandoned.

36. Yet, there is absolutely no indication in the file wrapper of the applicant's religious background.

and egregious form of content discrimination," *Reed*, 135 S. Ct. at 2230 and is unconstitutional. (internal quotation marks and citations omitted).

III. THE DISPARAGEMENT BAR FAILS ANY LEVEL OF REVIEW.

The government zigzags through several doctrines, disclaiming any viewpoint discrimination, Pet. Br. 43-44, denying the applicability of strict scrutiny, faintly invoking *Central Hudson*, Pet. Br. 48, and ultimately arguing that its "program" is not subject to First Amendment scrutiny at all. This is all wrong.

A. Strict Scrutiny Dooms Section 2(A)'s Content And Viewpoint Discrimination.

Section 2(a) imposes a financial burden and disincentive (in the form of withheld legal protections) on those whose speech the government believes others may find disparaging. The law burdens speech on certain topics of public concern,[37] because of its content. Laws that "impose[] a financial disincentive only on speech of a particular content" are "presumptively inconsistent with the First Amendment." *Simon & Schuster, Inc.*, 502 U.S.

---

37. Speech is of public concern, "at the heart of the First Amendment," when "it can be fairly considered as relating to any matter of political, social, or other concern to the community, or when it is a subject of legitimate news interest; that is, a subject of general interest and of value and concern to the public." *Snyder*, 562 U.S. at 451–52, 453 (internal quotations and citation omitted). A trademark reflecting a political statement or commentary on racial, ethnic, or other stereotypes, is a paradigmatic example of speech on a matter of public concern.

at 115, 116. There is perhaps no category of regulation toward which the Supreme Court has been more hostile. *See Ashcroft v. ACLU*, 542 U.S. 656, 660 (2004).

The disparagement clause is content-based because it cannot be "justified without reference to the content of the regulated speech." *Bartnicki v. Vopper*, 532 U.S. 514, 526 (2001) (citation omitted); *see also Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622, 643 (1994). The Act evaluates trademarks based on their content, and it is aimed at improving the quality of dialogue in commerce[38]—a goal that is content-based and anathema to the First Amendment. "The very purpose of the First Amendment is to foreclose public authority from assuming a guardianship of the public mind through regulating the press, speech, and religion." *Thomas v. Collins*, 323 U.S. 516, 545 (1945) (Jackson, J., concurring).

Worse, § 2(a) compels viewpoint discrimination—a particularly pernicious form of discrimination. "[T]he First Amendment forbids the government to regulate speech in ways that favor some viewpoints or ideas at the expense of others." *Members of City Council of L.A. v. Taxpayers for Vincent*, 466 U.S. 789, 804 (1984). The statute allows registration of trademarks that refer positively to a group, but bars messages perceived as offensive. This should end the analysis; "it is all but dispositive to conclude that a law is content-based and, in practice, viewpoint-discriminatory." *Sorrell*, 564 U.S. at 571.

---

38. The United States claims to be "declining to create incentives for the use of such marks in commerce," Pet. Br. at 10-11, but this is just a more complicated way of saying they want to create incentives to use "better speech."

Section 2(a) is subject to the most stringent judicial review. Laws allowing the government to discriminate among speakers based on content or viewpoint are unacceptable absent narrow tailoring and a compelling government interest. *See R.A.V. v. City of St. Paul*, 505 U.S. 377, 395 (1992). Here, the government's interests in "declining to incorporate racially offensive epithets into various official communications," Pet. Br. at 40, and in discouraging disparaging speech, Pet. Br. at 48, are not compelling. "The fact that society may find speech offensive is not a sufficient reason for suppressing it" *Simon & Schuster, Inc.*, 502 U.S. at 509. And even if these interests were compelling, the government makes no showing how § 2(a) is narrowly tailored. Section 2(a)'s disparagement bar fails strict scrutiny.[39]

---

39. Whether labeled commercial speech or otherwise, the disparagement bar should be subject to exacting scrutiny. *See Sorrell*, 564 U.S. at 566 ("[H]eightened scrutiny" is required "*whenever* the government creates a regulation of speech because of disagreement with the message it conveys.") (emphasis added) (internal quotations and citation omitted); 44 *Liquormart*, 517 U.S. at 501; *Cent. Hudson*, 447 U.S. at 566 n.9.

B. The Disparagement Bar Fails Intermediate Scrutiny Because An Interest In Preventing Offense Is Not Substantial, And The Bar Does Nothing Other Than Chill Expression.

The government half-heartedly invokes intermediate scrutiny, Pet. Br. at 48, but does not engage in analysis. Even if § 2(a) were subject to intermediate scrutiny, the government could not justify it. Under *Central Hudson*, the government may regulate truthful, non-misleading commercial speech about lawful activity if the regulation serves a substantial government interest, directly advances the government interest, and is no more extensive than necessary. 447 U.S. at 566. Here, the goals purportedly served by § 2(a)'s bar against disparaging marks are not legitimate, fall far short of substantial, and confirm the regime's incompatibility with the First Amendment.

The government's justifications have been shifting and underwhelming. In the Federal Circuit[40] the government enumerated interests in: (1) discouraging the use of marks that may be offensive, *In re Tam*, 785 F.3d 567, 583 (Fed. Cir. 2015); (2) not having disparaging marks "occupy the time, services, and use of funds of the federal government," *id.*; (3) "maintaining a well-functioning trademark system that harmonizes state and federal trademark law," *id.* at 584; and (4) the government not being seen as giving its approval, *id.* The government appears now to have

40. In the Fourth Circuit, the government claimed a substantial interest in "maintaining a working trademark system at the state and federal levels and preventing a mistaken perception of official endorsement of insult and calumny." USMJ at 2.

streamlined its arguments,[41] casting them in less risible terms. In this Court, its interests focus on preventing parties from calling upon the resources of the government to promote offensive trademarks. Pet. Br. 5, 37–41.

As noted, an interest in preventing offense is inconsistent with the First Amendment to such a degree that the Supreme Court has "found it so 'obvious' as to not require explanation." *Simon & Schuster*, 502 U.S. at 115-16 (citation omitted). And as explained, concern over a perceived government promotion or incentive to engage in "disparaging" speech is baseless. Trademarks are *private* speech. *See Cent. Hudson*, 447 U.S. at 584–85 (citing cases). Without a substantial interest for the ban, the Court could stop there. *See id.* at 566. But even if claimed interests were substantial, the disparagement bar fails the rest of the analysis.

Courts seek evidence that a law burdening speech advances an asserted interest "in a direct and material way." *Edenfield v. Fane*, 507 U.S. 761, 767 (1993). The government's reliance on the fact that Tam remains free to use the mark without registration shows that the government is not actually preventing "harmful" speech

---

41. A previously claimed interest in husbanding government resources fails because under the disparagement bar, the government spends substantial resources conjuring evidence of potential offense, and then defending refusals. *See In re McGinley*, 660 F.2d 481, 487 (C.C.P.A. 1981) (Rich, J., dissenting). Likewise, the government previously invoked an interest in a "well-functioning trademark system." This interest rings hollow. Given the legion of offensive, prurient, and silly marks the PTO has already registered, it is hard to argue that the registration of similar marks disrupts a well-functioning trademark system.

or meaningfully protecting "the dignity and reputation of those associated with disadvantaged and minority groups," USMSJ at 20. *See Edwards v. District of Columbia*, 755 F.3d 996, 1005 (D.C. Cir. 2014) (holding that the government's interests were not furthered where the offending parties retained "carte blanche" to say whatever they wanted). The government is making a stand on principle, with little effect other than to suppress speech.

Finally, the bar impermissibly chills expression. Entrepreneurs and advocates considering a slogan or name will wonder whether they can register it. They may think twice about whether the PTO will find it "offensive," but will have little ability to predict the vagaries of an examiner. "Many persons, rather than undertake the considerable burden (and sometimes risk) of vindicating their rights through case-by-case-litigation, will choose simply to abstain from protected speech—harming not only themselves but society as a whole, which is deprived of an uninhibited marketplace of ideas." *Virginia v. Hicks*, 539 U.S. 113, 119 (2003). Consumers will suffer if they are deprived of a robust marketplace of goods, services, and ideas, as they will be under the government's approach, which requires advocacy groups, sports franchises and musical bands to play it safe, or think twice before choosing a controversial logo or slogan because they may not have the endurance to fight the PTO.

The Court should not let the PTO—or third party groups whose offense the PTO claims to vindicate—exercise a discretionary "chancellor's veto" over speech it dislikes. *Grayned v. City of Rockford*, 408 U.S. 104, 108–09 (1972).

CONCLUSION

The decision of the Federal Circuit should be affirmed.

Respectfully submitted,

JOHN W. WHITEHEAD
DOUGLAS R. MCKUSICK
THE RUTHERFORD INSTITUTE
1440 Sachem Place
Charlottesville, VA 22901
(434) 987-3888

JOSEPH COLANGELO
CONSUMERS' RESEARCH
1801 F Street NW
Washington, DC 20006
(202) 898-0459

MEGAN L. BROWN
Counsel of Record
JOSHUA S. TURNER
CHRISTOPHER J. KELLY
DWAYNE D. SAM
JOHN T. LIN
WILEY REIN LLP
1776 K Street NW
Washington, DC 20006
(202) 719-7000
mbrown@wileyrein.com

Counsel for Amici Curiae

Decenver 16, 2016

RECORD AND BRIEF

No. 15-1293

FILED
DEC 16 2016
OFFICE OF THE CLERK

IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF *AMICUS CURIAE* SAN FRANCISCO DYKES ON BIKES WOMEN'S MOTORCYCLE CONTINGENT, INC.

BROOKE OLIVER
50 BALMY LAW P.C.
50 Balmy Alley
San Francisco, CA 94110
(415) 641-1116

TOBIAS BARRINGTON WOLFF
UNIVERSITY OF PENNSYLVANIA
3501 Sansom Street
Philadelphia, PA 19104
(215) 898-7483

MARK A. LEMLEY
Counsel of Record
MICHAEL A. FELDMAN
DURIE TANGRI LLP
217 Leidesdorff Street
San Francisco, CA 94111
(415) 362-6666
mlemley@durietangri.com

Counsel for Amicus Curiae

269878

TABLE OF CONTENTS

Page

TABLE OF CONTENTS i

TABLE OF CITED AUTHORITIES ii

INTEREST OF THE *AMICUS CURIAE* 1

SUMMARY OF ARGUMENT 2

ARGUMENT 7

A. DYKES ON BIKES AND THE TRADEMARK REGISTRATION ODYSSEY 7

B. DYKES ON BIKES' TRADEMARKS ARE POLITICAL SPEECH, NOT COMMERCIAL SPEECH 10

C. THE STANDARDLESS DISCRETION IN SECTION 1052(A)'S SPEECH LICENSING REQUIREMENT LEADS TO ARBITRARY APPLICATIONS 13

D. THE IMPORTANCE OF TRADEMARK REGISTRATION 19

CONCLUSION 24

TABLE OF CITED AUTHORITIES

Page

CASES

Board of Trustees of State University of New York v. Fox,
492 U.S. 469 (1989) 12

Carey v. Population Services Int'l,
431 U.S. 678 (1977) 12

City of Cincinnati v. Discovery Network, Inc.,
507 U.S. 410 (1993) 13, 17

City of Ladue v. Gilleo,
512 U.S. 43 (1994) 10

City of Lakewood v. Plain Dealer Publishing Co.,
486 U.S. 750 (1988) 13

Forsyth County v. Nationalist Movement,
505 U.S. 123 (1992) 11, 16

Grayned v. City of Rockford,
408 U.S. 104 (1972) 18

In re Tam,
808 F.3d 1321 (Fed. Cir. 2015) 4, 17

Lee v. Tam,
137 S. Ct. 30 (Sept. 29, 2016) 4, 10

Cited Authorities

Page

Nat'l Endowment for the Arts v. Finley,
524 U.S. 569 (1998) 18

Perry v. Sindermann,
408 U.S. 593 (1972) 19, 23

Reed v. Town of Gilbert,
135 S. Ct. 2218 (2015) 22

Roberts v. United States Jaycees,
468 U.S. 609 (1984) 11

Shuttlesworth v. Birmingham,
394 U.S. 147 (1969) 13, 14

Sorrell v. IMS Health Inc.,
564 U.S. 552 (2011) 22, 23

Speiser v. Randall,
357 U.S. 513 (1958) 19, 23

Staub v. City of Baxley,
355 U.S. 313 (1958) 13

Texas v. Johnson,
491 U.S. 397 (1989) 11

Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc.,
455 U.S. 489 (1982) 18

Cited Authorities

Page

STATUTES

15 U.S.C. § 1052 ..... *passim*

15 U.S.C. § 1064 16

The Lanham Act 20, 22

OTHER AUTHORITIES

TMEP § 1203.03 ..... 14, 15

INTEREST OF THE *AMICUS CURIAE*[1]

Amicus Curiae San Francisco Dykes on Bikes Women's Motorcycle Contingent, Inc. ("Dykes on Bikes") is a non-profit organization composed of lesbian motorcycle riders and their allies. The Dykes on Bikes first appeared in the 1976 San Francisco Pride parade and have led the San Francisco Pride parade and many other cities' Pride parades ever since as representatives of the movement for lesbian, gay, bisexual, transgender, and queer ("LGBTQ") equality and empowerment.

The Patent and Trademark Office ("PTO") has by turns both accepted and rejected Dykes on Bikes' trademark applications, depending on the time and the particular examiner assigned to the case. This includes various rejections on the ground that the term "dyke" is a disparaging term for lesbians, and, conversely, an acceptance based on extensive evidence from Dykes on Bikes that the term "dyke" is not a disparaging term, including almost two dozen expert declarations from distinguished linguists, historians, and authors.

Dykes on Bikes has no direct interest in the outcome of this case, but does have an interest in being able to register and control the use of its trademarks, which the PTO has interfered with by rejecting Dykes on Bikes' Design Mark trademark application and by applying

---

1. No counsel for a party authored this brief in whole or in part, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than the *amicus curiae*, or its counsel made a monetary contribution to its preparation or submission. The parties have consented to the filing of all brief in this matter.

its registration criteria arbitrarily and inconsistently. Dykes on Bikes has a trademark application that has been suspended pending the result of this case.

SUMMARY OF ARGUMENT

Amicus Dykes on Bikes is a non-profit organization composed of lesbian motorcycle riders and their allies. Dykes on Bikes uses its trademark to cultivate a brand of political activism and awareness, supporting the civil rights of lesbians and working to fight harmful stereotypes about lesbians and the entire LGBTQ community. The purpose of the brand is not to sell commercial goods or services. Rather, Dykes on Bikes requires all its Chapters around the world to use the brand for charitable and political expression in support of its civil rights mission. Amicus purposefully and intentionally adopted the term "dykes" as part of its trademark in order to highlight and confront the controversial history of that term and dispel the notion that it is disparaging. It uses its trademark to prevent the commercial exploitation of its name or logo, which Dykes on Bikes believes would corrupt and dilute its ability to use its mark to advance its political and social message.

The process of obtaining trademark registrations from the PTO has been costly, time-consuming, and ultimately only partially successful because each application is subject to the whim of the particular trademark examiner assigned and his or her particular biases in applying 15 U.S.C. § 1052(a). Different PTO examiners have at various times both accepted and rejected Dykes on Bikes' trademark applications, depending on the particular examiner assigned to the case and their changes in mind.

It has at various points found both that the term "dyke" is a disparaging term for lesbians and, conversely, that the term "dyke" is not a disparaging term.

This difficulty in registering its trademarks has made it nearly impossible to keep the Dykes on Bikes brand focused on political speech. Dykes on Bikes has struggled to prevent other users from attempting to commercialize the mark. Websites like eBay, Facebook, and Zazzle.com require trademark registration numbers for takedown notices, and some sites refuse to honor takedown notices without proof of a federal trademark registration. This leaves the Dykes on Bikes logo vulnerable and threatens to deprive the Dykes on Bikes name of protection as the PTO contemplates reversing its earlier ruling and invalidating the organization's existing mark. The reality is that federal trademark registration is often a prerequisite to effective enforcement. Without the power of a registered trademark, the public is left confused and unable to distinguish Dykes on Bikes' political speech from the speech of unrelated, unaffiliated entities looking to make money off the Dykes on Bikes brand.

Dykes on Bikes' experience with Section 1052(a) offers three lessons that may help the Court in resolving this case:

1. Trademark registration is not useful only for commercial speech. It can also be critical for entities engaged in political speech. Dykes on Bikes is a non-profit organization focused on political speech and social action, not commercialization. Dykes on Bikes uses its trademarks for three reasons: (1) to identify itself when it is engaged in its own political speech; (2) for members to

publicly self-identify as proudly out-of-the closet lesbians, publicly appropriating the very words previously used to shame them into silence and submission as well as claiming those words as a source of pride and as a rallying cry for winning equal rights under the law; and (3) to prevent for-profit companies from trying to profit from the well-known Dykes on Bikes trademark by selling products of their own with no benefit, oversight, or approval from the actual Dykes on Bikes organization. Section 1052(a) does not simply burden speech that proposes a commercial transaction. As applied to Dykes on Bikes, it directly affects our ability to engage in core political speech undiluted by misleading commercial messages.

2. The PTO's application of Section 1052(a)'s prohibition on "disparaging" trademarks is arbitrary and inconsistent, depending on the opinions, biases, and standardless discretion of the particular PTO examiner assigned to the case. The Federal Circuit decision now on appeal lamented the inconsistent application of Section 1052(a), pointing out that the PTO denied trademark registration for HAVE YOU HEARD SATAN IS A REPUBLICAN, but granted the trademark application for THE DEVIL IS A DEMOCRAT. *See In re Tam*, 808 F.3d 1321, 1342 n.7 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016), *cert. granted sub nom., Lee v. Tam*, 137 S. Ct. 30 (Sept. 29, 2016). But it is worse than that. The PTO has both accepted and rejected marks using exactly the same words. In 2007, the PTO issued a certificate of registration for the word mark "Dykes on Bikes," albeit only after the examiner's refusal to register the mark was reversed on appeal. DYKES ON BIKES, Reg. No. 3,323,803 File History ("'803 FH"), Registration Certificate (Oct. 30, 2007). Dykes on Bikes then filed its declaration of use and

incontestability in 2013. *Id.*, Decl. of Use & Incontestability (Oct. 30. 2013). But in 2016, when Dykes on Bikes applied to register its logo, which also includes the words "Dykes on Bikes," the PTO rejected the application on the basis that the word "dyke" was disparaging, despite the 2007 finding to the contrary and despite issuing a certificate of use and incontestability for the same words only two years earlier. DYKES ON BIKES W M C, U.S. Trademark Serial No. 86/609,566 File History ("'566 FH"), Suspension Notice (Oct. 15, 2016). The PTO argues that it is not bound by its prior decision on the same words, insisting upon its right to render inconsistent rulings.

The long, costly, and uncertain process of obtaining trademark registration has imposed a substantial burden on Dykes on Bikes. Trademark examiners demanded an extraordinary amount of evidence, far beyond what is required of other trademark applicants, before registering the Dykes on Bikes word mark. And some examiners accept that evidence while others reject it, applying a subjective standard for identifying "disparaging" words. The inconsistency of the PTO in registering other marks that use words with a history of disparaging meaning, like QUEER AS FOLK and BITCH, while refusing to register the Dykes on Bikes design mark, further demonstrates the arbitrariness of the standard. Dykes on Bikes' experience is a cautionary tale about delegating hundreds or thousands of discretionary free speech decisions to individual civil servants working with no clear or objective standard. It is also a healthy reminder why the First Amendment strongly disfavors this kind of content-based prior licensing restraint on speech.

3. Federal trademark registration matters. Without registration, it may be practically and financially impossible for Dykes on Bikes—or any small political activist organization—to effectively ensure that the public understands the difference between Dykes on Bikes' own political speech, and speech from others, which might be commercial or contain anti-gay political messages falsely claiming to come from Dykes on Bikes.

Some courts—and petitioners—suggest that even if the PTO rejects a mark as disparaging, the trademark owner can invoke common-law rights. But common-law rights are not adequate. Trademark registration confers a number of legal advantages that a common-law right to bring a lawsuit does not, including the statutory presumption of validity, nationwide priority, incontestability, proof that the mark has secondary meaning, and constructive notice to would-be infringers. Registration also confers significant practical advantages not mentioned in the statute, particularly for small companies or non-profit organizations such as Dykes on Bikes. Effective enforcement is practically impossible without a trademark registration or the money to file countless common-law trademark lawsuits.

Trademark registration, then, is not simply a benefit conferred by the government that can be replaced by the consolation prize of common-law rights for those whose speech the government disfavors. Registration is an integral part of the federal trademark scheme and an integral part of an organization's ability to effectively name and brand itself.

ARGUMENT

A. DYKES ON BIKES AND THE TRADEMARK REGISTRATION ODYSSEY

1. Dykes on Bikes is a non-profit organization dedicated to helping LGBTQ people have pride and dignity in their sexual orientation and to engage in philanthropic efforts in the LGBTQ and women's communities. It is based in San Francisco, and has about 15 official chapters throughout the U.S. and the world. The San Francisco chapter oversees the official chapters and ensures that the organization as a whole maintains a united vision for advancing LGBTQ and women's rights.

The organization first formed in 1976, when a small contingent of women motorcyclists gathered at the head of the San Francisco Pride parade. That first year, they coined the informal name "Dykes on Bikes." Consistent with the "pride" theme, they chose to use the name "dykes" precisely because of its history as a slur. The message it conveyed was, in part, that being a dyke was not something to be ashamed of. Rather than remaining hidden in private homes and clubs, lesbians could be out and proud, riding powerful machines at the front of parades celebrating the civil rights of LGBTQ people. The societal and personal impact of the Dykes on Bikes trademark has helped transform "dyke" from an epithet to a word commonly used by lesbians to refer to themselves with pride.

2. In 2003, the organization officially changed its name to the San Francisco Dykes on Bikes Women's Motorcycle Contingent. Dykes on Bikes filed its application to register

the phrase DYKES ON BIKES as a trademark on July 31, 2003, beginning a saga that continues to this day without a final resolution.

Trademark examiners initially refused to register the mark. '803 FH, Office Action (Feb. 20, 2004). Overcoming that resistance required Dykes on Bikes to submit evidence far beyond what is required of other trademark applicants and to win an appeal. Throughout the process, Dykes on Bikes met with hostility and resistance from the PTO.

Dykes on Bikes first provided evidence to the PTO that the term "dyke" is not disparaging, but the PTO rejected the application. *Id.*, Request for Reconsideration (April 26, 2005). Dykes on Bikes appealed. TTAB Appeal of Appliction Serial No. 78/281,746 ("Appeal") (April 28, 2005). We offered declarations from 23 expert witnesses, including LGBTQ scholars, historians, and lexicologists to show that the term is not derogatory. *Id.* Rather than cite similarly competent evidence during the appeal, the PTO attempted to support its position with a printout of an unidentified individual's webpage purporting to provide personal translations of "vulgar" words from English into Spanish. *Id.*, Reconsideration Denial (May 26, 2005). It was not a list of "disparaging" words, but a list of "vulgar" words including "dyke," "breasts," "testicles," "clitoris," "condom," and many other words which could not be considered "disparaging" under Section 2(a). The PTO also offered a print out of an online dictionary combining references from an out-of-print 1913 Webster's dictionary and personal notations by the individual who hosted the website, where the only reference to "dyke" as "vulgar, deprecatory" appears in a personal notation.

On November 2, 2005, the Trademark Trial and Appeals Board remanded the case to the PTO, which published the DYKES ON BIKES mark for opposition on January 4, 2006. *Id.*, Remand (Nov. 2, 2005); '803 FH, Notice of Publication (Jan. 4, 2006).

The PTO finally registered the Dykes on Bikes mark in October 2007, and in 2013 accepted the certificate of use and incontestability. '803 FH, Registration Certificate (Oct. 30, 2007); *id.*, Notice of Acceptance (Nov. 15, 2013).

However, only two years after accepting the incontestability certificate for the trademark on the words Dykes on Bikes, the PTO rejected Dykes on Bikes' new application to register a trademark in its logo on the basis of those same words. '566 FH, Office Action (Aug. 11, 2015). That should not have been a controversial or difficult request, since a mark limited to words plus a design is narrower than the already-registered word mark. Yet despite the PTO's determination after remand from the TTAB in the prior case that the words "Dykes on Bikes" are not disparaging and are eligible for trademark registration, a new trademark examiner decided to reverse course and reject the design mark application, setting Dykes on Bikes' work back twelve years. The PTO examiner has stood by this rejection even after Dykes on Bikes incorporated all the evidence from the prior word mark application into the record along with new evidence that the mark is not disparaging. The examiner has stood by this rejection despite the fact that not one lesbian has ever raised any objection to registration of "Dykes on Bikes" during this entire thirteen year trademark registration effort. The examiner has suspended Dykes on Bikes' design mark application pending the outcome

of this case, *Lee v. Tam*. It is a particularly frustrating result for Dykes on Bikes, which continues to struggle to control its brand without federal trademark registration.

B. DYKES ON BIKES' TRADEMARKS ARE POLITICAL SPEECH, NOT COMMERCIAL SPEECH

1. Dykes on Bikes adopted its trademarked name as a form of political speech. Dykes on Bikes does not exist to sell products. It is a non-profit organization that exists to communicate a political and social message. Indeed, the value of its trademark registration is precisely that it enables Dykes on Bikes to keep the use of its mark political rather than allowing it to be diluted with commercial messages. Dykes on Bikes uses its trademarks to prevent others from commercializing the term "Dykes on Bikes" and to prevent others from attributing others' speech to the Dykes on Bikes organization.

This use of a trademark for self-identification furthers a core purpose of the First Amendment. The First Amendment does not merely protect the availability of messages from various viewpoints. It also protects the right of individuals to associate their identities with the messages they seek to convey. As this Court explained in *City of Ladue v. Gilleo*, 512 U.S. 43 (1994), in the course of striking down an ordinance that prohibited signs on residential property, "[p]recisely because of their location, such signs provide information about the identity of the 'speaker.' [And] . . . the identity of the speaker is an important component of many attempts to persuade." *Id.* at 56. A trademark allows Dykes on Bikes to identify as a group by using language that invokes the members' own

identities. That ability to associate individual identity with group identity and communicate a message unique to that group is central to the First Amendment. *See Roberts v. United States Jaycees*, 468 U.S. 609 (1984) ("[T]he Court has recognized a right to associate for the purpose of engaging in those activities protected by the First Amendment — speech, assembly, petition for the redress of grievances, and the exercise of religion. The Constitution guarantees freedom of association of this kind as an indispensable means of preserving other individual liberties.").

Section 1052(a) restricts Dykes on Bikes' ability to self-identify in their own political speech while preventing commercial exploitation of their branded name by others. It does so by penalizing their mark based on its content and limiting the organization's expressive activity based on the offense that examiners imagine an audience might experience from their choice of words. This is an impermissible content- and viewpoint-based restriction on speech. The First Amendment does not permit government to regulate or punish speech solely because it may give "serious offense." To the contrary, "a principal function of free speech under our system of government is to invite dispute." *Texas v. Johnson*, 491 U.S. 397, 408–409 (1989). In *Forsyth County v. Nationalist Movement*, 505 U.S. 123, 134–35 (1992), this Court reiterated that "[l]isteners' reaction to speech is not a content-neutral basis for regulation" and explained that "[s]peech cannot be financially burdened, any more than it can be punished or banned, simply because it might offend a hostile mob." Section 1052(a) places financially burdensome limitations on the ability of Dykes on Bikes to control the use of its mark and preserve its brand and its name for political

and social purposes without the dilution that comes from unauthorized commercial exploitation. Dykes on Bikes seeks to use its mark to engage in a vital public debate over the very meaning of the word "dyke" to lesbians today.

2. The Court should not allow the government to justify such viewpoint- and content-based restrictions on the false premise that all trademark use is exclusively commercial in nature. We recognize that other trademark owners, such as the Washington Redskins, may use controversial trademarks that are not self-referential for the more traditional goal of branding and selling goods and services for profit rather than engaging in political speech and social activism. We express no opinion on the constitutionality of regulating purely commercial speech, *compare Carey v. Population Services Int'l*, 431 U.S. 678, 701 (1977) ("At least where obscenity is not involved, we have consistently held that the fact that protected [commercial] speech may be offensive to some does not justify its suppression.") *with Board of Trustees of State University of New York v. Fox*, 492 U.S. 469, 475 (1989) (upholding rule at state university that prohibits "Tupperware parties" in order to promote "an educational rather than commercial, atmosphere on SUNY's campuses"), or whether the manner in which the Redskins use their mark constitutes commercial speech.[2] But

---

2. Nor do we endorse the use of the term "redskins" for a football team. Unlike The Slants and Dykes on Bikes, both of whom have chosen to reclaim self-referential terms as trademarks for the benefit of the groups those terms refer to, the Washington Redskins have chosen a term that is unrelated to the people who identify as members of the football team and is commonly understood to be a slur which members of the identified group have not reclaimed. Whatever the constitutionality of the PTO's treatment of the Redskins mark, the team's use of that name is immoral and Dykes on Bikes encourages the Washington Redskins to give up their trademarked name as a matter of respect and decency.

Section 1052(a) restrains more than commercial speech. As applied to Dykes on Bikes and similar organizations, the law burdens political speech and cannot be justified under the lesser scrutiny this Court has sometimes applied in a commercial setting.

Any rule governing what the PTO can or cannot register as a trademark must account for those who use their trademarks for political speech. The fact that some trademark owners may use their marks for exclusively commercial purposes cannot change the fact that Section 1052(a) restricts and burdens those engaged in political speech as well.

C. THE STANDARDLESS DISCRETION IN SECTION 1052(A)'S SPEECH LICENSING REQUIREMENT LEADS TO ARBITRARY APPLICATIONS

When one PTO examiner approves a trademark application for a phrase and another examiner rejects an application for using the exact same phrase, it is clear that "the peaceful enjoyment of freedoms which the Constitution guarantees [is] contingent upon the uncontrolled will of a [government] official," as this Court has prohibited on numerous occasions. *Shuttlesworth v. Birmingham*, 394 U.S. 147, 150 (1969) (quoting *Staub v. City of Baxley*, 355 U.S. 313, 322 (1958)); *see e.g.*, *City of Lakewood v. Plain Dealer Publishing Co.*, 486 U.S. 750, 764 (1988) ("[The government] may not condition that speech on obtaining a license or permit from a government official in that official's boundless discretion."); *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 423 n.19 (1993).

On its face, Section 1052(a) does not provide the "narrow, objective, and definite standards to guide the licensing" that the Constitution requires for a speech licensing scheme. *Shuttlesworth*, 394 U.S. at 151. It prohibits "disparaging" trademarks, but whether a word is disparaging depends heavily on the speaker, the listener, and the context. The difference could even be as subtle as a difference in tone of voice. "Disparagement," by its very nature, is based on the speaker's subjective intent. Depending on the context and the speaker, the use of the term "dyke" can be either an act of self-identification and a claim of pride in group membership or a slur intended to hurt or silence a minority. To tell the difference, a government bureaucrat must engage in viewpoint discrimination, deciding what the term means to the person doing the speaking and their expressive purpose. This is precisely the kind of uncertain standard this Court has rejected in the past. For instance, in *Shuttlesworth*, this Court struck down an ordinance giving the City Commission the power to license parades or demonstrations guided by, among other factors, "decency, good order, [and] morals." *Id.* at 150. The situation is no different here. The government cannot give individual civil servants (a City Commission or the PTO) nearly unfettered discretion to withhold a government benefit (a parade license or trademark registration) based on vague moral standards ("decency, good order, [and] morals" or "immoral . . . , scandalous matter; or matter which may disparage"). *Compare id. with* 35 U.S.C. § 1052(a) *and* TMEP § 1203.03 (b)(i) (Oct. 2015).

The application of Section 1052(a) in practice confirms that delegating hundreds or thousands of discretionary free speech decisions to individual civil servants working

with no clear or objective standard inevitably leads to arbitrary application and irreconcilably inconsistent results. The PTO analyzed two applications from Dykes on Bikes using the exact same phrase and found that phrase disparaging in one application and not in another, even after the same evidence was put before it in both applications.

In 2007, after four years of explanations, evidence, appeals, and motion practice, the PTO finally agreed that the phrase "Dykes on Bikes" is not disparaging and issued a federal trademark registration certificate for the Dykes on Bikes' name. In 2013, it accepted a certificate of continuing use and incontestability. '803 FH, Notice of Acceptance (Nov. 15, 2013). Yet just two years later, Dykes on Bikes applied for a trademark in its logo and the PTO rejected it, finding that the phrase "Dykes on Bikes," which appears in the logo, is disparaging. That finding directly contradicts the PTO's previous finding. '566 FH, Office Action (Aug. 11, 2015).

This was a not a difference in evidence, nor of changing attitudes over time. Rather, the difference is attributable merely to the caprice of the different examiners considering the applications.

This, alone, should be sufficient evidence that Section 1052(a) confers unconstitutionally standardless discretion on PTO examiners. But it gets worse in light of the Trademark Manual of Examining Procedure, which defines a disparaging mark as one that "may" be considered disparaging to "a substantial composite" of a "referenced group." TMEP § 1203.03 (b)(i) (Oct. 2015). While this shift from the perspective of the speaker to

the perspective of the audience purports to offer a more neutral perspective, in fact it does no such thing. To begin, judging speech by the reaction of the audience is itself a content-based activity. *Forsyth County*, 505 U.S. at 134–35. Further, the law's decision to choose only a subset of the audience—the group members the term describes—adds additional ambiguity. It is ambiguous as to what group is to be considered—all women, all lesbians, or all lesbian motorcycle enthusiasts? What constitutes "a substantial composite" of a group is also ambiguous. More importantly, how is an individual trademark examiner to determine whether most lesbian motorcycle enthusiasts would take pride in the phrase "Dykes on Bikes," or be offended by it? How is an individual trademark examiner to determine whether any offended lesbian motorcycle enthusiasts constitute a "substantial" or "insubstantial" composite? Dykes on Bikes submitted dozens of declarations on this point, but the resolution of its applications still depended on the personal reaction of an examiner who audibly gasped in shock when Dykes on Bikes' lawyer told her that counsel is herself "a dyke." That examiner's supervisor justified the examiner's decision by stating that a search for "vulgar" and "dyke" on Google yields many results. The same is true for a search of "vulgar" and practically any other word such as "shoe," yet that does not transmute "shoe" into something generally vulgar (or disparaging).

The open-ended discretion of Section 1052(a) and the TMEP guidelines does not stop with the PTO's registration decision. The uncertainty extends indefinitely because any person can attempt to cancel a trademark—even an incontestable mark—at any time by claiming it is disparaging or scandalous. *See* 15 U.S.C. § 1064(3).

Section 1052(a) is an exception to the normal rule that a trademark cannot be challenged after five years of registration and continuous use. *Id.* Dykes on Bikes thus operates under the constant specter of some person asking to cancel its marks because he or she believes them to be disparaging. And indeed it has already faced such challenges. Although Dykes on Bikes has invested in and cultivated its trademarked name for more than 40 years, it has no idea how the PTO will rule if someone decides to challenge its mark in the PTO, particularly in light of the inconsistent rulings that the PTO has already issued on the mark. The survival of Dykes on Bikes' trademark depends entirely on the personal whim on whichever PTO examiner is assigned to the case if someone decides to challenge the trademark.

The Federal Circuit decision now on appeal held that the PTO's inconsistent application of Section 1052(a) chills speech because people are less likely to choose a trademark if it is uncertain whether the government will be willing to protect it. *See In re Tam*, 808 F.3d at 1342 n.7. In particular, it points out that the PTO denied trademark registration for HAVE YOU HEARD SATAN IS A REPUBLICAN, but granted the trademark application for THE DEVIL IS A DEMOCRAT, stating "all we need say about the uncertainty here, however, is that it contributes significantly to the chilling effect on speech." *Id.* at 1342. That particular example also underscores the danger of the "potential for invidious discrimination of disfavored subjects" where an individual bureaucrat makes decisions about whose speech the government favors and whose speech it does not. *City of Cincinnati*, 507 U.S. at 423 n.19.

Judge O'Malley and Judge Wallach's concurrence in *In re Tam* echoes the majority's concern, but explicitly states that Section 1052(a) should be held unconstitutionally vague. *In re Tam*, 808 F.3d at 1359–60. This Court's admonishments regarding vaguely drafted speech restrictions underscore the dangers of allowing individual PTO examiners standardless discretion. The PTO's arbitrary application of Section 1052(a) does not "give the person of ordinary intelligence a reasonable opportunity to know what is prohibited, so that he may act accordingly." *Grayned v. City of Rockford*, 408 U.S. 104, 108 (1972). Vagueness in government regulation can, standing alone, be a constitutional problem. *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 588 (1998) ("Under the First and Fifth Amendments, speakers are protected from arbitrary and discriminatory enforcement of vague standards."). The Constitution tolerates even less vagueness where, as here, "the law interferes with the right of free speech." *See Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 498 (1982). No reasonable person can determine or predict what speech Section 1052(a) will allow and what speech it will prohibit. *Grayned*, 408 U.S. at 108. As a result, it is likely that speakers will self-censor and avoid trademarks they worry the PTO might cancel even if they invest time and goodwill for many years. *See In re Tam*, 808 F.3d 1341–43.

This Court has held that the First and Fifth Amendments protect people from this kind of vague and inconsistent law when it restricts speech. *See Finley*, 524 U.S. at 588 ("Under the First and Fifth Amendments, speakers are protected from arbitrary and discriminatory enforcement of vague standards."). As discussed further below, the same protections should

apply when such a vague and inconsistent law withholds a government benefit on the basis of the content of speech. *See Speiser v. Randall*, 357 U.S. 513, 518 (1958) ("To deny an exemption to claimants who engage in certain forms of speech is in effect to penalize them for such speech."); *Perry v. Sindermann*, 408 U.S. 593, 597 (1972) ("[E]ven though a person has no 'right' to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech. For if the government could deny a benefit to a person because of his constitutionally protected speech or associations, his exercise of those freedoms would in effect be penalized and inhibited. This would allow the government to 'produce a result which (it) could not command directly.'").

The experience of Dykes on Bikes with Section 1052(a) starkly illustrates the reasons for this Court's longstanding skepticism over poorly drafted government licensing schemes for speech, particularly those that target disfavored or unpopular messages. When a licensing scheme uses terms so vague that applicants will be unable to predict what content will or will not pass muster, the threat to First Amendment values is acute.

D. THE IMPORTANCE OF TRADEMARK REGISTRATION

Federal trademark registration provides substantial benefits that are particularly important to a small, politically-focused, non-profit organization such as Dykes

on Bikes whose resources are limited and therefore must pick and choose the legal battles it can afford to fight.

Some of these benefits of registration are defined in the statute. For instance, the Lanham Act expressly provides that trademark registration comes with a presumption of validity, nationwide priority, incontestability, proof that the mark has secondary meaning, and constructive notice to would-be infringers. The statute also allows a trademark holder to seek additional remedies against infringers.

Other benefits are more practical than legal. Potential users will often check the Principal Register at the PTO and will avoid using a trademarked term when they see it's registered, but they are much less likely to search for or discover who has common-law trademark rights, in part because it is impossible to know from a search what parties might have or claim to have common-law rights in a particular trademark.

Our experience in seeking to enforce our mark bears this out. It has often proved sufficient for Dykes on Bikes to point to its federal registration for its word mark to persuade obvious infringers to cease their unlawful activity. But merely asserting the right to common-law protection often does not have the same effect, as Dykes on Bikes learned when the PTO refused to register its logo trademark. In fact, many online companies like Zazzle.com, which sells user-designed t-shirts and other products online, refuse to honor takedown notices at all without proof of a federal trademark registration. Virtually all websites such as Zazzle.com, eBay, Etsy, CafePress, and Facebook request that a trademark

owner include a trademark registration number when requesting takedown of infringing items, and without one, the takedown may require more time, and may not be successful at all. Other online sites, such as ReverbNation.com require a trademark registration in order to accept a takedown notice. Trademark registration is also required to combat cyber squatting and to protect the mark from registration under newly issued domain extensions. For example, GoDaddy, one of the main domain name registrars in the U.S., requires that a trademark owner have a valid federal registration on the principal register in order to prevent another domain name registrant from using the owner's trademark in a domain name. When ICM Registry, working with ICANN (which oversees the system of domain name extensions such as .com, .net, and .gov) offered a controversial new internet domain extension, .xxx, the only way Dykes on Bikes was able to prevent having its trademark offered to the public with a .xxx domain extension was because they held a federal registration and could opt out during the "Sunrise B" period. Without the federal registration, their application to opt out would have been rejected. Registration by others of Dykes on Bikes using a .xxx domain name would have substantially harmed the political speech and public impression of Dykes on Bikes, and common law remedies would have been too little too late to prevent such harm. Thus, lack of trademark registration actually impedes a trademark owner's ability to enforce its mark in the digital market place and limits its ability to take advantage of the simple, inexpensive takedown notice methods most internet service providers have made available

Dykes on Bikes relies on trademark registration to

ensure that the public associates Dykes on Bikes only with its own speech and not with others' speech or unlicensed attempts to commercialize the mark. Without them, Dykes on Bikes cannot control its own public presence or dignity. The inability to finally resolve its (so-far) thirteen-year effort to register its marks has imposed real costs and burdens on Dykes on Bikes that the possible existence of a common law trademark cause of action does not redress. The difference between having a federal trademark registration and not having one has had a striking difference on Dykes on Bikes' ability to control what speech the public associates with the official Dykes on Bikes organization.

Trademark registration, then, is not merely a government subsidy, largesse that the government can grant or withhold on a whim. Registration is, as a practical matter, an integral part of the Lanham Act scheme for protecting trademarks. Denying registration imposes a substantial burden on small organizations like Dykes on Bikes. Congress cannot impose that burden because it disagrees with Dykes on Bikes' choice of name. *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 566 (2011) ("The First Amendment requires heightened scrutiny whenever the government creates 'a regulation of speech because of disagreement with the message it conveys.'" (citation omitted)); *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015) ("Government regulation of speech is content based if a law applies to particular speech because of the topic discussed or the idea or message expressed.").

It is no answer that the Lanham Act withholds benefits rather than imposes restrictions. That would elevate form over substance. It would make the constitutionality

of the statute turn on Congress' chosen phrasing rather than the statute's effect on speech. There is no difference between "deny[ing] a benefit to a person because of his constitutionally protected speech or associations" and "penaliz[ing] and inhibit[ing]" the exercise of free speech. *Perry*, 408 U.S. at 597. This Court has rejected this argument, holding that "even though a person has no 'right' to a valuable governmental benefit and even though the government may deny him the benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech." *Id.* at 597 (1972); *see also Speiser*, 357 U.S. at 518 ("To deny an exemption to claimants who engage in certain forms of speech is in effect to penalize them for such speech."); *Sorrell*, 564 U.S. at 566 ("Lawmakers may no more silence unwanted speech by burdening its utterance than by censoring its content."); *id.* at 580 (holding impermissible a state law that "burdened a form of protected expression," while leaving "unburdened those speakers whose messages are in accord with its own views").

Congress having provided important rights to all trademark applicants through the registration process, this Court should not allow Congress and the PTO to deny those benefits to selected individual applicants because of viewpoint-based disagreements with their particular choice of trademark.

CONCLUSION

This Court should find that 15 U.S.C. § 1052(a) is unconstitutionally vague, an impermissible viewpoint- and content-based restriction on speech, and confers unconstitutionally standardless discretion on individual PTO examiners

Respectfully submitted,

BROOKE OLIVER
50 BALMY LAW P.C.
50 Balmy Alley
San Francisco, CA 94110
(415) 641-1116

TOBIAS BARRINGTON WOLFF
UNIVERSITY OF PENNSYLVANIA
3501 Sansom Street
Philadelphia, PA 19104
(215) 898-7483

MARK A. LEMLEY
Counsel of Record
MICHAEL A. FELDMAN
DURIE TANGRI LLP
217 Leidesdorff Street
San Francisco, CA 94111
(415) 362-6666
mlemley@durietangri.com

Counsel for Amicus Curiae

RECORD AND BRIEF

No. 15-1293

In the

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

AMICI CURIAE BRIEF OF THE THOMAS JEFFERSON CENTER FOR THE PROTECTION OF FREE EXPRESSION AND THE ELECTRONIC FRONTIER FOUNDATION IN SUPPORT OF RESPONDENT

DAVID GREENE
DANIEL NAZER

Electronic Frontier Foundation
815 Eddy Street
San Francisco, CA 94109
(415) 436-9333 ext. 143
DavidG@eff.org

J. JOSHUA WHEELER*
CLAYTON N. HANSEN

The Thomas Jefferson Center for the Protection of Free Expression
400 Worrell Drive
Charlottesville, VA 22911
(434) 295-4784
jjw@tjcenter.org

**Counsel of Record for Amici Curiae*

TABLE OF CONTENTS

STATEMENT OF INTEREST OF *AMICI CURIAE* 1

SUMMARY OF ARGUMENT 2

ARGUMENT .....

I. The *Walker* Factors Should be Interpreted as Sharply Limiting the Reach of Government Speech 4

A. History Counsels Against Registration as Government Speech 5

B. No Reasonable Consumer Would Confuse Trademarks for Government Speech 5

C. "Direct Control" and Veto Power 7

II. Free Speech Policy Concerns Strongly Counsel Against Treating Trademark Registration as Government Speech 8

A. This Court Has Rightfully Been Cautious with Government Speech Doctrine 8

B. Even if the Government in Some Way Speaks by Registering a Trademark, the Government's Message is Necessarily Limited 10

C. Trademark Registration Does Not Fit into the Category of Government Speech by Means of Spending 11

D. The Government Does Not Create Trademarks and Is Thus a Poor Judge of Their Expressive Content 12

E. PTO's Trademark Review Cannot Shield Arbitrary and Discriminatory Findings from First Amendment Scrutiny 15

F. Courts Can Balance Speech Interests Implicated by the Lanham Act Without Mislabeling Trademarks as Government Speech 18

CONCLUSION 20

TABLE OF AUTHORITIES

Cases **Page**

Capitol Square Rev. & Advisory Bd. v. Pinette, 515 U.S. 758 (1995) 5

In re Simon Shiao TAM, 2015 WL 4537349 (C.A.Fed. July 23, 2015) 6, 19

Invisible Empire of Knights of Ku Klux Klan v. Mayor of Town of Thurmont, 700 F. Supp. 281 (D. Md. 1988) 11

Johanns v. Livestock Mktg. Ass'n, 544 U.S. 550 (2005) 7

Koch Industries, Inc. v. Does, No. 2:10CV1275DAK, 2011 WL 1775765 (D. Utah May 9, 2011) 20

Nat'l Endowment for the Arts v. Finley, 524 U.S. 569 (1998) 17

N.Y. Times Co. v. Sullivan, 376 U.S. 254 (1964) 19

Perry v. Sindermann, 408 U.S. 593 (1972) 17

Pleasant Grove City v. Summum, 555 U.S. 460 (2009) 5, 9, 11

Qualitex Co. v. Jacobson Products Co., Inc., 514 U.S. 159 (1995) 5, 8, 16

Rosenberger v. Rector & Visitors of the Univ. of Va., 515 U.S. 819 (1995) 9

Rust v. Sullivan, 500 U.S. 173 (1991) 16

Shelley v. Kraemer, 334 U.S. 1 (1948) 20

Walker v. Tex. Div., Sons of Confederate Veterans, Inc., 135 S. Ct. 2239 (2015) ..... *passim*

Administrative Decisions:

In re Lebanese Arak Corp., 94 U.S.P.Q.2D 1215 (T.T.A.B. 2010) 13, 14, 16

In re Old Glory Condom Corp., 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993) 10

Simon Shiao TARN [sic], 2013 WL 6039240 (T.T.A.B. 2013) 16

Statutes:

15 U.S.C. § 1052 10

Other Authorities:

Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. Rev. 621, 667–70 (2004) 14

Br. of Law Professors as Amici Curiae in Support of Pet'r 18

Br. of Amicus Curiae Public Knowledge in Support of Neither Party 18

Br. for South Asian Bar Ass'n of D.C. as Amici Curiae Supporting Appellant, *In re Simon Shiao Tam*, 2015 WL 4537349 (Fed. Cir. June 23, 2015) 6, 19

Daniel Nazer, *Deeplinks Blog: EFF to Court: A Trademark is Not a Censorship Tool*, Electronic Frontier Foundation (Oct. 11, 2014) 18

Daniel Nazer, *Deeplinks Blog: EFF to Jones Day: Don't Be A Trademark Bully*, Electronic Frontier Foundation (June 24, 2014) 18

Google, *Our History in Depth*, https://www.google.com/about/company/history 13

Pet'r's Br., *Lee v. Tam*, 137 S. Ct. 30 (2015) (No. 15–1293) 10, 13

STATEMENT OF INTEREST OF *AMICI CURIAE*[1]

The Thomas Jefferson Center for the Protection of Free Expression is a nonprofit, nonpartisan organization located in Charlottesville, Virginia. Founded in 1990, the Center has as its sole mission the protection of free speech and press. The Center has pursued that mission in various forms, including the filing of *amicus curiae* briefs in this and other federal courts, and in state courts around the country.

The Electronic Frontier Foundation ("EFF") is a non-profit, civil liberties organization working to protect rights in the digital world. EFF actively encourages and challenges industry and government to support free expression, privacy, and openness in the information society. Founded in 1990, EFF is based in San Francisco.

EFF believes that free speech is a fundamental human right, and that freedom of the press is vital to an open, democratic society. The vast web of electronic media that now connects us is heralding a new age of

---

[1] Pursuant to Supreme Court Rule 37.6, counsel for *Amici Curiae* represents that it entirely authored this brief and no party, its counsel, or any other entity but *Amici* and their counsel made a monetary contribution to fund the brief's preparation or submission. Consent of the parties to file this brief is on file with the Court.

communications, a new way to convey speech. New digital networks offer tremendous potential to empower individuals in an ever-overpowering world. While EFF is mindful of the serious issues that may arise when information flows free, EFF is dedicated to addressing such matters constructively while ensuring that fundamental rights are protected.

SUMMARY OF ARGUMENT

The United States Patent and Trademark Office (PTO) seeks to turn First Amendment law on its head. Presently, government regulation of speech based on its viewpoint and content is subject to strict scrutiny. Yet the PTO claims its registration process is government speech and that it can deny a governmental benefit in service of communicating its message. Were this interpretation of the law correct, it would obliterate First Amendment doctrines that sharply limit how the government regulates speech, including prior restraint and time, place and manner restrictions.

The PTO would create a new category of government speech heretofore unrecognized by this Court: speech in which the speaker is private and the message is private, but which by the mere act of registering such expression under a government program, is converted into government speech. In recog-

nizing a trademark, it claims, the government involves itself with private speech and thereby creates government speech.

In virtually every other context, the government's denial of a benefit to a private speaker in order to prevent the speaker from disparaging unrelated persons is plainly unconstitutional. There is no reason to treat the PTO's registration process any differently. Indeed, the idea that the PTO, of all governmental agencies, should be the one charged with discriminating against speech on the basis of viewpoint is completely unfounded, given that agency's purpose and expertise.

That registered trademarks are not government speech flows naturally from this Court's recent decision in *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015). Unlike the specialty and personalized license plates at issue in *Walker*, trademark registrations are not a traditional medium for government speech. There is no clear government speaker in a trademark registration, and the public is unlikely to be confused as to whether the owner or the government is speaking through a trademark. Lastly, because *Walker* relied on the government's essential role in the issuance of license plates, its reasoning does not map naturally onto trademarks. Trademarks serve only to memorialize interests in private speech, whereas license plates convey direct government messages or private speech with which the government has allowed itself to be associated.

ARGUMENT

I. The *Walker* Factors Should be Interpreted as Sharply Limiting the Reach of Government Speech

This case represents an attempt by the PTO to expand the government speech doctrine beyond what this Court intended, and in a manner, that poses a serious threat to the First Amendment rights of private individuals. When a particular type of speech is deemed to be government speech it is effectively shielded from First Amendment review. *Walker*, 135 S. Ct. at 2245–46. Given the potential for abuse this represents the government speech doctrine should be narrowly defined; far more so than it would have to be to encompass trademark registration.

The *Walker* decision used three factors to identify government speech: history, speaker identity, and governmental control. In cases that involve private speech, these factors—even combined—do not reach very far beyond personalized license plate design and certainly not to trademark registration.

A. History Counsels Against Registration as Government Speech

Contexts where private speech is converted to government speech ought to be limited to existing examples such as public monuments and license plates. Unlike monuments and license plates, trademarks do not have a history of being used as a vehicle for government speech. *See Pleasant Grove City v. Summum*, 555 U.S. 460, 470 (2009). ("Governments have long used monuments to speak to the public."); *Walker*, 135 S. Ct. at 2248 ("State speech has appeared on Texas plates for decades."). Trademarks, by contrast, have long been used for commercial purposes by private parties seeking to help people identify their products. The singular purpose of trademark enforcement is to protect consumers and producers. *See Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 163–64 (1995). These messages have always been regarded as private and no reasonable observer would interpret a trademark as a government endorsement of or association with the mark's message. *Cf. Capitol Square Rev. & Advisory Bd. v. Pinette*, 515 U.S. 758, 778, 780 (1995).

B. No Reasonable Consumer Would Confuse Trademarks for Government Speech

The government and supporting *amici* claim that the granting and publication of trademarks by the PTO causes the public to believe that trademarks

are the government's words rather than those of a private business referring to its goods or services. The approval and publication of federal trademark registration in the Principal Register is a formal administrative procedure that results in a catalog of private speakers and their speech. This record exists to identify the property right, name its possessor, and put future registrants on notice that the property right is already possessed and accounted for. As such, it is highly unlikely that publishing this record would cause the trademarks themselves to be viewed as government speech.

It is also claimed that the right to inform people about a trademark's registration status, through the use of the ® or equivalent language by trademark holders, is somehow an "official association with the United States government." Br. for South Asian Bar Ass'n of D.C. as Amici Curiae Supporting Appellant, *In re Simon Shiao TAM*, 2015 WL 4537349 at *4, (C.A.Fed. July 23, 2015). It is difficult to see how a reasonably informed person would think that the ® is representative of such an association. In practice, registration symbols are no different from "no trespassing" signs. Both signal the existence of private legal rights as well as the owner's will and intent to enforce those rights if the protected property is violated. The message conveyed by a "no trespassing" sign is the same regardless of whether the warning is handwritten by the property owner himself or printed by a third party—even if that party happens to be the govern-

ment. The attachment of government-provided symbols to real or intellectual property is no indicator of state involvement in those matters just as applying government-produced postage stamps (even those that feature their own highly expressive designs and messages) to an envelope prior to mailing results in no confusion over the authorship of the letter inside. Despite the PTO's assertions to the contrary, a trademark owner's message and identity are perfectly clear to all reasonable observers and there exists no legitimate concern over the identity of the speaker or any hidden message of government approval.

C. "Direct Control" and Veto Power

The third factor in the *Walker* inquiry is whether, through the review process in question, the government "maintains direct control" over particular messages. *Walker*, 135 S. Ct. at 2249. *See also Johanns v. Livestock Mktg. Ass'n*, 544 U.S. 550, 561 (2005) (discussing instances where the agency "exercises final approval authority over every word used in every promotional campaign"). This examination was necessary in *Walker* because the peculiar characteristics of custom license plates implicate issues of mixed government and private speech that could confuse the public as to the speaker's identity. Direct control over the content of speech or the veto power over such speech is irrelevant when the speaker is purely private. In fact, direct control over purely private speech is exactly what the First Amendment forbids.

The approval of a license plate design only superficially tracks with the PTO's process. In *Walker*, the presence of mixed government/private speech was predicated on the finding that license plates were traditional vehicles of government speech, into which some limited public input had been invited. *See Walker*, 135 S. Ct. at 2248 ("First, the history of license plates shows that, insofar as license plates have conveyed more than state names and vehicle identification numbers, they long have communicated messages from the States.") Trademarks, by contrast, are a private right arising from the common law to memorialize private interests in private speech. *Qualitex*, 514 U.S. at 163–64. *Walker* stands for the notion that the government can surrender some control over its own speech while retaining the right to veto such speech if it so chooses. The PTO implicitly reads this holding in reverse: that the government can assert a discretionary veto over traditionally private speech and thereby convert that speech into government speech.

II. Free Speech Policy Concerns Strongly Counsel Against Treating Trademark Registration as Government Speech

A. This Court Has Rightfully Been Cautious with Government Speech Doctrine

This Court has repeatedly stated that when exercising discretion in regulating private speech the government must "respect[] the critical difference" between "government speech . . . and private speech." *Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 841 (1995) (quoting *Bd. of Educ. v. Mergens*, 496 U.S. 226, 250 (1990) (opinion of O'Connor, J.)). In *Summum*, this Court expressed "legitimate concern that the government speech doctrine not be used as a subterfuge for favoring certain viewpoints." 555 U.S. at 462. Justice Stevens went on to note that, "to date, our decisions relying on the recently minted government speech doctrine to uphold government action have been few and, in my view, of doubtful merit." *Summum*, 555 U.S. at 481 (Stevens, J., concurring). Such hesitation remains justified: once given doctrinal force, government speech is hard to limit.

This Court has confined its use of the government speech doctrine to limited circumstances such as when "a government maintains a monument," *Summum*, 555 U.S. at 486 (Souter, J., concurring), or issues license plates, *Walker*, 135 S. Ct. at 2253.

Trademarks are not like those cases. *The Slants* do not propose to speak for the government, nor the government for *The Slants*. Without trademark approval, *The Slants* will still hold themselves out as *The Slants*. All that is withheld here is a government benefit—for viewpoint based reasons. Indeed, the PTO now invokes a capacious interpretation of "govern-

ment speech" that would give it an unaccountable degree of discretion. *See* Pet'r's Br. at 14–19, Lee v. Tam, 137 S. Ct. 30 (2015) (No. 15–1293) (characterizing the government speech aspect of their argument as finding "eligibility for a government program."). If, by some Midas-like transformative touch, the mere act of registering a name converts private speech into government speech, it would enable the simple act of registration to excuse untold encroachments on the First Amendment freedom of speech.

B. Even if the Government in Some Way Speaks by Registering a Trademark, the Government's Message is Necessarily Limited

To the extent the PTO communicates when it registers a trademark, its message is that the trademark is a means by which "goods of the applicant may be distinguished from the goods of others." 15 U.S.C. § 1052. A decision of the PTO, and even notification of the decision, merely serves to inform the mark holder of the outcome and inform other parties as to the rights of the applicant—nothing more. That the PTO allowing or disallowing registration lends a government imprimatur has been expressly denied as "erroneous." *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1219–20 n.3 (T.T.A.B. 1993).

In one limited sense that means the government may be speaking via a purely regulatory act, but

in that context the message is only "we grant this permit." If the government also wishes to say "and we don't like this message," they can do that too; but not in the registration context. The PTO cannot deny a permit on the basis of the content or viewpoint of an applicant's speech. Courts have consistently refused to allow cities to engage in viewpoint discrimination by denying parade permits to certain hate groups despite concerns that observers would falsely assume that the city endorsed the group's message. *See, e.g.*, *Invisible Empire of Knights of Ku Klux Klan v. Mayor of Town of Thurmont*, 700 F. Supp. 281 (D. Md. 1988). But surely governments do not want their granting of a permit to the KKK to mean "We endorse this speech" as the PTO suggests its registration process does.

C. Trademark Registration Does Not Fit into the Category of Government Speech by Means of Spending

Although this Court has considered the use of government resources to endorse private speech when identifying government speech, *see, e.g.*, *Summum*, 555 U.S. 460, there is no such endorsement in this case. The publication of trademarks in the Principle Register and the issuance of certificates are at most trivial expenditures and cannot be taken seriously as a government spending issue. That is in no way analogous to the government having to pay for the installation and maintenance of the donated Ten Commandments monument in *Summum*. To the contrary, all of

the significant expenditures, and corresponding financial benefits are by the trademark applicants and holders. Trademark holders are expected to privately fund the enforcement of their trademarks.

The government's argument that Mr. Tam seeks to compel registration and publication of his mark in violation of public policy is misguided. Mr. Tam is not forcing the government to convey a private message that it does not agree with. Registered marks serve to describe brands and identities owned by private participants, not to impute some proprietary government interest. Unlike the Texas DMV in *Walker*, the PTO here controls neither the speech nor the speaker: it merely punishes certain speakers by refusing to confer a legal benefit because it disfavors the content of the speech.

D. The Government Does Not Create Trademarks and Is Thus a Poor Judge of Their Expressive Content

Purely private speech conveys many messages. For that reason, the PTO cannot easily evaluate those messages with objective standards. Commercial businesses, non-profits, and individuals choose company and product names for a variety of reasons. Since the government is not involved in these choices, it will have little understanding of why marks were chosen

and may not understand their expressive content. Indeed, the government's own brief includes a mistake about the expressive content of the "GOOGLE" trademark. The government suggests that the mark is simply a nonsense word "with no preexisting meaning." *See* Pet'r's Br. at 47. But "GOOGLE" is play on the word "googol," which is the name for the very large number 10^{100}. The founders of Google chose their company name to reflect their "mission to organize a seemingly infinite amount of information on the web." *See* Google, *Our History in Depth*, https://www.google.com/about/company/ history. Contrary to the government's supposition, many in the engineering and science world are familiar with the deeper meaning of the mark. That the government's brief in this very case includes an error about the meaning of a world-famous trademark drives home just how bad a judge it is of the expressive content of trademarks.

Beyond simply misunderstanding blatant double-meanings such as "GOOGLE," the government also on occasion finds unintended double-meanings as the basis for rejecting a mark. In this case and others, the PTO denied a trademark registration by imagining unintended interpretations, contexts, and scenarios in which a proposed mark would give offense, and used such conjectures as the basis for rejecting the mark, regardless of the speaker's meaning or the speech actually conveyed by the mark. One example is particularly salient. In reviewing the Lebanese Arak Corporation's application to register "KHORAN"

wine, the Trademark Trial and Appeal Board (TTAB) refused to grant the trademark. The TTAB reasoned that because "khoran," an Armenian word meaning "altar," was a homophone of the Islamic holy book (the Koran), and since the Koran forbids consumption of alcoholic beverages, the mark "KHORAN" could offend followers of the Islamic faith. *See In re Lebanese Arak Corp.*, 94 U.S.P.Q.2D 1215 (T.T.A.B. 2010). In fact, the words "Armenian Wine" appeared "prominently on the wine bottle specimen label," but that feature was considered "essentially irrelevant" to the question of how consumers would understand the label "KHORAN." *Id.* at 7. The speaker's intent behind the mark and the message itself ceased to be treated for what they were: private speech.

The government wrongly dismisses the expressive content of marks as "incidental." *See* Br. in Opp'n at 47. Certainly, a trademark may have little or no independent expressive content aside from its role as a source identifier. But many marks can have deep expressive meaning to both the applicant and the public. Far from merely serving as source identifiers, many trademarks are so imbued with expression that scholars have suggested that the expressive meaning of a mark, standing alone, can be the primary driver of consumer behavior. *See generally* Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. Rev. 621, 667–70 (2004). The government not only fails to understand this rich and complex expression, it radically compounds its error by claiming it as its own speech.

Further, the inconsistent record of the PTO in granting colorful and sometimes genuinely offensive marks but denying benign ones, belies any notion that the PTO is not associating itself with messages it finds offensive or with which it disagrees. *See, e.g.*, RADICALLY FOLLOWING CHRIST IN MISSION TOGETHER (U.S. Reg. No. 4,759,522); THINK ISLAM (U.S. Reg. No. 4,719,002) (religious marks); GANJA UNIVERSITY (U.S. Reg. No. 4,070,160) (drug-related); CAPITALISM SUCKS DONKEY BALLS (U.S. Reg. No. 4,744,351); TAKE YO PANTIES OFF (U.S. Reg. No. 4,824,028); and MURDER 4 HIRE (U.S. Reg. No. 3,605,862). *See also Tam*, 808 F.3d at 1346. Ultimately, the government cannot logically have it both ways: either trademark registration converts trademarks into government speech, in which case trademarks that seemingly advance a particular religion or encourage illegal activities should be prohibited, or it does not. Given this inconsistent application and demonstrated lack of comprehension, it is deeply troubling that the existing scheme hinges on the government's understanding of the meanings of trademarks.

E. PTO's Trademark Review Cannot Shield Arbitrary and Discriminatory Findings from First Amendment Scrutiny

The government cannot claim an expressive interest in approving or denying trademarks when the

purported content of those marks is so contingent on individual examiners' caprice. Beyond providing evidence of administrative incompetence, the government's interpretations of "GOOGLE" and "KHORAN" demonstrate the incoherence of treating their often implausible or incorrect interpretations of proposed marks as authoritative. Far from applying an objective test, TTAB asserts broad discretion in determining what it believes to be a "substantial composite of the referenced group." *In re Lebanese Arak Corp.* at *3. In the case of the "KHORAN" mark, for instance, the PTO asserted without support that the mark referenced Muslims, an assertion that TTAB took as a given. *Id.* at *4. To make matters worse, the term "may be disparaging to" establishes the lowest possible standard of proof for examining attorneys who can gin up pseudo-research from blogs, comments, and obscure dictionary references to deny trademarks that have highly contextual meanings. *See* Examining Att'y's Appeal Br. at 1*, *Simon Shiao TARN [sic]*, 2013 WL 6039240 (T.T.A.B. 2013) (Opp'n No. 85472044).

A registration process that serves as the government's airing of its views regarding disparagement is inconsistent with the purpose of both the PTO and trademark law in general. The purpose of trademarks is to prevent consumer confusion and to give mark holders the opportunity to find creative ways to distinguish their products. *See Qualitex*, 514 U.S. at 163–64. Viewpoint discrimination has nothing to do with the proper goals of trademarks. This is not a situation such as that in *Rust v. Sullivan*, 500 U.S. 173 (1991),

where Congress crafted a program to fund the dissemination of specific message, in the process excluding the recruited speakers from using the funds to communicate an inconsistent message. *See id.* at 174–75 ("Similarly, in implementing the statutory prohibition by forbidding counseling, referral, and the provision of information regarding abortion as a method of family planning, the regulations simply ensure that appropriated funds are not used for activities, including speech, that are outside the federal program's scope.").

The Court could clarify this distinction by reasserting that "even though a person has no 'right' to a valuable governmental benefit" and the government "may deny . . . the benefit for any number of reasons . . . [i]t may not deny a benefit to a person on a basis that infringes his constitutionally protected interests—especially, his interest in freedom of speech." *Perry v. Sindermann*, 408 U.S. 593, 597 (1972). *See also Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 587 (1998) (noting that even in the provision of subsidies, the government may not "aim at the suppression of dangerous ideas"). There is no doubt that the benefits of registration are being withheld from constitutionally protected speech and the Respondent's brief addresses the unconstitutional conditions doctrine. However, this reasoning equally applies to simple viewpoint discrimination concerns. When the government regulates private speech that is protected under the Constitution it may not do so on the basis of

viewpoint. First Amendment review should not be ignored in a case in which the regulation of private speech is so squarely indicated.

F. Courts Can Balance Speech Interests Implicated by the Lanham Act Without Mislabeling Trademarks as Government Speech

A number of *amici* supporting the government have noted that any trademark regime must balance the free speech rights of both trademark owners and the public. These *amici* explain that trademark enforcement can burden expression. *See* Br. of Law Professors as Amici Curiae in Support of Pet'r at 25 (noting that the "the entire system of trademark registration is a system of speech regulation"); Br. of Amicus Curiae Public Knowledge in Support of Neither Party at 11–14. We agree.[2] The potential misuse of registered marks, however, does *not* require trademark

---

[2] The Electronic Frontier Foundation has filed *amicus* briefs and represented clients in numerous similar cases where abusive trademark enforcement threatened free speech. *See e.g.*, Daniel Nazer, *Deeplinks Blog: EFF to Court: A Trademark is Not a Censorship Tool*, Electronic Frontier Foundation (Oct. 11, 2014), https://www.eff.org/deeplinks/2014/10/eff-court-trademark-not-censorship-tool; Daniel Nazer, *Deeplinks Blog: EFF to Jones Day: Don't Be A Trademark Bully*, Electronic Frontier Foundation (June 24, 2014), https://www.eff.org/deeplinks/2014/06/eff-jones-day-dont-be-trademark-bully.

registration to be elevated to government speech in the way the PTO suggests. Other long-established doctrines can be invoked to protect the public from overbroad trademark enforcement.

A comparison with defamation law is instructive. Most defamation lawsuits, like most trademark lawsuits, are between private parties. But defamation statutes and judicial orders in defamation cases are considered an exercise of state power. *See N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 265 (1964). Accordingly, the First Amendment limits the reach of defamation law. *Id.* at 283–84. There is no need to assume that defamation is government speech to arrive at this result. Similarly, there is no need to assume trademark registration is government speech for courts to apply the First Amendment to protect speakers from overbroad trademark enforcement.

This reasoning resolves a concern expressed by an *amicus* before the Federal Circuit. There, the *amicus* argued that, if Mr. Tam were to prevail, hate groups might register trademarks on hateful speech and assert those marks in a way that restricted the speech of those that would publicize and criticize the conduct of such groups. *See* Br. for South Asian Bar Ass'n of D.C. as Amici Curiae Supporting Appellant, *In re Simon Shiao Tam*, 2015 WL 4537349 at *4, (Fed. Cir. June 23, 2015) (suggesting that "the hate group would be able to call upon the power of the government courts to cut off lawful speech by the counter-group aimed at subverting the message of hate"). In

support of this argument, the South Asian Bar Association of Washington, D.C. compared the registration of disparaging marks to the recording of racially restrictive covenants. *Id.* It suggested a ruling for Mr. Tam might be inconsistent with *Shelley v. Kraemer*, 334 U.S. 1 (1948).

This is not correct. In *Shelley*, this Court found "state action" where private parties resorted to the state courts to enforce a facially discriminatory restrictive covenant. That holding, as in *Sullivan*, is premised on the application of state power by courts. It did not rely on racially restrictive covenants being categorized as government speech. The lesson from *Shelley* is that courts can protect constitutional rights without improperly categorizing private agreements or private speech as belonging to the government. Any court faced with trademark enforcement that improperly burdens speech should invoke the First Amendment and refuse to allow a trademark to be asserted in such a manner. *See Koch Industries, Inc. v. Does*, No. 2:10CV1275DAK, 2011 WL 1775765 at *5 (D. Utah May 9, 2011) (declining to allow trademark owner to assert mark against a website critical of its conduct).

CONCLUSION

For the foregoing reasons, *amici* urge the Court to deny that trademark registration is government

speech and thereby consider the First Amendment concerns raised in this case.

Respectively Submitted,

DAVID GREENE
DANIEL NAZER

Electronic Frontier Foundation
815 Eddy Street
San Francisco, CA 94109
(415) 436-9333 ext. 143
DavidG@eff.org

J. JOSHUA WHEELER*
CLAYTON N. HANSEN

The Thomas Jefferson Center for
the Protection of Free Expression
400 Worrell Drive
Charlottesville, VA 22911
(434) 295–4784
jjw@tjcenter.org

**Counsel of Record for Amici Curiae*